Supreme Court of the United States

OCTOBER TERM, A. D. 1904.

No. 130.

HOWE SCALE COMPANY OF 1886 AND FAY-SHOLES COMPANY, Petitioners,

vs.

WYCKOFF, SEAMANS & BENEDICT, Respondent.

BRIEF AND ARGUMENT FOR PETITIONERS.

(WITH APPENDIX OF GERMAN DECISIONS AS TO NAME "REMINGTON-SHOLES.")

SYNOPTICAL INDEX.

Statement of Facts.—First of modern typewriting machines invented chiefly by C. L. Sholes and manufactured by E. Remington & Sons. World-wide reputation of Remingtons (as manufacturers of fire arms, sewing machines, etc.), before the advent of the typewriter, the admitted reason for giving the names "Remington" and "Remington Standard" to complainant's machine. Typewriter branch of business transferred in 1886 by E. Remington & Sons corporation, together with name "Standard Remington Typewriter," the right being reserved to re-engage in the business after ten years. 3

Identifying Marks of Complainant's Machine.—Complainant's machine marked with name "Remington," with large "Red Seal" trade-mark, with name and address "Remington Standard Typewriter, Manufactured by Wyckoff, Seamans & Benedict, Ilion, N. Y.," etc. 5

History of Remington-Sholes Co. and its Predecessor, the Remington-Sholes Typewriter Co.—Z. G. Sholes (son of C. L. Sholes, the pioneer typewriter inventor), having invented a typewriting machine, organized Wisconsin corporation, "The Z. G. Sholes Company," to manufacture same. Stock of said company never issued and no machine ever made by it. Z. G. Sholes met Franklin and Carver Remington, sons of former president of E. Remington & Sons corporation. The Remingtons bought three-quarters interest in Sholes' invention. They acquired interest in the Z. G. Sholes Company to cancel its license under the Sholes inventions and surrender charter. Franklin Remington gave his entire time to the improvement and exploiting of the Sholes machine, furnishing all capital ($15,000). All changes in the Sholes machine subject to Remington's approval. Name of machine thereafter

changed from "Z. G. Sholes" to the "Remington-Sholes." Remington and Sholes interested capital to manufacture their machine and "Remington-Sholes Typewriter Company" formed. Its capital stock taken mainly by the Remingtons and Sholes. Business of corporation managed entirely by Franklin Remington as general manager and Z. G. Sholes as superintendent, during first year or more. Dissolution of Remington-Sholes Typewriter Company in fall of 1896 and business taken over by Mr. Fay pending reorganization. Remington-Sholes Company succeeded to business in April, 1897. Remington retained one hundred and fifty shares of stock (representing his cash investment) and continued general manager. 6

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HOWE SCALE COMPANY OF 1886 AND FAY-SHOLES COMPANY, Petitioners,

vs.

WYCKOFF, SEAMANS & BENEDICT, Respondent.

BRIEF AND ARGUMENT FOR PETITIONERS.

This cause comes before this court on petition and cross-petition for writ of *certiorari* to the United States Circuit Court of Appeals for the Second Circuit to review a judgment which in terms reversed a judgment of the Circuit Court for the District of Vermont.

The bill of complaint charges infringement of the registered trade-marks "REMINGTON" and "REMINGTON STANDARD" (R. 6), and unfair competition in trade.

The Howe Scale Company, at the time the suit was brought, was placing upon the market typewriting machines manufactured by the Remington-Sholes Company of Chicago, Illinois, and bearing the name "REM-SHO" and

the name and address of the manufacturer, viz., "REMINGTON-SHOLES COMPANY, MFRS., CHICAGO," and it is against this use of the names "REM-SHO" and "REMINGTON-SHOLES COMPANY" that the complaint is particularly directed.

The Circuit Court sustained the bill so far as granting the prayer for an injunction, but denied the prayer for an accounting. On appeal, the Circuit Court of Appeals held defendant entitled to use the name Rem-Sho, but, by a divided court, technically reversed the decision of the lower court and remanded the cause with instructions to decree in favor of the complainant only as to the name "Remington." From this decision of the Circuit Court of Appeals, Wallace, J., dissented, holding that the decree of the lower court should be reversed with instructions to dismiss the bill of complaint. After the issuance of the mandate of the Circuit Court of Appeals, the Circuit Court on June 23, A. D. 1903, entered a final decree in which it was decreed *inter alia* that the defendant, the Howe Scale Company of 1886, and all others acting in privity with it, should be enjoined from in any manner whatsoever making use of the word "REMINGTON" as the whole or as a part of any name or designation whatsoever, which should be marked upon or applied to typewriting machines, and that complainant recover the costs of suit.

The Remington-Sholes Company, by whom the defense of this suit has been managed, in obedience to the original decree of the Circuit Court ceased to mark its typewriting machines with the words "REMINGTON-SHOLES COMPANY, MFRS., CHICAGO" and with its registered trade-mark "REM-SHO," and changed its corporate name from "Remington-Sholes Company" to "Fay-

Sholes Company" in keeping with the laws of the State of Illinois.*

The petition for writ of *certiorari* was presented by the Howe Scale Company and by the Fay-Sholes Company (formerly named Remington-Sholes Company) to secure the reversal of the decree of the Circuit Court of Appeals for the Second Circuit in so far as it decreed against the use of the name "Remington-Sholes" and "Remington-Sholes Company" in connection with defendant's machines; and the cross-petition of the complainant, Wyckoff, Seamans & Benedict was presented to secure the reversal of the decree of the Circuit Court of Appeals in so far as that decree affirmed defendant's right to use the name "REM-SHO" upon its machines.

Statement of Case.

Complainant and its Predecessors.—For some years prior to 1860 E. Remington and his sons, Philo, Samuel and Eliphalet, were engaged at Ilion, N. Y., in the manufacture of fire arms, both sporting and military, under the firm name of E. Remington & Sons. After the father's death in 1863, the sons carried on the partnership business until January, 1865, when they organized the corporation, E. Remington & Sons, under the laws of the State of New York.

As early as 1866 E. Remington & Sons produced a breech-loading rifle that was sold in immense quantities throughout the world, the output of the works at times reaching as high as 1,000 finished guns per day. (R.

* Counsel for complainant has urged that in view of this change of name the questions at issue have become largely "academic." We assume, however, that this court will deal with the *status* existing prior to the injunction decree that caused the change of name.

40.) This rifle was known and is today known as "The Remington." (R. 39.) The "Remington Sewing Machine," agricultural implements and other machines were also manufactured and sold very extensively (R. 80), offices being established for their sale in most of the principal cities of the United States. The plant of this corporation was one of the largest in the world and the name "Remington" became known the world over prior to the advent of the typewriter.

In 1873 E. Remington & Sons began the manufacture of a typewriting machine, the most important features of which were invented and patented by Christopher Latham Sholes. (R. 208.) When first placed upon the market this machine, being the pioneer writing machine, was designated and known simply as "The Typewriter." Later and for a very brief period it was called "The Sholes & Glidden Typewriter," although never known to any considerable extent by that name (R. 55 and 64); but about 1880, and for the admitted purpose of gaining the benefit of the great reputation of E. Remington & Sons in other lines of manufacture, the names "Remington" and "Remington Standard" were adopted and have since been continuously used. (R. 4.)

The history of the adoption of the name "Remington" in connection with the typewriter is thus given by complainant's witness, Mr. Barron (R. 206):

> "About 1880 the 'Caligraph' was put on the market by the American Writing Machine Company. When Mr. Yost first talked of putting the 'Caligraph' on the market, he and James Densmore (the parties who had brought the original model machine to E. Remington & Sons) had a conversation at which I was present and they decided that the name of the Sholes & Glidden typewriter should be called the 'Remington' in contradistinction to the 'Cali-

graph' for the reason that **the name Remington was known the world over owing to their building guns for foreign governments, building sewing machines, and having one of the largest manufacturing works in the world.** . . . The conversation was about, I think, the latter part of 1877 or in the spring of 1878."

On March 22, 1886, the typewriter branch of the business of E. Remington & Sons was sold to Messrs. Wyckoff, Seamans & Benedict, and at the time of such sale there was transferred also the exclusive right to the name "STANDARD REMINGTON TYPEWRITER," *by which name, as the assignment states* (R. 717), *the machines were generally known. But this assignment expressly reserved to E. Remington & Sons the right to re-engage in the manufacture and sale of typewriters at any time after ten years from its date* (R. 720.), this reservation obviously carrying with it the right to resume the use of their name upon typewriting machines in case they again embarked in such enterprise.*

The fire-arms branch of the Remington Corporation was later transferred to the Remington Arms Company that continues to manufacture the "Remington Rifle," the "Remington Shot Gun," the "Remington Bicycle," etc.

Identifying Marks of Complainant's Machine.— For many years past complainant's typewriting machines have been marked conspicuously and invariably with the name "REMINGTON" and with the large "RED SEAL" trade-mark upon the paper table and frame (R. 1487), and with the name and address "REMINGTON STANDARD TYPEWRITER MANUFACTURED BY WYCKOFF, SEAMANS & BENEDICT, ILION,

*Italics and display type for emphasis are not to be understood as appearing in the original of any matter quoted.

N. Y., U. S. A." on the cross-bar in front of the keyboard, and with the words and figures "No. 6 REMINGTON STANDARD TYPEWRITER No. 6" on the front of the base, and with the words "This machine is protected by 67 American and foreign patents" on the back. (R. 103, 104.)

The names "REMINGTON" and "REMINGTON STANDARD" and the "RED SEAL" have all been registered in the Patent Office as the trade-marks of complainant's machine, it being asserted that they have been used since the year 1880. (R. 82 and 1487.)

Genesis of the Remington-Sholes Company.—In 1892 Zalmon G. Sholes, a son of Christopher Latham Sholes (the pioneer typewriter inventor), invented a typewriting machine, but being without capital he sought to interest others in its manufacture. In the early part of 1893, The Z. G. Sholes Company was organized under the laws of Wisconsin for this purpose by persons strangers to this litigation and to those connected therewith. (R. 398.) THE STOCK OF SUCH COMPANY WAS NEVER ISSUED, AND NO MACHINE WAS EVER MADE OR SOLD BY IT. (R. 399.)* After various failures to secure capital, Mr. Sholes, in the summer of 1893, met Franklin and Carver Remington (R. 403), sons of Samuel Remington, formerly president of the E. Remington & Sons corporation, and interested them in his new machine. They bought a three-fourths interest in Sholes' inventions from parties to whom he had previously sold, and in order to extinguish the exclusive license to practice

* This court will therefore perceive the error of fact in the opinion of Wheeler, J., in stating that the Z. G. Sholes Company was an Illinois corporation, and that the name of such corporation was changed to Remington-Sholes Typewriter Company.

said inventions theretofore vested in the Z. G. Sholes Company they bought a like interest in the stock of said company, making a written agreement with Sholes (R. 826) that *"no other, further or different business of any kind or nature shall be transacted by said corporation or in its behalf except that the same shall be dissolved,"* etc. Upon acquiring their interest in the Sholes machine, the Remingtons and Sholes endeavored to procure the capital necessary for its manufacture. (R. 403 and 404.)

At the outset both of the Remingtons gave equal attention to the matter, but after the first month Franklin Remington gave his entire time to the promotion of the enterprise (R. 428), and no steps were thereafter taken by Sholes in connection with the machine without consulting with Franklin Remington. (R. 429.) It was Franklin Remington who supplied the money for salaries, for attorneys' fees, for shop rent, for changes in the machine, etc., to the extent of some six or seven thousand dollars beyond his original investment of eight or nine thousand. (R. 413, 430.) After they had labored together for several months, Sholes, without the knowledge of the Remingtons, changed the name of the reconstructed machine from "The Z. G. Sholes" to "The Remington-Sholes." (R. 427.)

As the successful manufacture and sale of their typewriting machine required capital far beyond their slender means, the Remingtons and Sholes sought at various points to enlist others in the enterprise. After repeated failures they at length induced Mr. Charles N. Fay and Mr. Franklin Head of Chicago to furnish the requisite funds to manufacture this new-born Remington-Sholes machine. Most of the typewriting machines upon the market bear the names of the inventors or manufacturers, and are the output of corporations similarly named. In

keeping with this custom the name "Remington-Sholes" was retained for the machine, and the corporation organized in the spring of 1894 for its manufacture was designated the "Remington-Sholes Typewriter Company."

The capital stock of this company (which was afterwards increased) consisted at first of 1,500 shares of the par value of $100 each, and these shares were subscribed for as follows, viz.: Z. G. Sholes, 374 shares; F. Remington, 561 shares; C. Remington, 562 shares, and Norman Hapgood, C. H. Hamill and L. Thompson, one share each. Upon the completion of its organization, the following officers were chosen, viz.: Mr. C. N. Fay, president; Mr. Franklin Head, vice-president; Mr. Franklin Remington, general manager; Mr. Z. G. Sholes, superintendent (R. 434), and Franklin Remington, Carver Remington, Z. G. Sholes and Messrs. Fay and Head, directors. (R. 409.) The company at once purchased the necessary tools and machinery, and its first typewriting machines were placed upon the market in December, 1894. **From the outset and during the first year of the existence of this company its business was managed entirely by Franklin Remington and Z. G. Sholes** (R. 434, 429 and 1105), Mr. Fay being absent most of the time in Europe and elsewhere.

In preparing the machine for the market, modifications and changes were made by Sholes, and these were invariably talked over with Remington and were subject to his approval. (R. 434.) From December, 1894, until it ceased doing business in the fall of 1896, the Remington-Sholes Typewriter Company widely advertised its machines as the "Remington-Sholes Typewriter" (R. 437), and established agencies throughout different parts of this country. During the first year it sold about 1,000

machines (R. 438), and up to December, 1896, about 3,000 or 3,500. (R. 438.)

In the fall of 1896 the Remington-Sholes Typewriter Company had run so in debt that it became necessary to take stens to meet its obligations, and on December 14, 1896, a meeting of the stockholders was held for such purpose. At this meeting 2,356 shares of stock were represented, Mr. Sholes, Mr. F. Remington, Mr. Fay and Mr. Head, with other stockholders, being present and voting. Resolutions were then passed, instructing the secretary to sell at public auction the property and assets of the company, the buyer to have the privilege of using all or any part of the company's corporate name. (R. 839.) On December 19, 1896, in pursuance of such stockholders' resolutions, C. N. Fay purchased in his own name (but as trustee for himself and other stockholders) the whole of the assets of said company, together with its good-will, the exclusive right to use its trade-marks, trade-name, etc., and for several months thereafter (R. 410), and until a reorganization could be effected, carried on the business at the factory formerly occupied by said Remington-Sholes Typewriter Company. (R. 354.)

The charter of the Remington-Sholes Typewriter Company was surrendered in April, 1897. In the same month the Remington-Sholes Company was incorporated under the laws of Illinois, and purchased all the assets, good-will, trade-marks, trade-names, etc., theretofore belonging to said Fay and to said Remington-Sholes Typewriter Company. Since its organization said new company has continued at the same factory and through the same instrumentalities as before used by the old company and by Fay to manufacture and sell its typewriters.

The organization of the Remington-Sholes Company was in purpose and in effect a reorganization of the old

company (R. 410; 431), the plan being to divide the common stock of the new company amongst the stockholders in keeping with the amounts of cash actually invested by them in the old company. The allotment of 150 shares of stock to Franklin Remington was admittedly in keeping with such plan, as he had invested $15,000 cash in the old company. (R. 430; 434.) Z. G. Sholes received no stock in the new company, because, by sales of his stock in the old company, he had already been reimbursed for his expenditures in connection with his original machine. (R. 431-432.)

Distinguishing Marks of Defendant's Machine.—Every machine put upon the market by the old Remington-Sholes Typewriter Company, and its successors, up to the middle of the year 1900 (R. 555) (nearly two years *after* the filing of the bill of complaint) had a highly ornamental, bronzed frame of very unique design. This frame both as to shape and coloring was a radical departure from the conventional plain black enamel frames invariably used upon complainant's and other typewriting machines. The machines made and sold by the defunct Remington-Sholes Typewriter Company were conspicuously marked with the words "REMINGTON-SHOLES, CHICAGO." While Mr. Fay conducted the business in his own name pending the reorganization, the same marks were retained. When the new company took possession of the plant and business, the trade-mark "REM-SHO" was adopted and from that time all of its machines have been marked also upon the cross-bars with the words "REMINGTON-SHOLES COMPANY, MFRS., CHICAGO," The name "REM-SHO" was registered as a trade-mark October 19, 1897.

In June, 1894, complainant protested against the use

of the names "Remington" or "Sholes," "together or singly." (R. 805.) In response to this and other notifications Mr. Remington wrote (R. 1444):

> "The writer and Mr. Sholes invested a great deal of time and money in developing a typewriting machine, fit to compete with your own and other excellent machines already in the market, before organizing this company and inducing others to join us in the business. As a matter of course, at the outset and continuously since, we and our associates have consulted eminent counsel here and in the East, as to both trade-mark and patents, and have, in their judgment and our own, full moral and legal right to enter the old and substantially open field of typewriter manufacture as we have done. We have carefully respected valid patents, and in using our own names, the right to which we had never alienated, we have scrupulously avoided all deception of the public, both in the superficial appearance and construction of our machine, and in all our printed and verbal representations regarding it."

From the very beginning of its business and even before actually placing its machines upon the market, the Remington-Sholes Typewriter Company advertised conspicuously and in divers ways the fact that its machine "was not the Remington Standard Typewriter" and that it had no connection with complainant or its machine, and the salesman and dealers were invariably instructed to guard carefully against all danger of possible confusion between the two companies and their respective machines. (See, for example, R. 439; 1258; 306; 440; 1041; 1142; 1169; 1262; 1278; 1309; 1322; 1331.) All of the catalogues circulated by defendant (and these catalogues have been distributed broadcast throughout the country) contained in connection with the history of defendant's machine the following statement:

> **"We state then emphatically that this com-**

pany has no connection whatever with that well known and excellent machine, the Remington Standard Typewriter, and caution all possible customers against confusing the 'Rem-Sho' with that machine or any other."

German Litigation.—No litigation was brought by complainant against this defendant or its principal until the filing of this suit in September, 1898, more than four years after the protest of June, 1894. But while the machine manufactured by the old Remington-Sholes Typewriter Company and marked with the words "Remington-Sholes, Chicago," were being sold in Germany by one Henry Newald, a suit was brought there against him by complainant's agents Glogowski & Co. (R. 219), by whom the name "Remington" had been registered in the German Patent Office as a trade-mark for typewriting machines. **The case went from the lower courts to the German Imperial Supreme Court and it was there held that in view of the history of the Remington-Sholes Typewriter Company the name "Remington-Sholes" could be properly and lawfully used upon machines of its manufacture.** (R. 29 and 1433.)*

Errors in the Decree of the Circuit Court.

The findings of the Circuit Court in paragraphs 1 and 2 of its decree (R. 1501) are believed to be in error because misleading. It is doubtless true, as admitted by defendant's answer, that to a large extent complainant's machine has become known by the single name "Remington," but it is not true in fact that by that name *alone* it has become universally known, designated or identified.

* A translation of the opinions of the German Courts follows at the end of this brief.

The bill of complaint alleges (R. 4, 6, and elsewhere) that complainant's machine is "known and distinguished in the trade generally and by all purchasers and intending purchasers and users of typewriting machines by said trade-marks and trade designations 'REMINGTON' and 'REMINGTON STANDARD.'" Again, in the assignment from E. Remington & Sons it is stated that the machine is known and designated "more generally as the "STANDARD REMINGTON TYPEWRITER" (R. 717), and complainant's own witnesses repeatedly designate the machine as the "REMINGTON STANDARD." (See *e. g.*, R. 158; 347; 375; 468; 480; 313, etc.) The fact also that the name "REMINGTON STANDARD" and the "RED SEAL" trade-mark and the manufacturer's name and address have been invariably marked upon all machines of complainant and its predecessors for more than twenty years must reasonably raise the presumption that the public has in a measure at least come to recognize these (as well as the word "Remington") as distinguishing marks of such machines.

Yet in the face of these facts and of the further fact that the attempt to prove by *selected* advertisements the general use of the name "Remington" alone was exposed on cross-examination (R. 223), counsel apparently succeeded in misleading the circuit court into the finding that the name "Remington" was the *sole* designation by which the public identified complainant's machine.

The finding of paragraph 5 of the decree that defendant has been guilty of a fraudulent invasion of complainant's rights; the injunction decreed in paragraphs 8 and 9, and the order awarding costs to complainant in paragraph 10, being in disregard of the facts of the case and of the law applicable thereto, constituted the main basis of the appeal from the Circuit Court.

A further specific ground of the appeal (R. 1511-1513) was the error of the Circuit Court in denying defendant's motion to suppress a mass of testimony and exhibits introduced on behalf of complainant, said motion appearing at R. 1440-1441.

The errors of fact occurring in the opinion of his Honor, Judge Wheeler, are adverted to in subsequent parts of this brief.

Errors Noted by Petition for Certiorari.

The order of the Circuit Court of Appeals (R. 1534), conforming to the majority opinion of such court, is as follows:

> "On consideration whereof, it is now hereby ordered, adjudged and decreed that the decree of said Circuit Court be and it hereby is reversed without costs, and cause remanded with instructions to decree in favor of complainant only as to the name 'Remington.'"

This decree is believed to be in error in the following respects:

First: In that, in disregard of the facts and of the law of the case, it forbids the use by defendant of the name "Remington" in the corporate name of its principal, the Remington-Sholes Company.

Second: In that it fails to order the dismissal of the bill and to tax complainant with the costs of the suit.

Third: It was also manifest error for the Court of Appeals to disregard, as it did, defendant's motion to suppress testimony, as such matter was properly presented to that court by the appeal.*

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*The testimony sought to be suppressed related in part to certain hearsay depositions, but more especially to a mass of exhibits showing

Error Alleged by Cross Petition for Certiorari.

The cross petition for certiorari raises the single question as to whether or not the Court of Appeals erred in refusing to enjoin defendant from using the name REM-SHO in connection with its typewriting machines.

BRIEF OF ARGUMENT.

I.

A personal name, such as the name "Remington," is incapable of exclusive appropriation, and its registration in the Patent Office cannot render it a valid trade-mark.

Singer Mfg. Co. v. *June Mfg. Co.*, 163 U. S., 169.
Brown Chemical Co. v. *Myer*, 139 U. S., 540.
McLean v. *Fleming*, 96 U. S., 245.
Columbia Mill Co. v. *Alcorn*, 150 U. S., 460.
Harson v. *Halkyard* (Sup. Ct. R. Is.), 46 At. Rep., 271.
Jamieson & Co. v. *Jamieson & Co.*, 15 R. P. C., 169.
Elgin National Watch Co. v. *Illinois Watch Case Co.*, 179 U. S., 665.
Sarrazin v. *Irby Co.*, 93 Fed. Rep., 625 (C.C.A.).
Brower v. *Boulton*, 52 Fed. Rep., 389.

advertisements in foreign countries by admittedly independent dealers who purchased Rem-Sho machines from an independent German Company. This testimony is considered in a subsequent part of this argument under the head of "Foreign advertisements and acts by persons over whom defendant and its principal had no control."

II.

"A man's name is his own property and he has the same right to its use and enjoyment as he has to that of any other species of property," the only restriction imposed by this court upon the use of a personal name being that it shall be "a reasonable, honest and fair exercise of such right."

Brown Chemical Co. v. *Myer, et al., supra.*
McLean v. *Fleming, supra.*
Singer Mfg. Co. v. *June Mfg. Co., supra.*

III.

To a personal name (or like generic name) no secondary signification can attach that will diminish the right of any one bearing such name to use it in every honest way and for every legitimate purpose; and where a personal or generic name has acquired a secondary signification, the most that can be required of a person having a right to use such name is that he shall accompany its use "with such indications as to show that the thing manufactured is the work of the one making it."

Singer Mfg. Co. v. *June Mfg. Co., supra.*
Holzapfel Co. v. *Rahtjens Co.*, 183 U. S., 1.
Baker v. *Baker*, 115 Fed. Rep., 297.
Duryea et al. v. *National Starch Manfg. Co.*, 79 Fed. Rep., 651.

IV.

In cases like that at bar, the ground of relief is the injury to a complainant by the passing off of defendant's wares for those of complainant, and where a complainant invariably marks his wares with his name and address (*e. g.*, Wyckoff, Seamans & Benedict, Ilion, N. Y.) and

with a designating mark (*e. g.*, "REMINGTON STANDARD TYPEWRITER"), the fact that a defendant has invariably marked *his* wares with his name and address (*e. g.*, Remington-Sholes Company, Mfrs. Chicago) and with a different distinctive mark (*e. g.*, "REM-SHO"), is most persuasive of the absence of any intent to pass off his wares as and for complainant's.

Goodyear Rubber Co. v. *Goodyear Rubber Mfg. Co.*, 128 U. S., 598.

Elgin National Watch Co. v. *Ills. Watch Case Co., supra.*

Singer Mfg. Co. v. *June Mfg. Co., supra.*

Holzapfel Co. v. *Rahtjens Co., supra.*

Corbin v. *Gould*, 153 U. S., 328.

Coats v. *Merrick Thread Co.*, 149 U. S., 562.

Lorillard v. *Peper*, 86 Fed. Rep., 956.

Kahn et al. v. *Diamond Steel Co.*, 89 Fed. Rep., 706.

Proctor & Gamble Co. v. *Globe Ref. Co.*, 92 Fed. Rep., 357.

Dadirrian v. *Yacubian et al.*, 98 Fed. Rep., 872.

Sebastian on Trade Marks (4th Ed.), 123.

V.

The issuance of cautionary circulars (such as defendant has widely distributed to call attention to the fact that it "has no connection whatever with that well-known and excellent machine, the Remington Standard Typewriter, etc.") is recognized by the courts as clearly repugnant to any purpose to palm off defendant's wares for complainant's.

Goodyear Rubber Co. v. *Goodyear Rubber Mfg. Co., supra.*

Singer Mfg. Co. v. *June Mfg. Co., supra.*

Hazelton Boiler Co. v. *Hazelton Tripod Boiler Co.*, 142 Ill. Sup., 494.

Genesea Salt Co. v. *Burnap*, 73 Fed. Rep., 818.

VI.

The decisions are uniform in holding that where the name or mark adopted by a defendant is sufficiently different from that employed by a complainant to enable the ordinary purchaser, using reasonable care, to distinguish defendant's from complainant's goods, no injunction will issue. The name "Sholes" amply differentiates the compound names "Remington-Sholes" and "Remington-Sholes Company" from the single name "Remington."

Liggett & Myers Co. v. *Finzer*, 128 U. S., 182.

Proctor & Gamble Co. v. *Globe Ref. Co.*, *supra.*

Coats v. *Merrick Thread Co.*, *supra.*

Meneely v. *Meneely*, 62 N. Y., 427.

Corbin v. *Gould*, *supra.*

Lorillard v. *Peper*, *supra.*

VII.

The courts have uniformly recognized that a man's use of his name in a firm name is a reasonable, honest and legitimate use.

Meneely v. *Meneely*, *supra.*

Same v. *Same*, 1 Hun., 367.

National Starch Mfg. Co. v. *Duryea et al.*, 101 Fed. Rep., 117.

Same v. *Same*, 79 Fed. Rep., 651.

Gilman v. *Hunnewell*, 122 Mass., 139.

English et al. v. *N. Y. Pub. Co.*, 8 Daly (N. Y.), 375.

Marcus Ward & Co. v. *Ward et al.*, 15 N. Y. S., 913 (61 Hun., 625).

Burgess v. *Burgess*, 3 DeG. M. & G., 896.

VIII.

It being a general custom to employ personal names for corporations, no distinction can be made between the use of such names in a firm and in a corporation, since in both cases the names adopted are selected and artificial.

Goodyear Rubber Co. v. *Goodyear Rubber Mfg. Co., supra.*

Baker v. *Baker,* 115 Fed. Rep., 297 (303).

Celluloid Mfg. Co. v. *Cellonite Mfg. Co.,* 32 Fed. Rep., 94.

Monarch v. *Rosenfeld et al.,* 39 S. West. Rep., 236 (19 Ky. Law Rep., 14).

Am. Cereal Co. v. *Eli Pettijohn Cereal Co.,* 72 Fed. Rep., 903.

Hazelton Boiler Co. v. *Hazelton Tripod Boiler Co.,* 142 Ill. Sup., 494.

Scott Stamp & Coin Co., Limited, v. *J. W. Scott Co., Limited,* 15 N. Y. S., 325 (58 N. Y. Super. Ct., 379).

Employers' Etc., Co. v. *Employers' Etc., Co.,* 10 N. Y. S., 845 (61 Hun., 552).

IX.

The courts recognize that the business of a corporation or of a firm in which a man has his capital invested, and to which he devotes his whole time and energy is HIS business, and that he has a right to use his name in connection therewith.

Meneely v. *Meneely et al., supra.*

Natl. Starch Co. v. *Duryea et al., supra.*

Monarch v. *Rosenfeld, supra.*

Scott Stamp & Coin Co., Limited, v. *J. W. Scott Co., Limited, supra.*

Hazelton Boiler Co. v. *Hazelton Tripod Boiler Co., supra.*

X.

Although it is true that there is no *necessity* for a man engaged in a corporation or in a firm to employ his name in connection therewith—since both firm and corporate names are alike artificial—this lack of necessity for using a personal name cannot affect the individual's *right* to so use it, because such use is a universally recognized legitimate and reasonable use of a personal name.

Meneely v. *Meneely, supra.*

Turton & Sons v. *Turton & Sons*, 42 Ch. D., 128.

Continental Ins. Co. v. *Continental Ass'n.* 96 Fed. Rep., 846.

Chivers & Sons v. *Chivers & Co.*, 17 R. C. P., 420.

XI.

The decisions recognize family reputation as a valuable heritage and as an ample reason for the use by a man of his name in the selection of a firm name and in its business. In the case at bar defendant has never imitated complainant's signs, labels or other indicia, nor trespassed upon its good will (which complainant *owns*), but has simply availed in an honest way of the family reputation (*which complainant does not own*) of Mr. Franklin Remington, the general manager of the Remington-Sholes Company.

Meneely v. *Meneely, supra.*

Natl. Starch v. *Duryea et al., supra.*

Gilman v. *Hunnewell, supra.*

See German decisions regarding name "Remington-Sholes" at the end of this brief.

XII.

Where a name is incapable of exclusive appropriation —like the name Remington—a court will not destroy the right of another to use such name but will direct its injunctive process against the specific abuse of the right, if any such has occurred. The sweeping decrees of the lower courts in the case at bar are therefore manifestly in error.

Singer Mfg. Co. v. *June Mfg. Co., supra.*

Meriden Brittania Co. v. *Parker,* 12 Am. Rep., 401 (39 Conn., 450).

Ill. National Watch Co. v. *Ill. Watch Case Co., supra.*

XIII.

That defendant in the case at bar has not been guilty of any unfair trade competition (unless the use of the name "Remington-Sholes" be so regarded) is conclusively established by the record and has been unanimously so held by the Circuit Court of Appeals (R. 1522) in the following language:

> "We do not find in this voluminous record sufficient evidence that defendant (by which name the Remington-Sholes Company is designated in the opinion) has itself done anything to promote confusion in the minds of the public, except to use the name 'Remington' on its machines and in its literature."

XIV.

The record in this case being devoid of any showing that there has ever been any deception or mistake or injury to complainant by reason of the use of the name "REM-SHO," this court will not disturb the unanimous finding of the Court of Appeals allowing defendant's right to use such fanciful name.

ARGUMENT.

The charges of the bill of complaint may be summarized as follows:

(*a*) That defendant has been guilty of wrong-doing by infringement upon complainant's alleged trade-mark "Remington," registered in the U. S. Patent Office October 23, 1888.

(*b*) That the organizers of the Remington-Sholes Company were guilty of fraudulent invasion of complainant's rights in the organization of such company and in the adoption of its corporate name.

(*c*) That the Remington-Sholes Company and defendant have been guilty of unfair trade competition by the manner in which they have marked their machines and placed the same before the public.

Complainant's claim to relief in this case is dependent upon the character of its right to the use of the name "Remington." The questions, therefore, that confront this court are: (1) Does this name constitute a valid trade-mark and has the complainant the exclusive right thereto; or, is the name "Remington" one incapable of exclusive appropriation? (2) If the name is not a valid trade-mark, what right, if any, has complainant with respect thereto and to what relief does such right entitle it? (3) Has defendant been guilty of trespass upon any right that complainant may possess?

A correct determination of these questions will be aided by keeping in mind the unanimous conclusion of the Court of Appeals (R. 1522) that "we do not find in this voluminous record sufficient evidence that defendant" (by which name the

Remington-Sholes Company is designated) "has itself done anything to promote confusion in the minds of the public, except to use the name 'Remington' on its machines and in its literature."

That a personal name cannot be exclusively appropriated by anyone as against others having a right to use such name, is conclusively settled by the repeated decisions of this court.

Brown Chemical Co. v. *Myer et al.*, 139 U. S., 540.

McLean v. *Fleming*, 96 U. S., 245.

Canal Co. v. *Clark*, 13 Wall., 311.

Singer Mfg. Co. v. *June Mfg. Co.*, 163 U. S., 169.

Elgin Nat'l Watch Co. v. *Illinois Watch Case Co.* 179 U. S., 665.

Goodyear Rubber Mfg. Co. v. *Goodyear Rubber Co.*, 128 U. S., 598.

Nor is the fact that a complainant asserts an exclusive right to a personal name, in part, at least, because of its registration as a trade-mark in the U. S. Patent Office of any moment, as the authorities are uniform in holding that registration cannot add to a complainant's right to relief nor give validity to an otherwise invalid trade-mark.

Elgin Nat'l Watch Co. v. *Illinois Watch Case Co., supra.*

Sarrazin v. *Irby Co.*, 93 Fed. Rep., 625 (C. C. A.)

The name "Remington" being an ordinary family surname, was manifestly incapable of exclusive appropriation as a valid trade-mark, and the registration of such mark in the Patent Office can confer no rights upon the complainant.

The contention of counsel for complainant that the name "Remington" has acquired "a secondary meaning," and that for this reason complainant is entitled to appropriate it, is without force. The books will be searched in vain for any case (except that of the lower court in the English case of *Cash* v. *Cash,* 18 R. P. C., 212) in support of the contention that a monopoly in a personal name can be created by any secondary meaning that may have attached thereto. The latest case before the English Court of Appeals involving the right to the use of a personal name, was the appeal of this case of *Cash* v. *Cash* (reported in Times Law Reports, N. 13, Vol. 18, p. 299, Feb., 1902). In that case the lower court by Kekewich, J., had enjoined the defendant Cash, who was doing business under the name of "Joseph Cash & Company," from selling frillings under this name or under the name of Cash, because the name "Cash" had become so associated with complainant's frillings that confusion of trade was inevitable. This decision of Kekewich, J., which is cited in Kerly on Trade-Marks, p. ii, "as a striking illustration . . . of the tendency to abandon rules which were formerly assumed as settled principle," caused that learned author to express the "hope that the question how far the rule that a man may under all circumstances, honestly use his own name, for which *Burgess* v. *Burgess* has been cited for more than forty years, is now to be relied on, will before long be considered by the highest tribunal." The Court of Appeals after reversing this sweeping order of the lower court said, in speaking by Williams, L. J.:

> "It may be that a trade is of such a nature that the products of that trade, associated with a particular trade name, have become almost indissolubly connected with the business carried on by the particular

> manufacturer who has created that particular business. But still, even though that may be so, and even though the nature of the trade has to be taken into consideration in an action for an injunction, there never has been a case yet where an order has been made restraining a man altogether from carrying on in his own name a particular trade. Every decision up to the present time has been limited to restraining him from carrying on a trade which has thus become so identified with the business of another person, without taking the steps which any honest man would wish to take to prevent his goods being confounded with the other person's goods which have become so identified with the name."

A further conclusive answer to the contention that the name "Remington" is susceptible of exclusive appropriation because it is said to have acquired a "secondary meaning" is, *first,* that the wrong complained of is defendant's alleged attempt to pass off its machine as one "made by a Remington," or by a company comprising a Remington; *second,* that the witnesses (Weingart, Stallwood *et al.*) produced to show that they were misled by the name "Remington," all state that they relied upon the name Remington as indicating that the machine was *made by the Remingtons.* Indeed, the vehemence with which complainant attacks as fraud any assertion by defendant as to the connection of a Remington with the manufacture of the "Rem-Sho" is irreconcilable with any pretense that such name has acquired a secondary or non-descriptive meaning.

On the other hand, if it be admitted that the name "Remington" has acquired a secondary meaning, and does not convey the idea that there is any one of that name connected with the manufacture of complainant's machines, it is not seen how it is possible that the word with such meaning can be confounded with words which

unmistakably announce that defendant's machines are made by the Remington-Sholes Company of Chicago. Obviously, there is no "secondary meaning" conveyed by the name Remington in the manner in which it is used by defendant, this name being invariably associated with the purely personal name "Sholes" in the name Remington-Sholes Company and being designed, as the Supreme Court said in *Goodyear Rubber Co.* v. *Goodyear Rubber Co., supra,* to indicate that the parties (in this case Remington and Sholes) "have formed an association or partnership."

The Restrictions Upon the Use of a Personal Name. —This court has had occasion in a number of cases to state in no uncertain language what restrictions pertain to the use of personal or other names incapable of exclusive appropriation.

Thus, in *McLean* v. *Fleming*, 96 U. S., 245, in affirming a man's right to his own name as against another of *different* name, and after citing the leading case of *Meneely et al.* v. *Meneely*, 62 N. Y., 427, and others, it was said:

> "He cannot have such a right even in his own name as against another person of the same name, unless such person uses a form of stamp or label so like that used by the complaining party as to represent *that the goods of the former are of the latter's manufacture*. . . . Colorable imitation which requires careful inspection to distinguish the spurious trade-mark from the genuine is sufficient to maintain the issue; but a court of equity will not interfere, when ordinary attention by the purchaser of the article would enable him at once to discriminate the one from the other."

In *Brown Chemical Company* v. *Myer et al.*, 139 U. S., 540, plaintiff adopted as a trade-mark for its medicine

the words "Brown's Iron Bitters," and the defendants used upon their medicine the words "Brown's Iron Tonic." This court, after commenting upon the descriptive character of the words "Iron Tonic," and confirming the defendant's right to the use of these, said:

> "It is hardly necessary to say that an ordinary surname cannot be appropriated as a trade-mark by any one person as against others of the same name who are using it for a legitimate purpose; although cases are not wanting of injunctions to restrain the use, even of one's own name, where a fraud upon another is manifestly intended or where he has assigned or parted with his right to use it."

And after citing numerous authorities and quoting at length from the leading case of *Croft* v. *Day*, 7 Beav., 84, the court adds:

> "These cases obviously apply only where the defendant adds to his own name *imitation of the plaintiff's labels, boxes or packages*, and thereby the public are induced to believe that his goods are those of the plaintiff. A man's name is his own property, and he has the *same right* to its use and enjoyment, as he has to that of any other species of property. If such use be a reasonable, honest and fair exercise of such right, he is no more liable for the incidental damages he may do a rival in trade, than he would be for an injury to his neighbor's property by the smoke issuing from his chimney, or for the fall of his neighbor's house by reason of necessary excavations upon his own lands. These and similar instances are cases of *damnum absque injuria*."

In *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S., 169, the law is thus stated:

> "Although every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidently interfere with and injure the business of another having the same name, in such case the inconvenience or loss to which those

having a common right are subjected is *damnum absque injuria*, but although he may thus use his name he cannot resort to any artifice, or do any act calculated to mislead the public as to the identity of the business, firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name."

In *Goodyear Rubber Mfg. Co.* v. *Goodyear Rubber Co.*, 128 U. S., 596, attempt was made to restrain defendant from using its corporate name. In reversing the decision of the Circuit Court it was said:

> "The case at bar cannot be sustained as one to restrain unfair trade. Relief in such cases is granted only where the defendant, by his marks, signs, labels, or in other ways, represents to the public that the goods sold by him *are those manufactured or produced by the plaintiff*, thus palming off his goods for those of a different manufacture, to the injury of the plaintiff. *McLean* v. *Fleming*, 96 U. S., 245; *Sawyer* v. *Horn*, 4 Hughes, 239; *Perry* v. *Truefitt*, 6 Beavan, 66; *Croft* v. *Day*, 7 Beavan, 84."

Again, in *Illinois National Watch Co.* v. *Illinois Watch Case Co.*, 179 U. S., 665, this court used the following pertinent language, viz.:

> "But it is contended that the name 'Elgin' had acquired a secondary signification in connection with its use by appellant, and should not, for that reason, be considered or treated as merely a geographical name. It is undoubtedly true that where such a secondary signification has been acquired, its use in that sense will be protected by **restraining the use of the word by others in such a way as to amount to a fraud on the public and on those to whose employment of it the special meaning has become attached.** . . .
>
> "If a plaintiff has the absolute right to the use of a particular word or words as a trade-mark, then, if an infringement is shown, the wrongful or fraud-

ulent intent is presumed, and although allowed to be rebutted in exemption of damages, the further violation of the right of property will nevertheless be restrained. But where an alleged trade-mark is not in itself a good trade-mark, yet the use of the word has come to denote the particular manufacturer or vendor, **relief against unfair competition or perfidious dealing will be awarded by requiring the use of the word by another to be confined to its primary sense by such limitations as will prevent misapprehension on the question of origin."**

Centaur Co. v. *Marshall*, 97 Fed. Rep., 785 (C. C. A.).

In *Meriden Brittania Co.* v. *Parker*, 12 Am. Rep., 401 (39 Conn., 450), the court granted an injunction as to the infringing marks, but refused to enjoin defendant against the use of the name "Rogers." In a valuable note at the end of that case the reporter very clearly sums up the result of the authorities as follows:

"A man has a right to the free and unrestricted use of his own name in trade or manufacture notwithstanding another of the same name may have previously set up the same business in the same locality and acquired a celebrity for his goods, unless the former in connection with his own name use some mark or device that has become the property of the latter, or is otherwise guilty of affirmative acts designed to deceive the public and induce them to believe that the goods of the former are the goods of the latter, **and in such cases the use of such mark or device, or the practice of such acts, will be restrained but not the use of the name."**

The foregoing and numerous other authorities conclusively establish the following propositions:

First, that no one can have an exclusive right to, or a valid trade-mark in a personal name as against others of the same name.

Second, that where the name is one incapable of exclusive appropriation,

> "relief against unfair competition or perfidious dealing will be awarded by requiring the use of the word by another to be confined to its primary sense by such limitations as will prevent misapprehension on the question of origin."

Third, that a person may not in the use of his name resort to any artifice or fraud for the purpose of palming off his wares upon the public for those of his rival.

Your Honors will notice that the decrees of the Circuit Court and of the Circuit Court of Appeals in this cause, in the absence of any imitation of the characteristic marks of complainant's machine and in the face of the fact that defendant's machines are distinctly marked with the manufacturer's name and address, *without qualification or reservation*, enjoin defendant from the use of the personal name "Remington" in *any manner whatsoever* upon typewriting machines, the injunction being more particularly directed against the placing upon typewriting machines of the inscription "REMINGTON-SHOLES COMPANY, MFRS., CHICAGO."

Plainly these sweeping decrees are repugnant to the decisions of this court, since such decrees are not directed to the *correction* of any supposed *abuse* of the right to use the personal name, but to the entire *extinction* of such right.

If this court find that defendant, under the circumstances of this case, had no right whatever to use the words "Remington-Sholes" in *any manner*, and that the use of such words violate complainant's rights, then the decree of the Court of Appeals was obviously correct; but, if the finding be that the wrong of the defendant consisted in some particular way in which these words were used,

then the decree of that court with respect to such words was plainly wrong, because it should have been directed, not to the extinction of defendant's right to use the words at all, but to the correction of any abuse that may have been made of such right. It is the province of a court of equity to correct the abuse of a right—not to destroy it.

What is Required of a Defendant.—Nor do the decisions of this court leave any room for doubt as to the means to be employed by a defendant in distinguishing his wares from those of another.

In *Singer Mfg. Co.* v. *June Mfg. Co., supra,* as in the case at bar, complainant's machine, which was designated by a surname, had been protected by many patents, the most important of which had expired. Complainant's machines not only bore the name "Singer," but also a distinctive trade-mark stamped upon a brass label of oval shape attached to the base of the arm of the machine. Defendant marked its machines with the name "Singer" and extensively advertised them as "Improved Singer Sewing Machines," "The Improved Singer," etc., but as all its circulars and advertisements contained the statement that its machines were manufactured by the defendant, the court held that such were fair and proper. The name "Singer," as used by complainant during the life of the controlling patents came, as the court found (p. 183), "to indicate in its primary sense to the public the class and type of machines made by the Singer Company or corporation," although this name "also came in a secondary sense to convey to the public mind the machines made by the firm or corporation." The court held that upon the expiration of the controlling patents the right to use the name "Singer" in every form passed to the public, saying, also, "nor is this right governed by

different principles where the name that has become generic, instead of being an arbitrary one, is the name of the patentee or original manufacturer." After a lengthy consideration of the authorities of this and foreign countries, it was said:

> "The result, then, of the American, the English and the French doctrine universally upheld is this, that where, during the life of a monopoly created by a patent, a name, whether it be arbitrary or be that of the inventor, has become, by his consent, either express or tacit, the identifying and generic name of the thing patented, this name passes to the public with the cessation of the monopoly which the patent created. Where another avails himself of this public dedication to make the machine and use the generic designation, he can do so in all forms, with the fullest liberty, by affixing such name to the machines, by referring to it in advertisements and by other means, subject, however, to the condition that the name must be so used as not to deprive others of their rights or to deceive the public, and, therefore, that the **name must be accompanied with such indications that the thing manufactured is the work of the one making it, as will unmistakably inform the public of the fact.**"

The court, when considering defendant's machines, says:

> "There was an entire failure on the part of the defendant to accompany the use of the word 'Singer' on the machines made and sold by him with sufficient notice of *their source of manufacture*, to prevent them from being bought as machines made by the Singer Mfg. Co., and thus operate an injury to private rights and a deceit upon the public."

And, after commenting upon the fraudulent imitations by defendant of peculiar marks, etc., of complainant's machine (p. 201), the court adds (p. 203):

> "The right to use the word 'Singer' which caused

> the imitative infringement in the device, being lawful, it is plain that **the infringement only resulted from the failure to plainly state along with the use of that word the source of manufacture,** and therefore this branch of the question is covered by the same legal principle by which we have determined the other. It follows, therefore, that the judgment below, which recognized the right of the defendant to make or vend sewing machines in the form in which they were made by him—that is, like unto the machines made upon the principles of the Singer system—with the use of the word 'Singer,' **without a plain and unequivocal indication of the origin of manufacture,** was erroneous."

Again, this court, in *Holzapfel Co.* v. *Rahtjens Co.*, 183 U. S., 1, recognized that defendant fulfilled its duty, in distinguishing its goods from those of complainant, when they were plainly described as of defendant's manufacture.

The following comparison of the respective marks upon complainant's and defendant's machines show how fully defendant has complied with the requirements fixed by this court:

COMPLAINANT'S MARKS.	DEFENDANT'S MARKS.
Remington.	REM-SHO.
Large Red Seal.	REMINGTON-SHOLES CO., MFRS., CHICAGO.
Remington Standard Typewriter, Manufactured by Wyckoff, Seamans & Benedict, Ilion, N. Y., U. S. A.	
Remington Standard Typewriter.	

The marking of its machines by a defendant with its name and address is uniformly recognized by the courts as one of the strongest indications of the absence of fraudulent intent to confound its business with that of a

complainant. The distinct manner in which the Remington-Sholes Company has marked its machines with its name and address and with the name Rem-Sho (see R. 1458), must clearly differentiate such machine in the public mind from complainant's, all of which are marked with its name and address, even if the omission of all the characteristic marks of complainant's machine, its Red Seal, etc., were not ample for this purpose.

In the recent case of *Baker* v. *Baker*, 115 Fed. Rep., 297, the Court of Appeals for the Second Circuit said with respect to defendant's corporate name, which was "William H. Baker, Syracuse, N. Y.":

> "A part of that name is the place of business, and every person who deals with the defendant is thereby notified that its business domicile is not the domicile of the complainant."

In Sebastian on Trade-Marks (4th Ed.), 123, the author, after citing many authorities to the point, summarizes the law as follows:

> "On the other hand, if the defendant uses on the goods which he is alleged to be endeavoring to pass off as the plaintiff's, a distinct and obvious trade-mark" (*e. g.*, "Rem-Sho") "or if he states plainly and in fair size and clear type that such goods are in fact manufactured by himself" (*e. g.*, "Remington-Sholes Company, Mfrs. Chicago") "there is a strong indication that the defendant has no intention of attempting deception."

In the case of *P. Lorillard* v. *Peper*, 86 Fed. Rep., 956 (C. C. A.), Mr. Justice Brewer said:

> "The two principal ways by which an article is distinguished in trade are, *first* the name of the manufacturer; *second* the descriptive name."

Corbin v. *Gould*, 133 U. S., 308.

Coats v. *Merrick Thread Co.*, 149 U. S., 562.

Kahn et al. v. *Diamond Steel Co. et al.*, 89 Fed. Rep., 706.

Proctor & Gamble Co. v. *Globe Refining Co.*, 92 Fed. Rep., 357.

Duryea et al. v. *National Starch Manfg. Co.*, 79 Fed. Rep., 651.

Dadirrian v. *Yacubian et al.*, 98 Fed. Rep., 872.

Singer Manfg. Co. v. *June Manfg. Co., supra.*

Precautions of Remington-Sholes Company and its Predecessors to Avoid Possible Confusion.—The record shows that since the organization of the old Remington-Sholes Typewriter Company every precaution has been adopted to guard against the possibility of any confusion existing in the public mind with respect to said company or its successors.

At the very outset the old Remington-Sholes Typewriter Company adopted for its machine a highly ornamental, bronzed frame widely differing in appearance from the conventional black enameled, plain frame common to complainant's and other machines. To any one familiar with the typewriting machines on the market this radical difference in appearance must necessarily have differentiated defendant's machine from all others.

On June 25, 1894, and before the Remington-Sholes Typewriter Company had placed its machines upon the market, complainant notified said company (R. 805) that it claimed the exclusive right to use the name "Remington" and the name "Sholes" in any manner, together or separately, in connection with typewriting machines or with a corporation organized for their manufacture. As Mr. Sholes states (R. 439 and 440), it was not the purpose of the Remington-Sholes Typewriter Company to allow confusion to arise, but in the face of this warning

it was natural that extreme precaution should be adopted. At the outset, therefore, it plainly announced upon its store window, in its catalogues and in its advertisements (R. 439 and R. 1358) that it was "NOT the Remington Standard." And with regard to this even complainant's witness Crandall admits:

> "The expression is familiar to me as one used by the Remington-Sholes people either in circular matter or as a sign." (R. 306.)

Again, while the Record shows that it has been complainant's practice to conspicuously display upon its store windows, signs, stationary, catalogues, etc., its Red Seal trade-mark, its full name, Wyckoff, Seamans & Benedict and the name Remington Standard Typewriter, an examination of defendant's exhibits (R. 1445-1452) must at once make plain how unlike these in every respect are the signs, the stationary, and the whole literature of defendant.

The record also shows that it has been the uniform practice of the Remington-Sholes Typewriter Company and its successors to instruct their salesmen to explain fully the origin and history of the machine to prospective purchasers so that no possible doubt could exist with respect to its entire independence of complainant. (R. 440; R. 1041, 1142, 1169, 1262, 1278, 1309, 1322, 1331.) Moreover, the various offices of the Remington-Sholes Company, of defendant and of all persons handling the "Rem-Sho" machine have been supplied with "Rem-Sho" catalogues conspicuously displayed and given out to inquirers and prospective purchasers. The free and general manner in which these catalogues have been distributed appears from both complainant's and defendant's

testimony. In these catalogues the following statement occurs:

"IN REGARD TO OUR NAME. The question is often asked, 'What connection has the Remington-Sholes Company with the Remington Standard Typewriter?' We answer, none whatever. The 'Rem-Sho' Typewriter is manufactured by the Remington-Sholes Company in Chicago, Ill., U. S. A. It originated in the brain of Mr. Zalmon G. Sholes, a son of the original inventor of the Remington Standard Typewriter. In 1893 Mr. Sholes came to Mr. Remington, a son of the original manufacturer of the well-known typewriter which bears his name, and laid his plans and the results of his work before him. The two formed a partnership, and began at once to develop the typewriter with which they are now identified. Later, a company was formed of strong capitalists to manufacture the machine and put it on the market, since when it has been tested by four years' use and the Nos. 2, 3, 4 and 5 Models brought out under the personal supervision of Mr. Fay.

"We state then, emphatically, that this Company has no connection whatever with that well known and excellent machine, the Remington Standard Typewriter, and caution all possible customers against confusing the 'Rem-Sho' with that machine or any other.

"We are sometimes asked about the right of the Messrs. Remington and Sholes to the use of their own names in connection with typewriters. In answer we would say that the law is absolutely clear that every man has a right to use or permit the use of his own name (which is his birthright) in business, provided it is so used as not to deceive. In order to prevent deception *absolutely*, we have made our machine, in finish and outward appearance, entirely unique, and in all public advertisements, signs, marks and statements, we are careful to set forth that it must not be confounded with any other. This is in accordance with law and good faith, and

renders our use of these names morally and legally unassailable."

It is idle for complainant's counsel to pretend that there is any ambiguity or uncertainty about this cautionary notice. A reference to the "Remington Standard Typewriter" identifies complainant's machine more certainly than any other name could do—more certainly by far than any mere reference to complainant by its corporate name, since it gives the true name of complainant's machine, the name that it has registered as a trade-mark in the Patent Office (R. 1487), the name by which the machine was designated in the assignment from E. Remington & Sons (R. 717), and the name that has appeared upon every machine that has issued from complainant's factory.

If it be true that Messrs. Remington and Sholes had the right to use their names like other individuals (and as this court has said, "the same as other property"), and to organize a corporation in keeping with modern business methods, can one conceive of any more fair or scrupulously honest means that could have been adopted to guard against all possibility of trade confusion than the widespread distribution of these circulars?

It is simply inconceivable that any purpose to confound its name or its machine with that of complainant could have existed in view of the persistent and constant statements to the contrary and in the face of the fact that every one of its machines is conspicuously marked with the name "REM-SHO" and the words "REMINGTON-SHOLES COMPANY, MFRS., CHICAGO," and in face of the further fact that its machine differed so radically in appearance from complainant's.

In *Goodyear Rubber Mfg. Co.* v. *Goodyear Rubber Co.*, 128 U. S., 598, a case similar in many respects to that here presented, the following pertinent language was used (p. 604):

> "There is no proof of any attempt of the defendant to represent the goods manufactured and sold by it as those manufactured and sold by the plaintiff; but, on the contrary, **the record shows a persistent effort on its part to call the attention of the public to its own manufactured goods, and the places where they are to be had, and that it had no connection with the plaintiff.**"

In *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S., 169, this court said (p. 200), in considering the manner in which defendant had used the name "Singer":

> "This leaves only two questions, first, whether that name as used in the circulars and advertisements of the defendant is accompanied with such plain information as to the source of manufacture of the machines by them made as to make these circulars and advertisements lawful; and, second, whether this also is the case with the use of the word 'Singer' on the machines which the defendant makes and sells. As to the first of these inquiries **the proof shows that the circulars were so drawn as to adequately indicate to any one in whose hands they may have come that the machines therein referred to were made by the June Manufacturing Company, and not by the Singer Company.** We therefore dismiss the circulars from view."

In *Hazelton Boiler Co.* v. *Hazelton Tripod Boiler Co.*, 40 Ill. App., 430, it was said:

> "It is not shown that the defendants have endeavored or intended to deceive anybody; we do not find that they have sought to palm off their goods as the manufacture of the plaintiff; on the contrary, *the record shows that defendants have issued a circular*

> *warning to the public not to confound the 'Hazelton Tripod Boilers' with the 'Hazelton;'* and have also issued a statement that it, the 'Hazelton Tripod Boiler Company,' has no connection with 'The Hazelton Boiler Co.' of New York."

In *Hazelton Boiler Co.* v. *Hazelton Tripod Boiler Co.*, 142 Ill. Sup., 494, the Supreme Court of Illinois, in affirming the decision of the Appellate Court, said (pp. 508-9):

> "It is not shown that the defendant has ever attempted in any way to palm off its own boilers as being of the complainant's manufacture. On the other hand, the evidence seems to show more than ordinary efforts on the part of the defendant to apprise the public that it and the complainant were two separate concerns having no connection with each other, and that its boilers were different from those manufactured by the complainant."

In *Genesee Salt Co.* v. *Burnap*, 73 Fed. Rep., 818 (C. C. A.), the court said (p. 822):

> "It appears that, immediately upon the complaint being made by the Genesee Salt Company that this was a colorable imitation of their goods, Burnap & Burnap sent out 5,000 circulars making clear the difference, and that their salt was Genesee County Salt, as distinguished from the salt of the Genesee Salt Company. . . . By their circulars, the defendants, if they ever had any purpose to pirate the business of the Genesee Salt Company by use of the words 'Genesee Co.' abandoned it, and explained to the public what was the fact, namely, that their salt was made in Genesee County."

It has been urged that the very fact of the statements made by the Remington-Sholes Company and its predecessor in catalogues, signs, etc., to the effect that no connection whatever existed with complainant, would indicate a recognition that there was danger of confusion

arising, but the plain answer to this is that these statements were made after the threat of complainant contained in its notice of June 16, 1894, and repeated at later dates. (R. 292.) We do not believe that this court will follow complainant's counsel in their effort to distort an honest precaution into a guilty confession.

Indeed, in many cases in which great confusion has arisen, the courts have restricted complainant's remedy to a requirement that defendant indicate the fact that he has no connection with complainant. *Walter Baker & Co.* v. *Sanders et al.*, 80 Fed., 889 (C. C. A.); *Allegretti Cream Chocolate Co.* v. *Keller*, 85 Fed., 643. In these Baker cases the court recognized that the most effective way for the defendant to distinguish his goods was to use a statement reading as follows:

> "W. H. Baker is distinguished from and has no connection with the old chocolate manufactory of W. Baker & Co."

Where a complainant's package or machine does not contain his name and address, but the trade-mark alone is relied upon, it stands for his signature. In such a case, if a defendant adopt the same trade-mark and adds *his* name and address, such act, instead of tending to differentiate his goods, manifestly tends to divert complainant's trade, and under such circumstances is an "aggravation" of the wrong. Such a case was that of *Menendez* v. *Holt*, 128 U. S., 514 (520), where complainant's package bore the fanciful name "La Favorite," but *did not bear complainant's name*, and where defendant's package also bore the name "La Favorite," together with defendant's name and address.

But in a case like that at bar, where the invariable practice of the complainant has been to mark its machines

with both its full name and address (*i. e.*, "Manufactured by Wyckoff, Seamans & Benedict, Ilion, New York, U. S. A."), in addition to its adopted marks (*i. e.*, "Remington" and "Remington Standard" and the "Red Seal"), then the act of defendant in marking its full name and address (*i. e.*, "Remington-Sholes Company, Mfrs. Chicago"), as well as the marking of the machines with a radically different trade-mark (*i. e.*, "Rem-Sho"), must conclusively show a purpose to distinguish its machines from complainant's.

So, also, if a defendant's caution is directed only to the retailer and not to the ultimate purchaser (as was the case in *Pillsbury* v. *Pillsbury-Washburn Co.*, 64 Fed Rep., 841), it can have but little weight. On the other hand, where, as in the case at bar, a defendant's cautionary notice is directed to the ultimate purchaser and not to the dealer and is freely distributed, such fact is clearly incompatible with any purpose to deceive.

No Fraud in the Adoption of the Name Remington-Sholes Company.—The question that at once presents itself is whether it is true, as charged in the bill, that the name "Remington-Sholes Company" was adopted in fraud and as an artifice and for the purpose of misleading the public and appropriating complainant's trade.

Under the authorities the burden is upon complainant in this case, as in every case involving the question of a defendant's right to use a personal name, to conclusively establish both of two propositions, viz., *first*, that the name was fraudulently adopted and used by defendant for the purpose of palming off its goods as and for complainant's, because by the use of a personal name *in the absence of fraud* any confusion in trade is, as the courts

have repeatedly said, *damnum absque injuria;* and, *second,* that the name thus dishonestly adopted has in fact enabled the defendant to deceive or will in all probability enable him to do so.

Where, as in the present case, the machines of complainant and defendant have been in fierce competition for years, the court may well brush aside the question of mere probability of deception because if in all these years there has been no deception or real trade confusion, it is manifestly improbable that there ever will be any, and because in this case, as we shall show the court, the testimony of both complainant's and defendant's witnesses makes it plain that what little question there was at the outset has been steadily growing less as defendant's machine has become better known upon the market.

In determining the question of fraudulent intent upon the part of the organizers of the Remington-Sholes Company this court will give to the parties concerned at least that presumption of honesty that the law accords even to the veriest criminal. More than this, we believe that this court, viewing the acts of these parties from the standpoint of common sense, will attach to them so long as consistent with the ordinary rules of honesty that purpose and meaning which it is asserted they were intended to have. (*Shulze* v. *Hoagland*, 85 N. Y., 464; 467, and *Shotwell* v. *Dixon*, 163 N. Y., 43; 52.) If this be done the argument for complainant must be without force, for it is predicated not merely upon the assumption that the officers and organizers of the Remington-Sholes Company and its predecessor were dishonest, but upon the further assumption that the very means adopted by them to distinguish their company and their machine from complainant and its machine and so to prevent possible con-

fusion in trade were designed in fact as instruments of fraud.

The Old Company.—A fair determination of the question of fraudulent intent upon the part of its organizers involves a consideration of the circumstances that led to the organization of the defunct Remington-Sholes Typewriter Company, in rightful succession to which the "Remington-Sholes Company" admittedly stands. (R. 353.)

To show these circumstances and establish its charge of fraudulent intent, complainant produced as a witness Mr. Zalmon G. Sholes, who at the time was in the employ of Mr. Seamans, complainant's president (R. 442). The testimony of Mr. Sholes, far from proving any fraudulent intent or conduct upon the part of the organizers of the Remington-Sholes Typewriter Company, conclusively showed the entire honesty of those associated with him from the time he first met the Remingtons in 1893, after the failure of the Z. G. Sholes Co., until he left the employ of Mr. Fay in 1897.

As the statements of Messrs. Remington, Fay and Head could have thrown no further light upon the subject, this court will undoubtedly approve rather than condemn the omission of their depositions. In view of the size of this record it will be time enough to criticize the absence of other witnesses when it is shown wherein their testimony could have thrown light upon the questions at issue.

When Z. G. Sholes invented a typewriter and made a model of it he was pursuing the life-work of his father, C. L. Sholes. With pride in his work and in his family name he called his first model "The Z. G. Sholes," and having organized in Wisconsin a company for its manufacture, the name "The Z. G. Sholes Company" was

naturally adopted. Carver and Franklin Remington, whom Sholes met *after the failure of this company* and before any additional machines had been built or any placed upon the market, were young men about his own age. Carver Remington had had some experience at the Ilion factory of E. Remington & Sons; Franklin Remington had had none; but both were old enough to know that twenty years before their father's company, then world famous, had undertaken the manufacture of the typewriter of the elder Sholes and from it had developed a most profitable and important branch of its business. They saw here a chance that history might repeat itself, and Franklin Remington at once began to give his undivided efforts towards perfecting the machine, and towards interesting capital for its manufacture. (R. 413.) As to the machine itself, that "marked the culmination of their hopes and labors," Mr. Sholes aptly says (R. 429): **"We naturally thought we had the best machine that had ever been built, and I don't think that we ever failed to talk it."**

A consideration of the deposition of Mr. Sholes when testifying on behalf of complainant must show with what entire fairness he and the Remingtons invoked the aid of others, for which purpose the machine was shown to many. (R. 404.) The repeated assertion of counsel for complainant in their brief before the lower courts that the Remingtons became interested in the "Z. G. Sholes" machine for "speculative purposes," might be ignored except for the insinuation attached to the manner in which it was made. It is enough to say that while they doubtless hoped to gain financially by their investment the record will be searched in vain for a single instance of any kind of questionable conduct in their efforts to enlist the

aid of others. On the contrary, Mr. Sholes distinctly testified (R. 413) that he and Mr. Franklin Remington exhibited the model machine "ENDEAVORING TO INTEREST CAPITAL FOR THE PURPOSE OF MANUFACTURING THE MACHINE."

Before his meeting with the Remingtons, Sholes had known Mr. Clarence Seamans, complainant's president, and had had negotiations with him in regard to a purchase of the old Z. G. Sholes machine. (R. 415.) Sholes and the Remingtons soon after their meeting went to Utica, to Ilion and to New York City, at the invitation of a Mr. Dally (R. 405), taking with them the machine (R. 416), and showing it to the Remington Arms Company and to various persons connected with the factory of Wyckoff, Seamans & Benedict. (R. 417, 433.) *Mr. Seamans was not seen at that time nor afterwards* by either of the Remingtons or by Sholes in regard to the machine. (R. 433.) *Sholes testifies* (R. 444) *that he and the Remingtons decided to let Mr. Seamans take the initiative, if he cared to do so, in making any deal; that he merely wrote to Mr. Seamans inviting him to call in regard to the possibility of a sale* (R. 432), *and that Franklin Remington actually objected to opening negotiations with Mr. Seamans.*

Adoption of Name Remington-Sholes.—No intimation was given to Mr. Seamans, nor to any one at the time of the Ilion visit, as to what Sholes and the Remingtons proposed to call their machine, although at such time it was marked with the name "Z. G. Sholes," and after the name on the machine was changed to "Remington-Sholes" no further negotiations were had with Mr. Seamans. (R. 417.)

After the eastern trip, Franklin Remington continued

to devote his entire time to the Sholes machine, seeking to interest capital, consulting with Sholes in regard to every change made in the model (R. 429), *and furnishing the necessary funds to pay salaries and other expenses.* Is it surprising, therefore, that we find Sholes, *entirely without the knowledge of the Remingtons,* as he states (R. 427), changing the name of his machine to the "Remington-Sholes"? Certainly under the circumstances no name could have been more appropriate.

In the direct examination of Mr. Sholes, counsel for complainant attempted by a series of most flagrantly leading questions (R. 424 to 426) to induce him to say that the adoption of the name "Remington-Sholes" was influenced by the existence of the well-known "Remington" machine, but a reading of *all* of his deposition upon this point must show the failure of counsel's effort. Thus, on page 424 of the Record, Sholes says:

> "I thought it (the name 'Remington-Sholes') a good combination because my father was the originator of what is known as the Remington machine and Mr. Remington's father had been the manufacturer."

And again on page 426, when asked:

> "Q. 215. And did you think it would be an advantage because there had been and was a typewriting machine on the market in connection with which the name Remington had been and was used?"

He answered:

> "A. I explained that once before by saying that owing to my father being the originator of the Remington Standard machine and Mr. Remington's father being interested in the manufacture of the machine, I very naturally thought it of value for he and I to be associated together in the manufacture of another typewriter."

Counsel's effort to induce Mr. Sholes to qualify the

statements thus explicitly made falls within the condemnation expressed by this court of a like attempt by counsel in *Singer Mfg. Co.* v. *June Mfg. Co., supra* (p. 183).

The machine was thus named and marked "Remington-Sholes" before Messrs. Remington and Sholes solicited and obtained the financial aid of Franklin H. Head and Charles N. Fay, of Chicago, in the organization of a company for its manufacture. For a company created to manufacture a typewriter upon the development of which a Remington had expended thousands of dollars and months of constant personal effort, and which was the invention of a Sholes, and which came already christened, there seemed but one appropriate name, viz., the "Remington-Sholes Typewriter Company." As Sholes himself testifies in regard to the adoption of the corporate name (R. 428):

> "As I remember it, there was no discussion about it; it was a foregone conclusion that the name would be used; we had no discussion on it; kind of took it for granted."

Doubtless Mr. Head and Mr. Fay also agreed with Mr. Sholes that the name "Remington-Sholes" was "a good combination." It offered a "talking point" for the machine. The name Remington was admittedly a byword for good workmanship the world over long before the typewriter was conceived by the brain of the elder Sholes; and the coming together of the second generation of these families to whom the typewriter industry owed its origin was a *fact* and bit of history that might well be expected to enlist the public interest.

Not only do the facts so fully testified to by Mr. Sholes show the entire absence of any fraudulent intent upon the part of the organizers of the old company, but his testimony also gives positive proof that their purpose was

to avoid all possibility of confusion with complainant's machine. Thus (R. 439), he says:

> **"It was not our endeavor to confuse our machines with the Remington Standard Typewriter."**

And again (R. 440), his examination reads:

> **"As I said before, it was not our intention to confuse the Remington-Sholes machine with the Remington Standard.**
> **"284 X-Q. And you gave the salesman under you to understand this fact, did you not?**
> **"A. There was a general understanding to that effect, if I remember rightly."**

The New Company.—While the Remington-Sholes Typewriter Company was a financial failure, it succeeded in establishing a market for its machine, which became known throughout this country and abroad as the "Remington-Sholes." When, therefore, in the process of reorganization, a new company was formed for continuing the sale of such machine, it was not merely reasonable—it was inevitable—that with a view to maintaining the established business and organization and gaining the benefit of the work and advertising that had been done, a similar name should be adopted for the new company; and this was recognized by the assent of both Mr. Remington and Mr. Sholes to such use of their names. (R. 839.)

The record shows that upon the organization of the Remington-Sholes Company Mr. Franklin Remington was a stockholder in it to the extent of $15,000 (*representing his actual cash investment*), and at once became its general manager. At such time he brought with him nearly four years of constant and unremitting experience in the manufacture of typewriting machines; and he

brought with him also a family name that had stood for a half century as a synonym for honesty and good workmanship. These were his contributions to the new company, and under such circumstances the use of his name was manifestly not merely reasonable, but most appropriate.

The repeated assertions of complainant's counsel in their briefs before the Circuit Court and Circuit Court of Appeals, that stock in the new company was "donated" to Mr. Remington, is in plain disregard of the stipulation (R. 567), which expressly states:

> "That at about the time of the organization of said company (*i. e.*, the new company) the said common stock was divided among the stock holders in keeping with the amounts of cash *actually invested by them* in the Remington-Sholes Typewriter Company, and that the allotment of said common stock to said Franklin Remington was in keeping with such plan."

Not only was the abandonment of the name "Remington-Sholes Typewriter Company" in favor of the shorter name, "REMINGTON-SHOLES COMPANY," a step away from all possibility of conflict with complainant's most favored pseudonym, the "Remington Typewriter Company," but the change in the name of the machine from "Remington-Sholes" to the fanciful name "REM-SHO" was a still wider step in the same direction.

The Vital Questions at Issue.—It is manifestly of no importance now what may have been the result of the marking by the old company of its machines with the name "Remington-Sholes—Chicago," as the proof shows that such marking of the machines was abandoned long before this suit was brought. The important questions to be determined by this court are the *live ones*, viz., *first*,

whether the Remington-Sholes Company is entitled to use its corporate name; and *second*, whether its machines, marked as they are with the fanciful name "REM-SHO" and with the name and address "REMINGTON-SHOLES COMPANY, MFRS., CHICAGO," have enabled or will enable such company to palm them off upon the public as and for machines of complainant's manufacture.

The statement of this court in *Brown Chemical Co.* v. *Meyer, supra*, that the use of a personal name cannot be condemned if it be for a **"legitimate purpose"** and be **"a reasonable, honest and fair exercise of such right,"** and the condition imposed upon the use of a personal name in *Singer Mfg. Co.* v. *June Mfg. Co., supra*, viz., that a defendant **"may not resort to any artifice . . . and thus produce injury to the other beyond that which results from the similarity of the name,"** make plain the tests that must determine in every case like that at bar.

The vital questions that confront this court are, therefore, the following:

1st. If a person having a name to which his ancestors have given a world wide reputation, uses such name as PART of the name of a corporation organized by him to manufacture a machine that "represented the culmination of his hopes and efforts," of which corporation he is a managing officer and to which his whole time, capital and energy are devoted, is such use a "legitimate" one, or is it an unreasonable, dishonest and unfair exercise of his right to use his name?

2d. Is the use of a personal name as PART of a corporate name, such a use as is calculated "to

produce an injury to another beyond that which results from the similarity of the name?"

In determining the reasonableness of the use of the name "Remington-Sholes" for a corporation designed to manufacture a typewriter produced by Messrs. Remington and Sholes, regard will be had to those trade customs disclosed by the record and judicially noticeable that are plainly pertinent to the question. Thus it is but fair to notice that in all lines of industry the trend of modern manufacture is toward corporate management. So, too, the practice of giving personal names to corporations has become well nigh universal, and especially is this true of the typewriter trade. All the numerous typewriting machines now upon the market are made by corporations, and these, with but very few exceptions, bear the names of the inventors or of the manufacturers of the machines. Thus we find the "BLICKENSDERFER," the "DENSMORE," the "HAMMOND," the "JEWETT," the "FISHER," the "ELLIOTT & HATCH," the "ODELL-YOUNG," the "OLIVER," the "SMITH," the "FOX," the "WELLINGTON," the "YOST," and the "HALL," besides various other well-known machines manufactured by corporations of like names. In giving their names to the machine and to the company organized for its manufacture, Messrs. Remington and Sholes were but following the established custom of the typewriter trade. Certainly in the light of all the facts no course could have been more *reasonable* or fair.

In their opinion the majority of the Court of Appeals assert that the incorporators of the old Remington-Sholes Typewriter Company knew "that the use of the name 'Remington' in connection with the typewriting machine

would help to sell it as the name of 'Brown' and 'Peterson' would not." Possibly it would, but certainly this can not alter the fact that inasmuch as the production of the finished machine was due to the joint labors of Remington and Sholes and to the capital of the former, it was reasonable to employ both names. The family name of REMINGTON has for the past forty years held a reputation in the markets of the world different from that of "BROWN" or "PETERSON." It has stood as a synonym of good workmanship so long and in such different fields of manufacture that few if any American names show as divers and wide a reputation. In this respect it is almost unique, and many a name although of great distinction in some single line of industry seems insignificant by comparison.

Had Franklin Remington embarked in the manufacture of sewing machines, or agricultural implements, or indeed, of any other line of machinery, particularly if designed for international trade, the world-wide reputation of his family name would have unquestionably prompted its use. We submit, however, that it would scarcely seem reasonable that a son of Westinghouse, of Edison, of Corliss, of Carnegie, of Bessemer or of Krupp should voluntarily conceal his identity even though a Brown or a Peterson might do so. The simple fact is that men pride themselves upon their family reputation, and, however democratic we may be, it must be admitted that we view with deeper interest the son of such a distinguished father and look to find in him a measure of inherited skill.

Decision of the German Courts Relative to the Name "Remington-Sholes."—As these German decisions could not under the rulings of our courts be set up in support of a plea of *res adjudicata* they were not for-

mally offered in evidence, but notice was given upon the record (R. 1433) that at the hearing of the cause they would be referred to, and counsel for complainant was furnished at that time with copies of the decisions and with translations thereof. A consideration of these will show that the history of complainant and of the Remington-Sholes Typewriter Company was set forth before the German courts, and it was strenuously urged by the German representatives of complainant that the name "Remington-Sholes" was adopted for the fraudulent purpose of deceiving the public, and should be enjoined.

In the decision of the Kammergericht, promulgated October the 15th, 1897, the following pertinent language appears:

> "Accordingly, the defendant, who in this locality sells the typewriters of the Remington-Sholes Typewriter Co. of Chicago, cannot be prohibited from affixing said business name upon the goods of said house nor from using it in the course of business, or announcements, advertisements, etc. It is not open to dispute, that the defendant deals only in typewriters made by said concern, and that he actually obtains his goods from said concern.
>
> "The plaintiffs have tried to establish that the Remington-Sholes Typewriter Co. has unlawfully and sneakingly appropriated the word Remington. They do not dispute that two descendants of the typewriter manufacturer Remington, Franklin and Carver Remington, were among the founders of the concern and are still interested in the same; but again they claim that Franklin and Carver Remington entered into said concern only *pro forma*, to bestow upon it an apparent right to use their name so well known in this line of business. However, whatever the plaintiffs have actually shown by way of foundation to their opposition to the use of the name Remington can in no wise give rise to the con-

clusion, that in this instance a business name has been sneakingly appropriated. The plaintiffs have confined themselves to the following statement: Franklin and Carver Remington are the sons of Samuel Remington, one of the copartners of the old firm of Remington & Sons; neither of them have ever had anything to do with the running of the business of said firm, or, before entering into the present business under the name of Remington-Sholes Typewriter Co. ever occupied himself with the manufacture of typewriters. But even if both these points had been fully established, it would not result therefrom, that the two Remingtons would not become real associates in said new house and were only *pro forma* engaged by said house, that their name might be used for improper purposes. For it is quite possible, yea, even probable, that they should have seriously devoted themselves to the business of their father, and acquired special knowledge, in which they were formerly lacking. To choose this business, in order to take advantage of the reputation attached to their name in this line of business, they have a perfect and indisputable right."

Upon a revision or rehearing of the German case, the Reichsgericht (Imperial Supreme Court), by a decision published October 22, 1899, refused to reverse the decision of the Kammergericht.

While it is true that the German case was "an affidavit case" and arose under the German trade-mark law this fact is of no moment, (*a*) because the record here shows (R. 85) that such case was presented, in part at least, by respondent; (*b*) because the true history of the adoption of the name "Remington-Sholes" was presented to the German courts as in the case at bar; and (*c*) because the reasoning of the German opinions applies as forcibly to the facts here as to the facts before the German courts.

That these decisions of the German courts, although

not of controlling force, should be recognized as precedents, is fully established by the authorities.

Liebig Extract of Meat Co. v. *Libby, McNeill & Libby*, 103 Fed. Rep., 87 (89), (C. C. A.).

Centaur Co. v. *Heinsfurter*, 84 Fed. Rep., 955 (C. C. A.).

Singer Mfg. Co. v. *June Mfg. Co.*, 163 U. S., 169.

Family Reputation Recognized as a Valuable Heritage.—The courts have repeatedly recognized the fact that the value attaching to the good reputation of a man's name is a most appropriate reason for its use by his son when engaging in business; and where such reason exists, the leading cases have allowed such name to be prominently used by a son when associating himself with others, although a degree of confusion in trade has arisen that would have been avoided had the name selected been that of one of his associates.

The case of *Meneely* v. *Meneely*, 1 Hun., 367, which is singularly like the case at bar, is one that has been repeatedly cited with approval by this Court (*McLean* v. *Fleming; Singer Mfg. Co.* v. *June Mfg. Co.*, *supra*), and by the Federal and State Courts generally. In that case, Andrew Meneely, who was the father of the plaintiff and of one of the defendants (Clinton Meneely), had established at West Troy a bell foundry that gained a wide and favorable reputation. He associated in business with him his son, Edwin Meneely, one of the plaintiffs, and after his death, in 1851, Edwin, with one brother, continued to carry on the business under the name of E. A. & G. R. Meneely. The defendants were Clinton Meneely and one Kimberly, and they adopted the firm name of "Meneely & Kimberly," and began, in 1871, the manufacture of bells a short distance only from plaintiff's fac-

tory, marking their bells with such name. It was shown that considerable confusion was created in the public mind with respect to the bell foundries of plaintiffs and defendants on account of the use of the name "Meneely" by both concerns.

It was urged by plaintiffs that there was no necessity of the defendants using the name Meneely in the title of the firm, as it could as well have been called "Kimberly & Co." as "Meneely & Kimberly," but the General Term expressly and the Court of Appeals tacitly refused to compel the defendants even to reverse the name and call themselves "Kimberly & Meneely," though Kimberly was much the older man and had all the business experience in the firm and furnished all the capital. In the lower court the Referee found that the defendants, by the use of the name "Meneely" in the firm name of "Meneely & Kimberly," and by marking their goods with such name, expected to derive profit and advantage by reason of the great reputation in bell-founding given to the name Meneely throughout the country by Andrew Meneely and the plaintiffs, and found also that the use of the name Meneely "was calculated to and does mislead persons to the belief that defendants are the proprietors of the 'Meneely Bell Foundry' carried on by the plaintiffs." The lower court sustained the Referee and restrained the defendants from using the name Meneely about their business, but upon appeal the General Term unanimously reversed such decision. The reasons set forth in the opinion are so cogent that we quote from them at length. The court said:

> "In the case at bar, the defendants have not used the firm name of the plaintiffs, or any name by which it has been heretofore known or designated, but the name of 'Meneely & Kimberly,' as constituting a co-

partnership, while engaged in the same business as the plaintiffs have, for a long time, carried on. The objection is to the employment of the name of 'Meneely' in connection with the same business as the plaintiffs, at the place where the defendants are located, which is in the city of Troy on the opposite side of the Hudson River from where the plaintiffs are situated. . . .

" The question then arises, whether the defendants are liable to be enjoined without having done any wrongful act and merely because they assumed to use the name of one of them in connection with a business in which the ancestor of that defendant and of the plaintiffs had been engaged, and which by a life of industry and toil, and by skill he had made profitable, and an invaluable inheritance for his posterity. **The right to the enjoyment of a good name, personally or in connection with a business established by the labor and integrity of an ancestor is an inestimable privilege which cannot be too highly prized. As a general rule, every individual is entitled to the full benefits and advantages which such a privilege confers and should not be deprived of the same by the interference of the courts except in extraordinary cases and for the most cogent of reasons.** . . The defendant Clinton H. Meneely claimed the right to profit from the name which he inherited, and the good reputation which his father had earned in the business of bell founding. He was open and above board in declaring thus to derive advantage, and formed a partnership and conducted his business with the expectation and belief that profit would accrue to him by reason of the good name and celebrity which had attended his father's successful career. I am inclined to think that in this respect he committed no wrong, and that he has a perfect right to use his own name in his own business even although that name was the same as the one used by the plaintiffs and the business precisely of the same character."

The court distinguishes the case of *Sykes* v. *Sykes*,

Croft v. *Day*, *Holloway* v. *Holloway*, *Stonebreaker* v. *Stonebreaker*, and *Holmes B. & H.* v. *Holmes B. & A.*, saying with respect to the last-mentioned case that it "involved the element of estoppel." The court also says:

> **"There is quite a distinction between appropriating the good will of the business of a deceased father carried on at a particular locality and enjoying the benefit of his name as a man of skill and fair dealing in the business in which he was engaged."**

Recognized Distinction Between Family Reputation and Business Goodwill.—This is precisely the distinction that has determined the whole course of defendant and its principal in the present case. As their machines have been made under Mr. Remington's management they have rightfully sought the benefit of his family reputation. But far from committing any trespass upon the *good-will* to which complainant has succeeded, they have, by circulars, by signs, by advertisements, and by invariable instructions to their agents and dealers, taken every conceivable precaution against the possibility of such trespass.

The importance of this difference becomes at once apparent when it is remembered that the whole foundation of a suit like the present one is the alleged *trespass upon complainant's trade* by the representation that defendant's goods are of complainant's manufacture (*McLean* v. *Flemming*, *supra*), thereby effecting an injury to something that complainant *owns*, and is not a trespass upon a family reputation which a complainant *cannot own*.

In the case at bar, whatever injury complainant may have sustained (although the record is barren of any showing that it has been injured at all, as the lower court tacitly admits by its refusal of an accounting) is due en-

tirely to its trying to make a trade-mark out of a family name in order that it may gain the exclusive benefit of the *reputation* of such family for good workmanship in addition to the *good-will* of the branch of the business that it purchased.

Upon the appeal of the Meneely case (reported in 62 N. Y., 427) the decision of the General Term of the Supreme Court was affirmed, the court saying:

> "The bare statement of the scope of the injunction would seem to be sufficient to show that it ought not to have been granted and that the judgment awarding it was erroneous. The cases referred to in its support fall far short of sustaining it. If the defendants were using the name of Meneely with the intention of holding themselves out as the successors of Andrew Meneely and as the proprietors and managers of the old established foundry which was being conducted by the plaintiffs and thus enticing away the plaintiff's trade, or resorted to any artifices to induce the belief that the establishment of the defendants was the same as that of the plaintiffs, and, perhaps, if without any fraudulent intent they had done acts calculated to mislead the public as to the identity of the establishments and produce injury to the plaintiffs beyond that which resulted from the similarity of names, then the cases referred to sustain the proposition, not that a court of equity would absolutely restrain the defendant Meneely from the use of his own name in any way or form, but simply that the court would enjoin him from using it in such a way as to deceive the public and injure the plaintiffs. **The manner of using the name is all that would be enjoined, not the simple use of it;** for every man has the absolute right to use his own name in his own business, even though he may thereby injure the business of another person bearing the same name, provided he does not resort to any artifices or contrivance for the purpose of producing the impression that the establishments are identical, or does anything calculated to mislead.

Where the only confusion created is that which results from the similarity of the names the court will not interfere. A person cannot make a trade-mark of his own name, and thus obtain a monopoly of it which will debar all other persons of the same name from using their own names in their own business."

It is vain to deny the fairness and logic of this opinion of the New York Court of Appeals or its pertinency to the case at bar. The particulars in which the facts in that case differ from the facts of this all make for the defendant here. It will scarcely be urged that the defense there would have been weakened had Meneely and Kimberly established their place of business a thousand miles distant from complainants, as defendant's principal in this case has done, or had they taken the many precautions adopted by this defendant to avoid the possibility of confusion in trade, or had they conspicuously marked all their bells with some such fanciful name as "MEN-KIM" in the same manner that defendant here displays the trade-mark "REM-SHO" on its machines.

In the case of *National Starch Mfg. Co.* v. *Duryea et al.*, 101 Fed. Rep., 117 (C. C. A., 2nd Circ., Feb. 28, 1900); see also *Same* v. *Same*, 79 Fed. Rep., 651 (C. C. A.), the facts were briefly as follows: Hiram Duryea and his brothers had been controlling members of the Glen Cove Manufacturing Company, which had made a wide reputation for starch enclosed in packages labeled "DURYEA STARCH," and bearing a picture of the factory and the name of the company. At the time complainant bought the business, Hiram Duryea agreed not to engage in the manufacture of starch for a period of five years. After the lapse of such time and in 1895, two sons of Hiram Duryea, having no business or reputation, formed a partnership with two former salesmen of the Glen Cove

Company and of complainant, and entitled their firm "Duryea & Co.," the capital of the firm being furnished entirely by Hiram Duryea. Duryea & Company caused their starch to be manufactured for them by another company, and it was placed upon the market in packages on which were prominently displayed the words "LAUNDRY STARCH, PREPARED BY DURYEA & CO.," and "PURE CORN FLOUR, PREPARED BY DURYEA & CO." Before the younger Duryeas formed this partnership they were not manufacturers of starch.

In that case, as in the case at bar, it was alleged that the defendants had made an "unncessary" and unfair use of the name Duryea, since the firm could have used equally as well the names of the two salesmen who, with the Duryea brothers, comprised it. At Circuit the court found for complainant upon this point on a motion for preliminary injunction, but upon appeal from such decision it was held (79 Fed. Rep., 651) that defendants had not made an unfair, unreasonable or unnecessary use of the name Duryea. The court (Wallace, Lacombe and Shipman, Circuit Judges, and Brown, District Judge) there said:

> "Inasmuch as the defendants have not called their starch by this well-known name, and have not assimilated the labels upon their packages to those long used by the manufacturers at Glen Cove, the question is whether the defendants have made such an unnecessary and unfair use of the name of 'Duryea' as to deserve the unfavorable criticism of a court of equity. In the recent case of *Singer Manuf'g Co.* v *June Manuf'g Co.*, 163 U. S., 169, 16 Sup. Ct., 1002, it is declared by the Supreme Court to be a well-settled doctrine that: 'Every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidentally interfere with and injure the business of another having

the same name. In such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria.*' . . .

"If the new firm could properly adopt the name of 'Duryea & Co.' and if sufficient precaution were taken to show the public that the manufacture is not that of the successor of the Glen Cove Manufacturing Company, the complainant is not entitled to an injunction. **The firm consisted of four persons, two of whom were named 'Duryea,' and all of whom were without capital, which was furnished by the father of the two Duryeas, and who had now a right to permit his name to be used honestly in the starch business. Under this state of facts the firm was not dealing unfairly with the complainant in calling itself 'Duryea & Co.,' and in omitting to add the name of the former salesmen of the complainant.**

"Upon the second point, whereas the complainant uses the name 'Duryea Starch' and the picture of the Glen Cove factories, and said that it was the manufacturer, the defendants' packages simply assert that the starch which they contain is prepared by Duryea & Co. **We think that this is a sufficient declaration of the source of the manufacture, as distinguished from the well-known source at Glen Cove,** and that the labels are not objectionable, because, by reason of their marked dissimilarity from the complainant's labels, the public could not be misled."

When the Duryea case again came before the Court of Appeals upon the final hearing (101 Fed. Rep., 117), it was said:

"There is now evidence that the defendant's starch was vigorously pushed upon retail grocers by salesmen whom the purchasers formerly knew as salesmen of the complainant's product, and that grocers made representations, either by acts or orally, to their customers, in regard to the origin of the new product, which indicated either careless ignorance or

a willful disregard of the truth. Testimony is given by retail purchasers from the grocers that they were misled by the use of the name Duryea & Co. . . .

"That an incidental interference with and injury to the business of the complainant, which had the exclusive right to the use of the well-known name or title 'Duryea's Starch,' would occur—an injury which would be enhanced by the earnestness of competition in the field which the complainant and its predecessors had labored to occupy—and that an injury from honest competition is not remediable by a court of equity, are also manifest. The point which is urged by the complainant is that the defendants use the name of Duryea, and have pressed the article which they sell upon the public by the use of that name, 'unaccompanied with any precaution or indication' that the article was not the manufacture of the complainant, and thus that their silence is an artifice which misleads (*Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S., 169, 16 Sup. Ct., 1002, 41 L. Ed., 118); and that neither the original members of the firm nor Hiram Duryea have taken pains to differentiate their goods from those of the complainant. The complainant uses the familiar label, which contained a picture of the factory buildings at Glen Cove, with its name as the manufacturer of the starch in lieu of the name of its predecessor, and with the words 'Duryea's Starch.' The defendant's label is entirely dissimilar, **but it contains the words 'Prepared by Duryea & Co.'**

"That they gladly welcomed the pecuniary advantage from the right to use the name Duryea is true, but that they presented it to the public as the Glen Cove starch is not true, and, while their label does not say as much as it might have said without detriment to themselves, and with the same injury to the complainant, **yet we think that their starch is shown by the label not to be the manufacture of the complainant,** as the successor of the Glen Cove Company, and not to be identified with the former Glen Cove factories as the source of its manufacture."

In every legal aspect the facts in the Duryea case are practically identical with those presented here, although where the facts differ the differences are due to the greater precautions adopted by this defendant's principal than were adopted by the Duryeas. In that case Hiram Duryea had by contract restricted for a limited period his right to use his own name as Samuel Remington's company by the contract of 1886 had done. The sons of Hiram Duryea, like the sons of Samuel Remington, were not manufacturers and had neither good will nor business. The Duryea sons co-operated with others in improving the manufacture of starch, as Franklin Remington co-operated with Z. G. Sholes in the production of an improved typewriter. The Duryea sons, with their associates Sleigh and Krey began business under the arbitrarily selected firm name of "Duryea & Company," preferring it because of their father's reputation to the names "Sleigh, Krey & Company," or "Duryea & Sleigh," although Sleigh and Krey were the experienced members of the firm; while the Remingtons with Mr. Sholes, more considerate of possible trade confusion, adopted for the name of their corporation *both* personal names. In the Duryea case complainant's product was known to the trade as "Duryea's Starch," as in the case at bar complainant's machine is known as "the Remington Typewriter" and "The Remington Standard Typewriter;" but in neither case was the name of complainant's goods adopted nor was attempt made to imitate its signs, circulars or like advertising matter. On the contrary in the Duryea case defendants, omitting all simulation of the picture on complainant's package, adopted a label unlike complainants, as in this case defendant's principal, omitting the "RED SEAL" trade-mark that by use since 1880 has become familiar

to every one acquainted with complainant's machine, has distinctly marked every machine of its manufacture with both its name and address and in conspicuous manner with the fanciful trade-mark "REM-SHO."

In the Duryea case the alleged wrong consisted in the statement upon defendants' package that their starch was "Prepared by Duryea & Company" just as in this case the statement "Remington-Sholes Company, Mfrs. Chicago" upon defendant's machines is asserted to be wrong. Indeed, it would appear from the reported opinions that Duryea & Company did not even give their address upon their packages and that as a matter of fact their starch was manufactured, not by them but by the Sioux City Starch Company. In that case it was strenuously urged that defendants were guilty of wrong doing in that their use of the name "Duryea" was "unaccompanied by any precaution or indication" that might show that their starch was not the starch of complainant, while in this case the record shows that from the very outset defendant and its principal have by circulars, by instructions to agents and dealers and in every reasonable way differentiated its machines from complainant's.

Every fact set forth in the opinion of the Circuit Court in support of its finding that Carver and Franklin Remington were guilty of fraudulent conduct had its counterpart in the facts of the Duryea case, and every word of the opinion condemnatory of these Remingtons might have been spoken with equal propriety of the sons of Hiram Duryea. The only distinction between the Duryea case and that at bar is that in the one case the sons of Hiram Duryea formed a partnership, whereas in the present case the sons of Samuel Remington formed a corporation. But, as we shall show, both partnerships and corporations are in legal effect the same so far as concerns matters of

unfair trade competition; hence if it be true that the Remingtons, as asserted by the Circuit Court, "lost their identity in that of the corporation," then it is equally true that the Duryeas lost their identity in that of the co-partnership, and it is equally true in both cases that the names were used for the benefit of others as well as for themselves.

Is it fair to assume that the court would have regarded the use of the name "Duryea" less "reasonable" if that name had, like the name "Remington" stood for forty years as a synonym of good workmanship in *many* lines of trade? Is it reasonable to suppose that the court would have decided the Duryea case differently if the defendants there, instead of the arbitrarily selected name "Duryea & Company" had traded under the name "Duryea-Sleigh Company," and had marked their packages "prepared by Duryea-Sleigh Company," and had adopted as a trade-mark the fanciful name "DUR-SLE"? Or would the danger of confusion have been less or the decision of this court been different if the defendants there had, like the Remington-Sholes Company, marked their address conspicuously on their product and distributed wherever their starch was sold, circulars calling attention of purchasers to the fact that they were in no manner connected with the complainant? We think not, and plainly the well reasoned decisions in the Duryea case are in direct conflict with that in the case at bar.

Gilman v. *Hunnewell,* 122 Mass., 139.

English et al. v. *N. Y. Pub. Co.*, 8 Daly (N. Y.), 375.

Marcus Ward & Co. v. *Ward et al.*, 15 N. Y. S., 913 (61 Hun., 625).

Burgess v. *Burgess,* 3 DeG. M. & G., 896.

Hardy et al. v. *Cutter et al.*, 3 O. G., 468.

Corporation's Right to Use a Surname.—While the decisions made in the case at bar affirm the broad proposition so fully established by the authorities that an exclusive right cannot exist to the use of a family name, they hold that the use of such a name by a corporation stands upon a different footing. The basis of such ruling is that a corporation, being an artificial body, its organizers have the whole vocabulary to select from, and hence are in duty bound to avoid the selection of such a name as may in any manner interfere with the business of those using like names.

The answer to all of this is that the law as established by the decisions of this court recognizes the right of every man to use his name *reasonably and honestly in every way*, whether such use be effected by him alone or associated with others, either in a firm or corporation; and, on the other hand, it condemns a dishonest use wherever and however practiced.

Inasmuch as the courts have thus invariably recognized the right of a person to use his family name fairly in the business of a firm in which he is honestly engaged, we submit that in reason no distinction can be made between the use of such name in a firm and its use in a corporation, for in both cases the names adopted are alike selected and artificial.

A corporation is in effect but a partnership, and the court will take judicial notice of the fact that of late years it has become a common practice to adopt family names for corporations in precisely the same manner as such names are used for firms; witness, for example, complainant's coporate name, Wyckoff, Seamans & Benedict, and the corporate name, E. Remington & Sons. Indeed, if a common usage can prove the reasonableness of the

adoption of a personal name for a corporation, the court need but notice how many typewriting machines on the market to-day are manufactured by corporations employing such personal names.

Manifestly when one incorporator has an unrestricted legal, moral and commercial right to the use of a family name that has acquired a world-wide reputation for honesty and good workmanship, he can contribute to corporate advancement and prosperity by allowing a company to use his name (where, as in the case at bar, he holds a substantial interest in and is an important member of such a corporation, and is devoting his entire time to the management thereof) in the same way and for precisely the same reason that he could use such name in connection with a partnership business.

Certainly it would be absurd to contend that Messrs. Remington and Sholes were not at liberty to engage in the typewriter business under the firm name of "Remington & Sholes," or associating others with them under the firm name of "Remington, Sholes & Company," and yet if such use of these names be reasonable and permissible it is difficult to perceive why they might not proceed with equal reason and fairness to follow the accepted custom of giving their names to a corporation organized and managed by them.

Let us assume that Remington & Sholes had begun the manufacture of their machine under the partnership name "Remington and Sholes" or "Remington & Company," and finding their capital inadequate, had interested others and incorporated under the same name (just as Wyckoff, Seamans & Benedict, and E. Remington & Sons did). Would they have been guilty of an unreasonable or illegal or fraudulent act in this corporate use of their names? Or would the innocent name of yesterday become a pi-

ratical trespass to-day? The answer to such questions is found in the language of the Court of Appeals for the Second Circuit in *Baker* v. *Baker,* 115 Fed. Rep., 297 (303):

> "As regards the complainant, it is wholly immaterial whether the business is conducted as that of a corporation or that of an individual by the same designation."

In *Celluloid Mfg. Co. Cellonite Mfg. Co.,* 32 Fed. Rep., 94, the learned Justice Bradley said:

> "The fact that both are corporate names is of no consequence in this connection. They are the names by which the parties are known, and are to be dealt with **precisely as if they were the names of private firms or partnerships."**

If a man's use of his name is to be held so limited that he cannot employ it in the ordinary way and for a universaly recognized legitimate purpose in trade, then is set at naught the language of this court in *Brown Chemical Co.* v. *Meyer, supra,* that "a man's name is his own property and he has the SAME right to its use and employment as he has to any other species of property." So, too, if a man is to be denied the right to so use his name, it must be in plain disregard of the limitation imposed by this court in the Singer case where it was held that he need only "adopt such precautions as will protect the property of others and prevent injury to the public, *if by doing so no substantial restriction is imposed on the right of freedom of use."*

In *Monarch* v. *Rosenfeld et al.,* 39 Southwestern Rep., 236 (19 Ky. Law Rep., 14), the following pertinent language was used:

> "Now, it is argued that the court by its judgment limits S. I. Monarch to the use of his name in busi-

ness alone or as a partner, but as a stockholder in the corporation he cannot use his name in the corporate business, its property is in no sense his property, its business is not his. *I do not think that is the meaning of the judgment or opinion.* . . . It is conceded that he can in good faith form a partnership with Rosenfeld & Hirsch in the whiskey business and the firm might use his name. **If the firm can, in the light of the opinion, there is no reason why his name cannot be used in the corporation. . . . Plaintiff can be injured no more in his business by a corporation than he can by such a firm. . . .**

"So, the only question is, if S. I. Monarch can go into business in good faith with any corporation, and use his name in branding its barrels with his name, he can do it with the defendant. In 1 Mor. Priv. Corp. (2nd Ed.) Sect. 1, it is said. 'However, it is essential to a clear understanding of many important branches of the law of corporations to bear in mind distinctly that the existence of a corporation independent of its shareholders is a fiction, and that the rights and duties of an incorporated association are in reality the rights and duties of the persons who compose it, and not of an imaginary being.' I do not doubt but that in certain kinds of corporations a stockholder can authorize the corporation to use his name, and for some purposes its business is his business. **It is known to all—the knowledge is so universal that I think the court can take notice of it—that in these days the practice and custom has grown up among business men that when two or three associate themselves together for the purpose of engaging in any trade or business of any magnitude, instead of forming a partnership to conduct and carry on said business, they form a corporation; they invest in it all of their capital, give to it all of their time and attention. In reality, it is their business. But for fiction of law, such an association would be a partnership.** If the Court of Appeals meant to say that S. I.

Monarch could not use his name in such a corporation, he has, after all, but a limited right to use his name in business. I do not think such is the meaning of the court."

In *American Cereal Co.* v. *Eli Pettijohn Cereal Co.*, 72 Fed., Rep., 903 (affirmed by C. C. A., 76 Fed. Rep., 372) Showalter, C. J., said:

"An injunction was prayed to stop the use by defendant of the name Pettijohn in defendant's corporate name and in the designation of defendant's product, and to stop the use by defendant of the wrapper or any wrapper showing the name Pettijohn. . . . It can hardly be contended that he (Eli Pettijohn) had not then the right to make, or rather to continue to make rolled wheat and to market the same in packages bearing his name in any part of the United States. Neither complainant nor its assigns could by advertising the name Pettijohn prevent Eli Pettijohn from doing this. **It would seem to follow also that he might secure the co-operation of others willing to assist him financially in the business, and that he might with such co-operation form a corporation for the purpose of carrying on such business;** *provided always he should take reasonable precautions to distinguish the business thus carried on by him from that of a competitor rightfully using the name Pettijohn.*"

In *Hazelton Boiler Co.* v. *Hazelton Tripod Boiler Co.*, 142 Ill. Sup., 494, the court recognized the right of Hazelton to give his name to the defendant corporation, and in so doing said:

"If any confusion has occurred it has arisen from the similarity of the corporate names, and not from any attempts on the part of the defendants to deceive. . . . If injury results to the complainant from such cause, it is *damnum absque injuria*." (P. 509.)

In *Scott Stamp & Coin Co. Limited*, v. *J. W. Scott Co., Limited*, 15 N. Y. S., 325 (58 N. Y. Super. Ct., 379), the facts were as follows: J. W. Scott had been a most prominent dealer in stamps, coins, etc., when by a written contract he assigned to another, and the business was continued for some time under the name "Scott & Co." or "J. W. Scott & Co." By agreement, complainant corporation was organized and defendant took stock therein in part payment. The contract provided that Scott should not engage in the same business for two years, nor while he held stock in the complainant corporation. About three years after the date of the contract, Scott having sold his stock, again engaged in business under the name "J. W. Scott Co., Limited." The court, after a careful review of the authorities, found that defendant had a full right to use its name, and in this connection said:

> **"Inasmuch, therefore, as J. W. Scott, after the lapse of two years, had the right to engage in a similar business under his own name, he had a right to give his name to the defendant corporation,** and the mere fact that mistakes are made by customers, and that confusion arises, does not give to the plaintiff any right to an injunction. *Employers' Etc., Corp.* v. *Employers' Etc., Ins. Co.*, 10 N. Y. Supp., 845; *Blakslee Manuf'g Co.* v. *Blakslee's Sons Iron-Works*, decided July 23, 1887. The opinion of Barrett, J., in the case last referred to, makes this so clear that it is not necessary to do more than reiterate his language, which is directly applicable here. He says: 'I see no reason to believe that Mr. E. G. Blakslee, in forming the defendant corporation, sought to deceive the public, or to wrong the plaintiffs. The intention has been legitimate, namely, to disclose the truth, and not to conceal it. Mr. Blakslee had a perfect right to let the public know that, although his name was being

used as part of plaintiff's corporate title, he had no connection with the plaintiff. He and his sons had also a right to transact lawful business under their own names, so put forward as to indicate the simple truth and not to deceive any one. . . . **If the sons, with their father, could do business lawfully under the defendant's name, there is no good reason why that same name given to a corporation should be unlawful. It is still their own name applied as the law permits, and, so long as there is no deceit or fraud, they cannot be restrained from transacting, in what is substantially their own names, their lawful business.**' The case of *Holmes* v. *Manufacturing Co.*, 37 Conn., 278, is no authority to the contrary." (Pp. 326-327.)

In *Employers' Etc. Co.* v. *Employers' Etc. Co.*, 10 N. Y. S., 845 (61 Hun., 552), it was said:

> "There is no difference in principle between the use of an individual or copartnership name and that of a corporate name."

In *Columbia Mill Co.* v. *Alcorn*, 150 U. S., 460, this court, after reviewing various cases in which it was held that geographical and like terms could not be exclusively appropriated, recognized that the same principles of law govern the use of all names that are *publici juris*. When therefore, this court, in *Goodyear Co.* v. *Goodyear Rubber Co.*, *supra*, held that the name "Goodyear Rubber Co." was incapable of exclusive appropriation, the fact that the name was descriptive of an article instead of being descriptive of a class or family took nothing from the force or application of the rule. And when the court there said "nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name," it made plain its view that a corporation had no greater right than an

individual to usurp a descriptive name. The reason, quoted by this court from the leading case of *Canal Co.* v. *Clark*, viz., "it would greatly embarass trade and secure exclusive rights to individuals in that which is the common right of many," applies as fully to family names as to others in which many enjoy a common right. This Goodyear Company case is the leading case in which this court has had occasion to pass upon the attempt of one corporation to enjoin another from using in its corporate title a name to which others had a common right, and the unmistakable language in which it condemns such attempt should leave little doubt in the minds of any one as to the disposition that should be made of a case like that at bar, where a corporation is seeking to monopolize the use of a family name.

In the light of the foregoing authorities the Circuit Court was plainly in error when, in condemning the giving of the names of Messrs. Remington and Sholes to defendant's principal, it said: "This was not a legitimate exercise of the natural right to use their own name in their own business; but was an attempt to exercise a fictitious right to use the name in, to a great part, other's business."

The Circuit Court failed to perceive the fallacy of the argument of complainant's counsel in urging that Messrs. Remington and Sholes were not using their names in *their* business, but were giving them to the business of another. The language used in *Monarch* v. *Rosenfeld supra*, applies precisely to the facts of this case and makes plain the fact that when men invest their all in a corporation and give to it their whole time and attention "in reality it is THEIR business." In like manner also the courts in the Pettijohn case, *supra*, and in the Scott Stamp

case, *supra,* recognized the fact that the corporate business is the business of each person having his capital and time devoted thereto. With all their capital, time and labor given to the corporation organized by them it is but playing with words to say that the business of such company was not their business although others were interested therein.

A somewhat similar technical quibble was presented to the court in the Duryea case, *supra,* where is was urged as an indication of fraud on the part of the defendants that they marked their starch "prepared by Duryea & Co.," whereas it was in fact manufactured by the Sioux City Starch Company. In view of the fact that the starch was made under the supervision of Duryea & Co. this court held the statement to be in substance true, if not literally so.

In the recent work Hopkins' Unfair Trade (Sec. 54, p. 110), the author, under the title "Corporate Names," after lamenting that "upon this subject the courts are hopelessly confused in their phraseology," thus expresses his view of the law (p. 112): "It is a self-evident proposition that a generic word embodied in a corporate name is not entitled to protection in equity." And in support of this view it directs attention to *Goodyear Co.* v. *Goodyear Co., supra,* and other cases. Continuing, the author says (p. 113):

> "In conclusion there is no practical difference so far as equitable rights and remedies are concerned, between corporate names and the names of a partnership or an individual."

Lack of Necessity for Using Personal Name No Test.—It is true that in some cases the courts in condemning the *unreasonable* use of a name have emphasized the fact that such use was "unnecessary;" but, strictly

speaking, the *necessity* for the use of a name as a test of the right to its use is without warrant in the decisions of this court or in common sense. The fact that a man may always readily conceal his identity under a corporate or a firm name proves the lack of *necessity* for such use in any case. The law simply requires that he shall enjoy the right to the use of his name as he would enjoy any other species of property—in a fair and reasonable manner. He is no more expected to abandon such use or to unreasonably restrict it than he would be expected to abandon the use of his chimney (in the illustration used by Justice Brown) and run a stovepipe through another part of his house merely because the smoke of his chimney was offensive to his neighbor.

In the leading English case of *Turton & Sons* v. *Turton & Sons*, 42 Ch. D., 128, plaintiffs had carried on the iron business for many years as "Thomas Turton & Sons." Defendant began the same business as John Turton, then traded as John Turton & Co., and finally took in his sons and changed the firm name to "John Turton & Sons." The evidence showed that some confusion had arisen and that there was every probability that the public would be "excessively misled by the similarity of names," and plaintiffs contended that there was no necessity of defendants using such name. In refusing the injunction, Lord Esher said (p. 135):

> "Therefore the proposition (*i. e.*, complainants' contention) goes to this length; That if a man is in business and has so carried on his business that his name has become a value in the market, another man must not use his own name. If that other man comes and carries on business he must discard his own name and take a false one. The proposition seems to me so monstrous that the statement of it carries its own refutation."

In *Continental Ins. Co.* v. *Continental Ass'n.*, 96 Fed., 846 (affirmed by C. C. A., 101 Fed., 255), the court said:

> "Counsel for complainant contends that it would have been a simple and easy matter for the incorporators of the defendant company to have selected a distinguishing name for it without having chosen a term already appropriated by a corporation engaged in a like business. This is true, and it is also true that the defendant might not suffer any serious pecuniary loss by the granting of the injunction prayed for in this cause; yet it is the opinion of the court that the incorporators of complainant by appropriating a generic term, purely descriptive, and in general and prevalent use, and in failing either to fix upon an arbitrary term, or to draw upon the realms of fancy for a name, or to select one indicative of the origin or ownership of the business about to be launched, failed to vest complainant with a distinguishing appellation, the exclusive right to the use of which the courts could declare to be in complainant."

Meriden Co. v. *Parker*, 39 Conn. 450.

S. Chivers & Sons v. *S. Chivers & Co., Ld.*, 25 Trade-Mark, Rec., 289.

In the light of the authorities and of the history of the Remington-Sholes Company it is for this court to determine, not whether Messrs. Remington and Sholes could have *abandoned* the use of their names, but whether under all circumstances the use which they made of their names was a *reasonable* and a fair one.

We therefore submit that the facts of this case and the law applicable thereto must satisfy this court upon the following points:

I. It was *reasonable* that Remington and Sholes should form a corporation for the manufacture of their typewriter (*a*) because alone they had not the capital necessary to manufacture it; (*b*) because corporate man-

agement is regarded as the most effective form of business enterprise; (*c*) because all other typewriters are made by corporations.

II. It was *reasonable* that they should adopt the name "Remington-Sholes" for their machine because both Remington and Sholes had labored incessantly for months in the production of the machine, Sholes contributing his inventive genius and Remington, after giving up all other work, furnishing not only the funds to effect the reconstruction of the machine and its exploiting, but conferring with Sholes as to every detail of change made therein.

III. It was *reasonable* that the corporation created to make this machine should bear the names of both Remington and Sholes (*a*) because it was to manufacture a machine that was distinctly the product of and owed its existence to both; (*b*) because it is the almost universal custom in the typewriter trade to identify by the same name the corporation and the machine that it manufactures; (*c*) because Sholes' father having invented the pioneer typewriter, which the company whereof Remington's father was president gave to the world, the public would be interested in the coming together of these sons; (*d*) because the family name of Remington had a world-wide reputation in many lines of trade older than and distinct from the good-will of the typewriter business; (*e*) because the public is attracted by family reputation in trade as it is in the professions; (*f*) because the courts, and the public common sense, recognize the value of a father's good name and a son's right to avail himself of it; (*g*) because having a right to use their names like ordinary property they had a right to bestow such names in the usual way upon a corporation of their own crea-

tion, in which they held a large part of the stock and to which all their time and energies were devoted.

IV. It was *reasonable* that the reorganized Remington-Sholes Company should adopt and continue to bear the name of the old company, (*a*) because it was the successor to the old company; (*b*) because by the retention of the name under which its predecessors had advertised the machine it could hope to better retain the trade; (*c*) because the highest courts of the German Empire in a suit instituted by this complainant had emphatically declared that the name "Remington-Sholes" was lawfully and properly used.

The answer to the test question deducible from the decision of this court in the Singer case, viz., "Is the use of a personal name as PART of a corporate name such a use as is calculated to produce an injury to another beyond that which results from the similarity of the name," would seem too plain to admit of argument, for obviously the addition of the name "Sholes" to the name "Remington" must tend to differentiate the names "Remington-Sholes" and the name "Remington-Sholes Company" from the alleged trade-mark "Remington" or any of complainant's pseudonyms, and it is equally true that the use of the name "Remington-Sholes Company" is less calculated to produce trade confusion than would have been the use of Mr. Remington's name alone, or in such combination as "Remington & Company."

Complainant's Relief Dependent Upon Its Right to the Name Remington, However Used.—The record shows that in this case complainant's claim to the relief prayed for hinges solely upon its alleged exclusive right to the name "Remington" in every conceivable colocation and environment, *first*, because

there is no other point of similarity between its trade-mark or any of its many pseudonyms and the name "Remington-Sholes;" and, *second,* because the name "Remington," and it alone, is alleged to have given rise to confusion in trade; and to the use of the name alone is due the only instances in which, through mistake (not deception), defendant's machines have been taken for complainant's. Yet the authorities are conclusive in holding that something more than the mere use of a surname —some piracy of the complainant's arbitrary marks— must be found before a defendant, having a right to use such name, can be convicted of fraud.

In *Harson* v. *Halkyard et al.,* 46 At. Rep., 271 (May, 1900), the Supreme Court of Rhode Island used the following pertinent language, viz.:

> "No person can acquire a right to use his surname as a trade-mark or trade-name, to the exclusion of others bearing the same surname. Unless, therefore, the signs, labels, and other advertisements of the respondents are such, independently of the use of the name 'Harson' as to deceive the public into the belief that they are buying the goods of the complainant when they are buying the goods of the respondents, the complainant has no ground of complaint. The principal point of resemblance between the signs, labels, and advertisements of the complainant and those of the respondents consists in the prominence given to the name 'Harson.' In view of the fact that the respondent Harson has the right to use that name, we do not think that the complainant is entitled to complain of the mere prominence given to it; the signs, labels, and advertisements being quite unlike in other respects. Though the testimony shows that in some instances persons have confounded the places of business of the complainant and the respondents, the confusion appears to have been due rather to the name 'Harson,' than to any resemblance between the signs, labels, and advertise-

ments. Our conclusion is, therefore, that the bill should be dismissed."

Carmichael v. *Latimer*, 11 R. I., 395.

If complainant can maintain its present action, then with equal right it might ask this court to enjoin the Remington Arms Company, of Ilion, the Remington Machine Company, of Wilmington, or the Remington & Sherman Company, of Philadelphia—all going concerns —from ever announcing the fact that they were engaged in the typewriter business, if they should ever see fit to enter it. Certainly it cannot be denied that these concerns have the right to manufacture typewriters, but if the decision of the lower court in this case is law, then it would be improper and fraudulent for these parties to place upon their machines inscriptions like the following:

Remington Arms Company, Mfrs., Ilion;
Remington & Sherman Company, Mfrs., Philadelphia;
Remington Machine Company, Mfrs., Wilmington.

And if the Remington & Sherman Company should be bold enough to adopt as a trade-mark for its machine the fanciful abbreviation "REM-SHER," this, too, according to complainant's contention, would be a fraudulent trespass upon complainant's rights.

So also, with equal reason complainant relying, as it must, upon an exclusive right to use the name "Remington" in every conceivable manner, could demand an injunction against any one who might attempt to manufacture and properly designate the early typewriting machines upon which the patents have expired and which were admittedly designated and known as "Remington" machines. (R. 92.)

Singer Mfg. Co. v. *June Mfg. Co.*, 163 U. S., 169.

Holzapfels Composition Co., Lim., v. *Rathjens American Composition Co.*, 20 Sup. Ct. Rep., 6.
Centaur v. *Marshall et al.*, 97 Fed. Rep., 785.

Name "Remington-Sholes Company" is Not in Imitation of Any Name to Which Complainant Asserts a Right and is Not Calculated to Create Confusion.—Not only does the record show an entire absence of any fraudulent intent upon the part of the organizers of the Remington-Sholes Company in the adoption of the name Remington-Sholes as part of its corporate title, but it also shows that the selection of such name was not in the way of imitation, intentional or otherwise, of the name of any other corporation. The "REMINGTON STANDARD TYPEWRITER MANUFACTURING COMPANY" had long since passed away, although were it still in existence it could have no ground of complaint. The "Z. G. Sholes Company" was a still-born organization. The "REMINGTON ARMS COMPANY" was engaged in the manufacture of the "Remington Rifle" and the "Remington Bicycle." The "REMINGTON & SHERMAN CO.," of Philadelphia, and the "REMINGTON MACHINE WORKS," of Wilmington, were in other lines of trade. The name of Sholes briefly associated with the original typewriter had twenty years before been abandoned by complainant's predecessors. (R. 64; 200.)

The fact that Wyckoff, Seamans & Benedict has "frequently" (as the amended bill alleges) been designated by the public as the "Remington Company," the "Remington Typewriter Company," the "Remington people," the "Remingtons," etc., etc., will be pressed upon the court, and it will be urged that in the adoption of its corporate name, the incorporators of the Remington-Sholes Com-

pany and its predecessors had in mind a fraudulent purpose to imitate such misnomers of complainant. It is not denied that for brevity and convenience complainant is often designated by the public by these and like terms, but it will scarcely be pretended that any of such is its proper or general appellation, or the one under which, prior to the decree in this case, its business was transacted. The voluminous advertising matter in complainant's record conclusively proves the contrary. See, for example, "Complainant's Exhibit St. Joseph Herald" (R. 959), where under date of April 25, 1899, complainant's machine is advertised as "REMINGTON STANDARD TYPEWRITER, WYCKOFF, SEAMANS and BENEDICT."

Nor does the fact that for convenience the public frequently uses a shorter title for complainant instead of its true name indicate that the public is ignorant of such name. It is plainly inconceivable that a name so universally and conspicuously advertised, as complainant's has been, in newspapers and periodicals, upon all its catalogues, letter-heads, signs and machines, should escape the public mind. An acquaintance—much less a familiarity—with complainant's machine without a knowledge of complainant's true name is a simple impossibility.

We submit that all fraudulent attempt at imitation is clearly disproved by the fact that the Remingtons and their associates, in naming their company, avoided using the name "Remington & Company" or the like and adopted the names of *both* persons Remington and Sholes, who had made its existence possible. In so doing they produced a name that presented a radically different sound to the ear and appearance to the eye from that of

any of the various pseudonyms of complainant. In this respect, therefore, the case at bar is plainly distinguishable from those cases in which a complainant has uniformly traded under a name other than its own, and in which a defendant's organizer, with knowledge of that fact, by reason of his former connection with such complainant, has given to a defendant company a name *idem sonans* with complainant's trade-name, manifestly without other purpose than that of stealing away complainant's trade. Such, for example, was the case of *Gray* v. *Taper Sleeve Pulley Works,* 16 Fed. Rep., 436, in which defendant, formerly associated with complainant, not only adopted for its corporate name the identical name under which complainant for years had traded, but by piracy of complainant's circulars, advertisements, etc., created much actual confusion in the trade.

A like difference in facts also distinguishes the case at bar from that of *Tuerk Hydraulic Co.* v. *F. W. Tuerk, Jr., et al.,* 36 N. Y. S., p. 384. In that case the plaintiff had become known as the "Tuerk Water Motor Co." Defendant F. W. Tuerk, who had long been an employee of plaintiff and had prepared its catalogues, its fanciful advertisements, etc., having severed his connection, formed a partnership with others under the style "The Tuerk Water Meter Co.," and engaged in business in the same city. The record in the Tuerk case showed that defendants not only manufactured a water motor like complainant's, but designated it as "Turek's New Water Motor," and copied the circulars, illustrations, etc., employed by complainant. The fraud that characterized the Tuerk case is manifestly absent from the case at bar.

In *Meneely* v. *Meneely, supra,* the point was made, as in the case at bar, that plaintiffs were known by various

different names involving the name "Meneely," but the court recognized the fact that the name **Meneely & Kimberly,** which involved the use of **two surnames,** was radically different from any of plaintiff's pseudonyms, in which the *single* name Meneely appeared. In this connection it was said:

> "In the cases cited, the degree of similarity and the imitations were far more apparent and distinct than in the case at bar, and **it is worthy of observation and special attention, that here the defendants only employed the surname of one of them, which one alone is of the same character as the plaintiffs', or bears any similarity to their name or any of the various cognomens, some forty in all, by which they have been designated by their numerous business correspondents. It would be a far-reaching extension of the powers of a court of equity, to grant an injunction which would protect the plaintiffs in the use of all the different names, by which they have been in the habit of being addressed by their customers. There is no adjudged case, which has protected trademarks to such extent, or ever struck out the name of a single member of a firm, because it was similar to another engaged in the same business. The partnership name here, was 'Meneely & Kimberly' and the plaintiffs' firm name, 'F. A. & G. R. Meneely.' And there is no such resemblance as would of itself either tend to deceive the public, or indicate a fraudulent purpose. The name of 'Meneely' could not have been used with apparently less design to commit a fraud, unless Kimberly's name was placed ahead of it, which I think was not required."**

It is simply impossible to deny the force or the pertinency of this language of the New York Court of Appeals. It is consonant alike with reason, with common sense and with the accepted methods of the public in dis-

tinguishing persons, firms and corporations in the world of trade. The public does not understand that the business of "Jones and Brown" is identical with that of any two individuals of such names, however prominent the names may have become in a particular line of trade. Nor would a corporation bearing, for example, the name "Westinghouse & Smith Co." be regarded as one and the same with the Westinghouse Co., although it might be surmised that possibly the same Mr. Westinghouse had an interest in both concerns or that some other Westinghouse was availing himself of the family reputation. But while in such cases the reputation of Westinghouse might attract the public eye to both concerns, it alone could not enable the trespass of one upon the goodwill of the other or cause any unlawful confusion as to the identity of the two.

The public views a corporation bearing a personal name or names in precisely the same manner that it does a firm. If there be but a single personal name in the corporate title the public identifies the corporation by it, but if there be several personal names then all serve as a means of identification. Is it reasonable to suppose that the public would regard "E. Remington & Sons" as identical with a firm bearing the name "Remington & Sholes"? The very absurdity of this question suggests its only answer, and yet there is as much reason to assume danger of confusion in such case as in the case at bar.

In *Hygeia etc., Co.* v. *N. Y. Hygeia Ice Co.*, 140 N. Y., 94, the court said:

> "Courts of equity must in such cases assume that the public will use reasonable intelligence and discrimination with reference to the names of corporations with which they are dealing or intend to deal, the same as in cases of individuals bearing the same or similar names."

Not a single one of the many witnesses on behalf of complainant has been heard to assert that he ever mistook the name Remington-Sholes Company for complainant's name or for any of the numerous pseudonyms by which it is often designated by the public, although if proof of such mistake had been made it could not deprive the Remington-Sholes Company of the right to use its corporate name, since, as is shown, such name was adopted in fair and honest manner.

Comparison of Names is Best Test of Probable Deception.—Inasmuch as the record in this case fails to show any instances of actual deception (although the testimony covered a period of several years), the court is left to determine for itself whether there is any such reasonable probability of deception occurring as will warrant the extraordinary remedy granted by the lower court. In Sebastian on Trade-Marks (4th Ed.), p. 128, it is said:

> " It is not sufficient for the plaintiff to produce evidence tending to show that in the opinion of the witnesses deception may occur; he has to convince the court or jury that there is such reasonable probability of deception as to justify interference with the defendant; and if he can not allege and prove that the public are deceived, or that there is reasonable probability of deception, he has no right to interfere with the use of the mark by others. . . . . **If it is shown that both marks have been used for a number of years and no case of actual deception can be produced, it is strong to show that deception is not probable."**

Certainly, a comparison of the name Remington-Sholes Company with the name Wyckoff, Seamans & Benedict, or the name "Remington Typewriter Company," or "Remington People," or the like, must fail to show that

"striking similarity" that must take the place of proof of actual deception in justifying a court to issue its injunction. The decisions are uniform in declaring that a comparison by the court itself is the best test as to the probabilty of the public being misled or deceived by alleged similarities. Thus, in *Liggett & Meyers Tobacco Co.* v. *Finzer,* 128 U. S., 182, the Supreme Court, after comparing the marks of complainant and defendant, said:

> "The judgment of the eye upon the two is more satisfactory than evidence from any other source as to the possibility of parties being misled so as to take one tobacco for the other; and this judgment is against any such possibility. Seeing in such cases is believing; existing differences being at once observed and remaining on the mind of the observer."

In *Lorillard* v. *Peper,* 86 Fed. Rep., 956 (C. C. A.), the court, after stating that there was testimony showing that the resemblance between the packages of complainant and defendant was calculated to mislead and in fact did mislead, said, in speaking by Mr. Justice Brewer:

> "We cannot surrender our own judgment in this matter because others may be of a different opinion, or because it happens, in isolated instances, that some purchaser was so careless as not to detect the difference. It may well be that where many sales were made, some individuals, not particularly attentive, may have purchased the defendant's, supposing they were purchasing the plaintiff's package. Such facts will happen in the ordinary course of business no matter how great the differences; and the fact that they do happen, while it is not to be ignored, is not to outweigh the evidence which comes from a personal inspection of the packages and labels."

Consolidated F. J. Co. v. *Thomas,* 6 Fed. Cases, 341 (2 N. J. Law J., 338).

Cal. Fig. Syrup Co. v. *Taylor Drug Co.,* 14 R. P. C., 564.

What meaning do the inscriptions "REM-SHO" and "REMINGTON-SHOLES COMPANY, MFRS., CHICAGO" convey to the public mind? What meaning comes to the mind of this court as it reads them? Obviously the name "REM-SHO" is understood as a fanciful name designed as a trade-mark to stick in the public memory, just as the familiar name "ADLAKE" (abbreviated from Adams & Westlake) is adopted for cameras, or the name "Edi-Swan" is adopted for electric lamps. The words "Remington-Sholes Company, Mfrs. Chicago" unmistakably announce the fact that the machine is manufactured by the Remington-Sholes Company of Chicago, and are incapable of any other meaning.

In considering a corporate name comprising one or more personal names, the impression is different from that conveyed, under certain circumstances, by a corporate name involving geographical or purely fanciful names, such as "The Home & Colonial Assurance Company," or "The London & Westminster Assurance Company," or "North Cheshire & Manchester Brewery Company." In such latter cases the public may assume that the corporation having the double name is a consolidation of two corporations, but even in such cases the courts have frequently refused to grant injunctions against defendants bearing the double names.

Merchant's Banking Co. of London v. *Merchant's Joint Stock Bank*, L. R. 9, Ch. Div. 560.

London & Provincial Law Assurance Society v. *London & Provincial Joint Stock Life Asssurance Co.*, 17 L. J. (Ch.), 37.

London Assurance v. *London & Westminster Assurance Corp. Ltd.*, 32 L. J. (Ch.), 664.

Colonial Life Assurance Co. v. *Home & Colonial Assurance Co., Ltd.*, 33 Beav., 548.

In Kerly on Trade Marks, Second Edition, p. 510, this distinction between the use of personal and fanciful names is recognized, the author there saying with respect to personal names:

> "The case is therefore readily distinguishable from cases where a 'fancy name,' which is not descriptive of actual facts in ordinary language, is appropriated."

The record fails to show that the Remington-Sholes Company ever used its corporate name otherwise than as an entirety (except as its machines are marked "Rem-Sho") or that it ever in any manner tried to conceal or disguise its identity. On the contrary, the record is full in showing that this corporate name appears upon all its signs, its catalogues and its advertisements, as well as upon its machines.

While the appearance of the name "Remington" in the corporate name of the Remington-Sholes Company may tempt the curiosity of some persons to inquire as to the existence of a connection between such company and complainant, the use of the name "Sholes" in such corporate name is a distinction so prominent that no reasonable person can fail to recognize it, and, if vested with common intelligence, to understand its significance.

Yost Typewriter Co. v. *Typewriter Exchange Co.*, R. P. C., Vol. 19, p. 423.

Aerators Ltd. v. *Tollit et al.*, R. P. C., Vol. 19, p. 419.

Heintz v. *Lutz*, 146 Pa. St., 592.

THE CROSS-PETITION FOR CERTIORARI.

Complainant's cross-petition raises the question as to whether or not the Circuit Court of Appeals was in error in its finding that "the arbitrary name 'REM-SHO,' however, does not seem to us to be sufficiently like 'REMINGTON' to be by itself a reasonable cause of confusion."

In thus summarily disposing of complainant's contention, the Court of Appeals makes plain how frivolous it was regarded.

The Name Rem-Sho a Valid Trade-Mark and No Infringement of Complainant's Rights.—The Record shows (R. 1485) that on October 19, 1897, certificate of registration No. 30,719 was issued to the "Remington-Sholes Company" for the trade-mark "Rem-Sho." The declaration accompanying said registration asserts that the mark was used since about the first day of July, A. D. 1897, and the testimony shows (R. 1104) that the adoption of this name Rem-Sho occurred at a somewhat earlier date. The word "Rem-Sho" being manifestly an arbitrary or fanciful word, is a valid trade-mark. Its registration, therefore, is *prima facie* evidence of its ownership and of the fact that it is no infringement of the registered name "Remington," or of any other registered mark.

Browne on Trade-Marks, Secs. 337 and 338.

Sterling Remedy Co. v. *Eureka C. & Manfg. Co.*, 80 Fed. Rep., 105 (C. C. A.).

Notwithstanding the fact that the name "REM-SHO" was in use for more than a year before this suit was brought and for several years before the testimony was

closed (and complainant attempted to prove instances of confusion up to the time of closing its proof), the record is utterly devoid of any instance whatever in which the name "REM-SHO" has caused the slightest trade confusion, much less can it be said to show any case of actual deception by the use of such name.

Naturally, when the name of the machine was changed from "Remington-Sholes" to "Rem-Sho" the public did not at once accustom itself to the new name, and those who had long been familiar with the old name (the writer of this brief, for example) did not at once adapt themselves to the change. This is noted by complainant's witness McKay, and it is too evident to permit of discussion. The fact remains, however, as testified to by complainant's witness Goodhue, an independent dealer (R. 565), that the machine of the Remington-Sholes Company is today commonly known as the Rem-Sho.

To those familiar with the name Remington-Sholes Company or having such name before them, the name Rem-Sho might, without any exercise of extraordinary cleverness, be considered to be an abbreviation of the name Remington-Sholes. Plainly, however this does not detract from the fact that it is a fanciful name, although coined from the longer one. As some of the witnesses aptly express it, it is a "nick-name" or "fancy name" (R. 1044; 1093; 1230), notwithstanding the fact that it is an abbreviation. In the absence of the name Remington-Sholes Company, or to one ignorant thereof, the name Rem-Sho is obviously meaningless. It might be understood as an abbreviation (if regarded as an abbreviation at all) of "Rembrandt-Showalter" or a dozen other familiar names.

Apparently, complainant's counsel would have this court reason as follows: Remington-Sholes is an infringement

of the name Remington; the public understands Rem-Sho to be an abbreviation of Remington-Sholes; *ergo*, the public understands Rem-Sho to mean Remington. The bare statement of this proposition, false in all its premises, would seem adequate to prove its absurdity. The same mental act that converts "Rem-Sho" into "Remington-Sholes" brings at once to mind BOTH names—"Remington" AND "Sholes"—and with both names thus before him there can be no possible excuse for any one confounding these two names with the single name Remington.

In *Amoskeag Manfg. Co.* v. *Trainer*, 101 U. S., 51 (56), this court had before it a case in which both the complainant and defendant used the letters "A. C. A." upon ticking, but the labels of defendants were held not to trespass upon complainants, the court saying:

> "As it was pertinently observed in the case of Sandford, if the purchasers of the ticking read the name of the company, the letters can give no additional information, even if it be admitted that they are intended to indicate the name of the company. And if they do not read the name as printed, the letters are unintelligible."
>
> *Proctor & Gamble Co.* v. *Globe Refining Co.*, 92 Fed. Rep., 357 (C. C. A.).
>
> *Potter B. & C. Corp.* v. *Pasfield Soap Co.*, 106 Fed. Rep., 914.
>
> *Kann et al.* v. *Diamond Steel Co. et al.*, 89 Fed. Rep., 706 (C. C. A.).

The case at bar is, therefore, plainly distinguished from the class of cases in which defendants have adopted trade-names so nearly *idem sonans* with complainant's that the purchasing public, using ordinary care, would mistake the name used by defendant for that of complainant.

Such, for example, was the case of *Burnett* v. *Phalon*, 5 Ab. Pr. (N. S.), 212, where complainant used the name "Cocoaine," while defendant used the name "Cocoine." The same is true also of the case of *Valentine* v. *Valentine*, R. P. C., Vol. 17, p. 673, where complainant marked its beef extract with the name "Valentine," while defendant marked its extract with the name "Valtine."

Regarding the similarity of such names, Collins, L. J., said:

> "Speaking for myself I frankly admit that when I saw the word 'Valtine' I thought it was 'Valentine' and I believe nine people out of ten would think it was Valentine, seeing 'Valtine' in large letters and 'Valentine' extract at the bottom."

Manifestly, such cases have no bearing upon a case like that at bar, where the fanciful name used by defendant presents a totally different appearance to the eye and sound to the ear from the name employed by complainant.

Whether the public upon seeing the name "Rem-Sho" recognizes it as an abbreviation is of no moment, because the primary signification of the word to every one must obviously be that of a coined or fanciful name. As one of the witnesses has observed, the word "Rem-Sho" is an abbreviation the same as the word "Adlake" (the familiar name of a well-known camera) is an abbrevation of the name of its makers, the Adams & Westlake Company (R. 1044); but surely there can be no question as to the fanciful character of such word. The authorities are conclusive to the point that the mere suggestiveness of a fancy name like "Rem-Sho" cannot detract from its character as a distinctive and valid trade-mark.

Browne on Trade-Marks, Sec. 273.
Davis v. *Kendall*, 2 R. I., 566.
Holt Co. v. *Wadsworth*, 41 Fed. Rep., 34.
Am. and Eng. Ency., Vol. 26, p. 282.

The Syllable Rem.—Considerable testimony was taken and many exhibits introduced on behalf of complainant for the purpose of showing that the abbreviation "Rem" has been frequently used to designate complainant's machine; and certain of the witnesses have testified that they have heard typewriter salesmen and others *engaged in the trade* use the abbreviation "Rem" even when speaking of complainant's machine. Thus the syllable "Rem" is often used in condensed newspaper advertisements of persons applying for positions as operators (R. 274), and in precisely the same manner that the abbreviations "Sm. P." is used for Smith-Premier, "Calig." for Caligraph, "Dens." for Densmore, etc. (R. 135 and R. 424.) The testimony also shows that typewriter operators in applying for positions at complainant's office sometimes used the abbreviations "Rem," "Dens," "Sm. P.," "Calig.," etc., in writing their answers to the question "What machine do you use?" (R. 121 and 135.)

The record conclusively shows, however, that while the syllable "Rem" is sometimes used by operators and salesmen (R. 190 and R. 1428) it is *never* used by customers or the public in speaking of complainant's machine. (R. 1431.) Thus Mr. Baldwin, when asked whether he ever heard the Remington Standard typewriter called "a Rem," answers, "No, sir, I never did, although I sold the machine for several years." (R. 1016.) Complainant's witness Crean (R. 120) when asked, "How have such machines (*i. e.*, complainant's) generally been known and designated among users of typewriting machines and by purchasers thereof to your knowledge?" answers, "I have never known them to have been called or designated by any other name than Remington machines," etc. Complainant's witness McNally says the same. (R. 321.)

Complainant caused various of its employees to canvass large cities throughout the country, and for this purpose furnished them with the names of parties of whom the question was asked, "What typewriting machine do you use?" These lists, introduced in evidence, show that out of the hundreds of inquiries made there *was not a single instance* in which the user of complainant's machine designated it as "a Rem." (R. 166; 203; 334.) It is true that complainant has spread upon the record (R. 148-158) a long list of names of Philadelphia users of typewriting machines, and the witness Johnston, who produced *a typewritten copy* of his list of these names, testified in his direct examination that certain of the parties in speaking of the complainant's machine used the abbreviation Rem. Upon cross-examination (R. 160) this witness admitted that he was unable to state whether the parties used the abbreviations or not, and when his *original* memorandum-book was produced (R. 163) it showed that the typewritten list was incorrect, as the witness admitted (R. 164), and that the abbreviation "Rem" was not used in a single instance. The testimony of Johnston and his list, while proving nothing for complainant, furnishes an instance of the unfairness that defendant has encountered in the testimony in this case.

Complainant's pretended exclusive right to use the term "Rem" apparently originated in the fertile brain of its detective witness Crean. Upon one of the memorandum blanks produced by him (R. 137) he wrote, "Why don't we own the word Rem too? Crean;" and this witness, with his readiness to assert anything that may be helpful to his employer, states as of his own knowledge that the use of the abbreviation Rem by defendant had misled prospective buyers of machines in many instances. (R. 137.) Not only does the re-cross examination of

this witness clearly indicate that his statement is devoid of truth, but, as we shall presently show, the testimony of the witness Downs and the statement of the witness Johnston (the instances referred to in Crean's examination) clearly disprove his allegation. Defendant's witness White, the manager of the F. S. Webster Company, and who has handled both the Remington and the Rem-Sho machines for years, states that he never heard a customer use the term "Rem" (R. 1431), and that as the result of his experience he has never found any confusion to arise between complainant's machines and that of the Remington-Sholes Company by reason of the fact that the term "Rem" is occasionally used among salesmen or in correspondence as a designation for complainant's machine. (R. 1432.)

We are confident that this court will not disturb the unanimous finding of the Circuit Court of Appeals affirming defendant's right to use the fanciful name "REM-SHO," particularly as complainant has failed utterly to prove any confusion occurring from the use of such name.

Cases Distinguished. In considering the cases relied upon by complainant to support its bill, this court will notice that every prior case, in which the use of a personal name has met with judicial condemnation, differs from the case at bar in some of the following vital particulars:

(*a*) In this case defendant has used two names—Remington and Sholes—thus distinguishing its corporate name "Remington-Sholes Company" both by appearance and sound from the name of complainant and from its pseudonyms. In prior cases defendants have employed the *single* surname by which the complainants therein were known to the trade.

(*b*) In prior cases defendants have adopted the single surname peculiar to complainants for the purpose of palming off defendants' wares for those of complainants' manufacture. In this case, as the unrefuted testimony of complainant's own witness, Mr. Sholes, shows (Rec. 424) the name Remington-Sholes was adopted to avail of the family reputation of these names, and there was no purpose of confusing defendant's machines with those of complainant. (R. 439-440.)

(*c*) In prior cases the name employed by defendants has been one devoid of any *general family reputation* and known only in the complainant's particular line of manufacture. In the case at bar, on the contrary, the name Remington has been famous the world over since long prior to the advent of the typewriter—a fact that would impel its adoption in any industrial enterprise.

(*d*) In prior cases the single surname employed has been of a person who (as stated in the Rogers case, 70 Fed. Rep., 1017) has "sold his name as a decoy, or permitted his name to be used for hire to deceive the public." In the present case there was never any compensation promised or paid to either Sholes or Remington for the use of their names (R. 440-441), and in this case also the machine of defendant was one made commercially possible by both Remington and Sholes, both were largely and actively interested in the management of the old company, and Mr. Remington continued as the general manager of the new company.

(*e*) In prior cases the persons contributing their names to be used by corporate defendants had already sold to the complainants their business and the right to use their names, and hence were morally, if not legally, bound to avoid the injury of such right by engaging in business under any corporate name that would injure their vendees

more than would the simple use of their individual names. In the case at bar there had never been any contractual relations whatever between Franklin or Carver Remington or Sholes and complainant.

(*f*) In prior cases defendants had copied the signs, or labels, or characteristic marks of complainants in their endeavor to palm off their goods as and for those of complainants. In the case at bar it will scarcely be contended that defendant has ever attempted to imitate complainant's signs, advertisements or other insignia, but, on the contrary, it has adopted most distinctive signs, circulars, etc., of its own, and has invariably by its advertisements, its literature, and its instructions to its agents, taken every reasonable precaution to prevent confusion by the purchasing public—with the result that no one could purchase a machine of defendant's manufacture without having forced upon him the knowledge that it emanated from the "Remington-Sholes Company, Manufacturers, Chicago."

(*g*) In prior cases defendants in their efforts to steal complainants' trade have made their wares in close imitation of complainants'. In the present case, on the contrary, defendant's machine was a most radical departure in appearance from all other typewriting machines upon the market.

(*h*) In prior cases the courts found that the defendants had resorted to various other kinds of fraudulent acts to palm off their wares for those of the complainants. In the present case the Court of Appeals, although enjoining the use of the name "Remington" in the name "Remington-Sholes," has unanimously found (R. 1522) that defendant has not done anything to promote confusion in the public mind beyond the bare use of the name upon its machines and in its literature.

R. W. Rogers Co. et al. v. *Wm. Rogers Mfg. Co.*, 70 Fed. Rep., 1017. As it is upon this decision that Judge Cox bases his concurring opinion in the case at bar (R. 1530), we trust that your Honors will carefully examine this Rogers case, as we are confident that a consideration of the facts therein must at once show how widely that case differs from the one before you. In this Rogers case, as the opinion shows, complainant's predecessor had achieved a wide reputation in a single line of industry, viz., the manufacture of silver plate.

> "In 1879 or 1880 a corporation called the Rogers Silver Plate Co. was formed in New York City by Robert W. Rogers, one Brown and one Boardman. Rogers had been a salesman of silver-plated ware but was not a manufacturer. The corporation was formed so that an Albany manufacturer by the name of Strickland and doing business as R. Strickland & Co. could use the name of Rogers on his flat ware, and gain the advantage of the reputation which the name had in the market. For the use of his name Robert W. Rogers was given a fourth interest in the corporation. Some time thereafter, Strickland and Rogers disagreed, and Rogers became a salesman of the goods made by the complainant."

Later on, R. W. Rogers induced others to form a new corporation under the name "R. W. Rogers Co." and entered into an agreement with the Curtis-Crume Company by which the former manufactured silver-plated flat ware for the latter company, which ware bore the name of the said Rogers Company. In summing up its findings of fact the court there states:

> "It is evident that the scheme was a reproduction of the old scheme in which Rogers was engaged in 1880 by which he sold his name as a decoy, or permitted his name to be used for hire to deceive the public."

This Rogers case is wide of the case at bar for the following, among other reasons: (1) The name Rogers had no reputation outside the single line of industry in which it was employed, viz., silver-plated ware, and the plain object of the use of the name "Rogers" by defendant was to trade upon complainant's reputation and sell its goods for complainant's. In the case at bar, on the contrary, the family name "Remington" had a world-wide reputation in many lines of industry—a reputation that would impel the use of such name by any member of that family in any manufacturing business. (2) In the Rogers case, R. W. Rogers was not engaged in the manufacture of the goods bearing that name; whereas in the case at bar, Franklin Remington has at all times been the general manager of the company manufacturing the typewriting machines in connection with which the corporate name "Remington-Sholes Company" and the name "Rem-Sho" have been used. (3) In the Rogers case, as the court there found, R. W. Rogers "sold his name as a decoy or permitted his name to be used for hire to deceive the public." In the present case, as the uncontroverted record shows, Franklin Remington expended $15,000 and months of close application in the development and exploitation of the typewriting machine and was a large stockholder in, and general manager of the company that made it. (4) In the Rogers case R. W. Rogers gave to the corporation organized by him a single surname, although others experienced in the same line of manufacture were associated with him. In the case at bar, on the contrary, two surnames, Remington and Sholes, were given to the corporation, thereby clearly distinguishing it from complainant and its pseudonyms. (5) The decision in the Rogers case was rendered by Judges Wallace and Shipman. The fact that

Judge Wallace so emphatically dissents from the majority opinion of the Court of Appeals in the case at bar is most persuasive of the radical difference between these cases. This Rogers case was immediately followed by a decision of the same court in *Rogers* v. *Wm. Rogers Mfg. Co.*, 70 Fed. Rep., 1019, in which defendant was held entitled to the use of his name.

Peck Bros. & Co. v. *Peck Bros. Co.*, 113 Fed. Rep., 291, is without bearing here. In that case the court found that "the record is replete with evidence touching the confusion of goods and the sales thereof. . . . Upon the question of confusion of goods there is no dispute." It restrained the use by defendants of the name "Peck Bros. Co.", not merely because of the fiduciary relations in which defendants had stood with respect to the original "Peck Bros. & Co.", but for the reason thus plainly stated by his Honor, Judge Jenkins:

> "Here the artifice consisted not in using one's own name, but assuming *falsely* the name 'Peck Bros.', there *being no brothers of that name in the corporation*. . . . The assumption of the name 'Peck Bros. Co.' was of itself the utterance of a falsehood, for there were no brothers Peck interested in the corporation."

The case of *Chickering et al.* v. *Chickering & Sons*, 120 Fed. Rep., 69, was an appeal from an order granting a preliminary injunction. In that case the defendant corporation had selected a *single* surname which had no reputation outside the *single line of manufacture*, had imitated the marking of complainants' pianos and had conspicuously displayed upon its pianos the words "the only piano made by Chickering." In its decision the Court of Appeals said:

> "We prefer to reserve judgment until the coming

> in of proofs. For the present we cannot say that the discretion of the court below was improperly exercised in restraining the acts complained of. It may be that the order is in some respects too broad in its terms, *particularly the second paragraph of it;* but the assignment of errors goes to the whole order, and not to any particular paragraph of it, so that we are not called upon to scrutinize language unchallenged by the parties complaining."

The second paragraph of the order (concerning which the court thus expressed its doubt) was one enjoining the use of the name Chickering "to designate the name of a corporation manufacturing or dealing in pianos." This court will therefore see that the Chickering case is not an authority here.

In *Massam* v. *J. W. Thorley's Cattle Food Co., Ld.*, 14 C. D., 748, J. W. Thorley was the holder of a one-shilling share in the company, and as Lord Justice James stated:

> "He either tendered himself for sale, or was found for purchase by some persons in order that his name might be got into a joint stock company formed for the sake of selling these goods."

The court also found that the defendant company had imitated the get-up of plaintiff's goods and had intentionally acted in such way as to induce the public to take defendant's goods from those of plaintiff's manufacture. Yet notwithstanding these facts, the injunction left the defendants at liberty to use their name and the word "Thorley" in any way not calculated to mislead the public. (See Kerley on Trade-Marks, p. 511.) From these facts the court will see that the Thorley case is wide of the case at bar.

In *Pillsbury et al.* v. *Pillsbury-Washburn Co.*, 64 Fed. Rep., 841 (C. C. A.), the complainant (appellee) and

its predecessor had long employed a peculiar brand for flour consisting of the words "Pillsbury's Best XXXX, Minneapolis, Minn.," printed in blue and red within a double circle of dots, and at each side of the circle the word "Pillsbury" was arranged in a vertical line, while beneath the circle the words "Pillsbury's Best" appeared. Defendant's flour was marked with the words "L. F. Pillsbury's XXXX Best Patent Minnesota," arranged within circles of dots, the words "L. F. Pillsbury's Best" being also arranged in the same position that the words "Pillsbury's Best" appeared in complainant's brand. The contrasting colors in both brands were the same. The Court of Appeals distinctly stated that "the appellant Pillsbury has an undoubted right to use his own name in any honest way," but found that there was a fraudulent imitation of complainant's brand and the decree was directed against the brand. The cautionary notices put out by defendant in that case were not directed to the ultimate purchaser, but to the dealer, and hence were of no avail. The case is therefore clearly distinguishable from the case at bar.

Walter Baker & Co. v. *Baker*, 77 Fed. Rep., 181; *Walter Baker & Co.* v. *Sanders*, 80 Fed. Rep., 209; *Walter Baker & Co.* v. *Baker*, 87 Fed. Rep., 209. In all these Baker cases defendants' goods were put up in packages with marks and labels closely resembling the complainant's and in these cases defendants' whole conduct was tainted with fraud. The court enjoined defendants against using the name "Baker's Chocolate" but it was held in the last case that "defendants may indicate in any appropriate language that their chocolate is made by W. H. Baker of Winchester, Va." And to avoid expense of changing the labels the court allowed defend-

ants to simply apply a label bearing the statement that "W. H. Baker is distinct from and has no connection with the old chocolate manufactory of Walter Baker & Co." This statement is no more distinctive than those constantly used in the case at bar by defendant's principal since the very inception of its business.

In the brief before the Court of Appeals counsel for complainant invoked the decisions of this court in these Baker cases and argued with much vehemence that because this court had forbidden the defendant there to mark his goods "Baker's Chocolate" defendant here should be enjoined from marking its machines "Remington-Sholes Co., Mfrs., Chicago," and with the fanciful trade name "Rem-Sho." Aside from the fact that the present case contains none of the elements of fraud that characterized the Baker cases, the court must perceive at once the radical difference between the use of the Christian name or initials of a defendant and the use of TWO DISTINCT SURNAMES to differentiate a defendant's goods from those of a plaintiff. This distinction is very clearly recognized by Mr. Sebastian in his "Law of Trade-Marks" (4th Edition), p. 23, in the following language:

> "There is between a name of an individual or firm used as a trade-mark, and a fancy name or arbitrary symbol used for the same purpose, a broad distinction which was early perceived, and which caused some difficulty in the universal acceptance of a name as an efficacious trade-mark. This difference is that a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate. The addition of the Christian to the surname does, indeed, diminish the number of persons to whom the appellation belongs; but the Christian name is commonly abbreviated to an in-

itial letter, and, in any case, the surname is the important part of the name, beyond which many persons do not care to investigate."

Plainly there is nothing in these Baker cases to warrant the decree of the lower court in this cause enjoining defendant against the use of the name Remington-Sholes Company and the fanciful trade-mark Rem-Sho. On the contrary, the language of this court in the Baker cases if followed here must permit defendant to use upon its machines the words "REMINGTON-SHOLES COMPANY, Mfrs. CHICAGO" because these words merely state in another way that the machines are made by the Remington-Sholes Company of Chicago. If any doubt existed as to the bearing of the Baker cases above cited we need only refer to the recent decision of the Court of Appeals for the Second Circuit in *Baker* v. *Baker,* 115 Fed. Rep., 297, where the defendant, a *corporation* named "William H. Baker, Syracuse," was expressly allowed to mark its chocolate with such corporate name. Certainly if in that case it was proper for the defendant corporation to mark its goods "William H. Baker, Syracuse" it must be equally lawful for defendant in this case to mark its machines "Remington-Sholes Company, Chicago."

In *Garrett* v. *T. H. Garrett & Co.,* 78 Fed. Rep., 472 (C.C.A.), it appeared that complainants were the manufacturers of snuff long known upon the market as "Garrett's Snuff." The defendant was a corporation organized by T. H. Garrett with a capital stock of 350 shares, to which Garrett subscribed to two and one-half shares only. T. H. Garrett was totally devoid either of personal or family reputation and simply gave his name to the defendant company, *in which he had no substantial interest and was not an officer, for the sole purpose of de-*

ceiving the public, and in furtherance of this object the defendant company closely imitated the packages and labels of complainant. Manifestly the facts in the Garrett case clearly distinguish it, therefore, from the case at bar; and in the later case of *Proctor & Gamble Co.* v. *Globe Refining Co.*, 92 Fed. Rep., 357 (C. C. A.), the same court considered this Garrett case and made plain the fact that the decision in such case was because T. H. Garrett *had no material interest in the defendant company and had allowed the use of his name for the sole purpose of effecting confusion in trade.*

In *Stuart* v. *F. G. Stewart Co.*, 91 Fed. Rep., 243 (C. C. A.), it appeared that complainant had built up a large trade for "Stuart's Dyspepsia Tablets." F. G. Stewart organized the defendant corporation and began selling a like preparation under the name "Dr. Stewart's Dyspepsia Tablets." The court found that defendant's *packages unfairly imitated complainant's* and decreed that defendant be enjoined from using the words "Dr. Stewart's Dyspepsia Tablets," stating:

> "It needs no argument to show that these names are *idem sonans* and that the use of both of them in connection with dyspepsia tablets must cause great confusion in the sale and great wrong to purchasers."

The facts in the Stuart case clearly differentiate it from the case at bar.

In *LePage* v. *Russia Cement Co.*, 51 Fed. Rep., 941 (C. C. A.), the facts were stated to be substantially the same as in the LePage case reported in 147 Mass., 206. LePage, having established a reputation for his glue as "LePage's Glue," formed a partnership and thereafter organized a corporation to which was assigned the entire assets and good-will of the business. He continued actively in the business of such corporation for some time

and then sold his stock and severed his connection therewith. Subsequently he formed a corporation entitled "The LePage Company," which sold glue designated as glue made by the LePage Company. The court held that this was a violation of the right acquired by the original corporation to the use of the name "LePage" in connection with glues, and said:

> "We have no occasion to deal with the long line of authorities commencing with *Croft* v. *Day*, 7 Beav., 84, of *Holloway* v. *Holloway*, 13 Beav., 209, and ending with *Chemical Co.* v. *Myer*, touching the original inherent right of every person to the honest use of his own surname. *These do not apply when the original right has been voluntarily parted with as in the case at bar,"* etc.

The adoption of the name "LePage Company" would naturally lead the public to call its product "LePage Company Glue" or "LePage Glue," and the *single* name "LePage" would be the one by which the public would identify both the complainant's and defendant's glue. The LePage case, therefore, is not only distinguished from the case at bar because LePage had "parted with his right" to the use of his name and was therefore *estopped* to confer such name upon a second corporation, but is distinguished also in the further respect that it involved the use of a *single* surname which the public would necessarily rely upon to designate the glue made by the defendant company. Neither Remington nor Sholes, in the case at bar, had in any manner parted with his right to the use of his name, nor was the public left to rely upon a single surname whereby to designate the machine manufactured by the Remington-Sholes Company. On the contrary, the record shows beyond dispute that the machines of the old Remington-Sholes Typewriter Company

were known solely as the "Remington-Sholes," while the machines of the Remington-Sholes Company are known as the "Rem-Sho."

The case of *Holmes, Booth & Hayden* v. *Holmes, Booth & Atwood*, 37 Conn., 278, was also one in which, as the court stated, there was involved "the element of a *contract or estoppel;*" and the courts, when citing this case, have generally recognized the fact that it turned solely upon such question of estoppel, as all the defendant's incorporators had been connected with the complainant company and withdrew therefrom for the express purpose of organizing the defendant company with its factory in the same town and its principal business offices in the same cities and upon the same streets as complainants.

In *Charles S. Higgins Co.* v. *Higgins Soap Co.*, 144 N. Y., 462 (January, 1895), Charles S. Higgins, who with his wife and sons organized the defendant company, was the son of the original Charles S. Higgins, who had established a wide reputation for his soap under the name "Higgins' Soap." After Charles S. Higgins succeeded to his father's business, he organized complainant company and was its president. He transferred to complainant, among other assets, a label bearing the words "Higgins' Soap." The record showed that complainant came to be designated as the "Higgins' Soap Company," and its product as "Higgins' Soap." After the defendant company was organized, it established its business in the same city with complainant, and marked its labels and soap "Higgins Soap Co., original laundry, Charles S. Higgins, Pres." The record showed extensive confusion in trade, both past and probable, because the name "Higgins' Soap" naturally attached to defendant's product, since the

single name "Higgins" was the only distinctive name whereby the public could designate it. The facts of the Higgins case clearly distinguish it, therefore, from the case at bar, in which neither Remington nor Sholes ever had any connection with complainant company, and in which, with equal prominence, *two* names (Remington and Sholes) are given to defendant corporation, and a fanciful name (Rem-Sho) is given to the product.

Even in the Higgins case and, notwithstanding the slight difference between the corporate names, the court said:

> "If the right of complainant to relief depended exclusively upon the comparison of the corporate names of the parties and the inferences to be drawn from such comparison and without reference to intrinsic facts, it might well be doubted whether the names are so similar that the court could find that confusion and injury would be likely to arise."

If the court entertained doubt upon a comparison of names so closely resembling each other as those in the Higgins case, certainly it could hold no doubt in a case like that at bar, where the name of the real defendant company is so manifestly unlike the name or pseudonyms of the complainant company.

Certainly, the fact in the case at bar that the defendant has marked its machines with a distinctive fanciful name, has marked its machines also with a corporate name havnig TWO SURNAMES OF EQUAL PROMINENCE, and has placed in the hands of the ultimate purchaser every means for distinguishing its product from complainant's, must clearly show the marked distinction between the Higgins case and the case at bar. That any force whatever may be attached to the Higgins case, it must be distinguished from the case of *Meneely* v. *Meneely*, of which the court

in the Higgins case expressly approved, and from the Duryea case recently decided by the U. S. Circuit Court of Appeals. Upon whatever grounds the Higgins case is distinguished from such two cases, the same distinction must carry it at every point wide of the case at bar.

In *DeLong et al.* v. *DeLong Hook & Eye Co.*, 35 N. Y. S., 509, Oscar A. DeLong, a man without any experience whatever in the manufacturing business and without any family reputation, commenced to manufacture and sell hooks and eyes mounted upon cards in the same manner as plaintiff's and marked with the words "DeLong Hook & Eye Company, makers, New York," the manifest purpose being to cause the hooks and eyes of the defendant company to be mistaken by the public for the DeLong hook and eye with which it had long been familiar. The single name "DeLong" was the only distinctive one in defendant's corporate name and the inevitable result was that defendant's product became confused with complainant's. The court, after noticing the fact that the selection of the name of the defendant company was made for the purpose of "decoying away plaintiff's trade," and the further fact that there were but slight and immaterial differences in the appearance, coloring, size of cards, etc., between complainant's and defendant's packages, said:

> "But the circumstances surrounding the creation of the defendant and the name of it, satisfy us as they did the trial court, that the selection of the name was not an honest one, but was a part of the original scheme of Oscar A. DeLong to make such use of his own name as would enable him to profit by the name which the plaintiffs had given to their hooks and eyes and which they had made valuable by much labor and a liberal expenditure of money."

In the DeLong case the court expressly said that the

decree "should not embarras the defendant in any honest effort which it may hereafter make to put its goods upon the market in a manner which shall not have the effect of persuading customers that the defendant's goods are the manufacture of the plaintiffs."

The facts of the DeLong case clearly distinguish it, therefore, from the case at bar, wherein both Remington and Sholes not only had their fathers' reputations as a warrant for using their names, but also had themselves produced a valuable machine that is placed before the public under a fanciful name totally unlike the name of complainant's machine, and under a corporate name composed of two distinct surnames. The DeLong case came again before the court in December, 1895, upon a motion to attach defendant, DeLong, for contempt, and Ingraham, J., granted the motion, but upon appeal, 39 N. Y. S., 903 (June, 1896), the order of the court adjudging DeLong guilty of contempt was reversed and it was held that DeLong might use his name rightfully in business notwithstanding any injury it might inflict upon complainant. This final disposition of the DeLong case seriously modified the effect of the prior decisions. But aside from the wide distinction between the facts in the DeLong case and those of the case at bar, the court will notice that the DeLong case, so far as it may have bearing upon the case at bar, is ruled by the later Duryea decision.

In *Clark Thread Co.* v. *Armitage*, 74 Fed. Rep., 936 (C. C. A., 2nd Circuit, May, 1896), the complainant had lawfully succeeded to a thread-manufacturing business established many years before. Its threads were placed upon the market under the name of "Clark's Thread" or "Clark's Cotton," and had become universally known by these names and as well also by certain fanciful labels

and arbitrary letters that were placed upon the ends of the spools on which the thread and cotton were wound. William Clark (known in the case as William Clark No. 1) was the grandson of the original Clark by whom the business was established, was one of the original promoters of the complainant company and its sole resident partner in this country, and had become very well known in connection with complainant's business. The defendant Armitage was the agent of the "William Clark Company," which was organized by another William Clark (known as William Clark No. 2), who had been associated with complainant company in responsible positions and as a director. The court found that the purpose of the organization of the William Clark Company and of its methods of doing business was to secure for such company complainant's business by placing defendant's goods upon the market in such way that they should be mistaken by the public for the goods of complainant. To this end the William Clark Company imitated the labels on complainant's spools in various ways so that these labels not only showed the words "Clark's Spool Cotton" in the same type and with the same arrangement as on complainant's spools, but showed also initial letters "N. E. W." arranged horizontally across the labels in the same manner as the initials "O. N. T." were arranged on complainant's spools. Moreover, as the court stated, "the exhibits in the case make it manifest that the defendant has been ingenious and persistent by advertisements, circulars, cards and devices of various sorts, to represent that the thread which he was selling was Clark's New Spool Cotton." There had been an assent by complainant to the use by the William Clark Company of that corporate name, and the court stated that in the absence of such assent the selection of the name would have

been both unnecessary and improper, because, as the court said, "the name was adopted not merely to obtain the benefit of the reputation of William Clark No. 2, but to gain the enlarged reputation which had belonged to Clark's thread for a great many years."

The Clark case was decided several years before the Duryea case and by the same court, so that the decision in the latter case must control so far as the questions dealt with are the same. But even in the absence of the later decision of the Duryea case the distinction between the Clark case and the case at bar must be apparent. The public had come to know complainant's product as "Clark's Thread" or "Clark's Spool Cotton." When, therefore, the William Clark Company began business and marked its spools of cotton with the words "Clark's Spool Cotton" an inevitable confusion resulted with great loss of trade to complainant. The word "Clark" was the only surname and the one distinctive name in the title of the William Clark Company, and as in complainant's label, was the one word upon which the public could rely. The prefix "William" was manifestly of little avail, not only because such an ordinary Christian name does not readily fix itself in the public mind, but because purchasers, knowing only the Clark Company, would not differentiate the William Clark Company from it, particularly when the names were associated upon labels so closely similar to those with which they had long been familiar.

Is it conceivable that the decision in the Clark case would have been the same if defendant had adopted the name "The Clark Jones Company" and had displayed each of these surnames with equal prominence and had adopted labels radically different in appearance from plaintiff's labels and bearing a fanciful trade-name totally

unlike in sound or appearance to anything employed by complainant? Or would the court have enjoined a son of William Clark No. 1 if, associating himself with another individual who had invented an entirely different style of thread and whose father had been a pioneer inventor in the thread industry, he had organized a corporation for the manufacture of such new style of thread, had adopted entirely different styles of labels and a different fanciful name, had taken every precaution to prevent confusion in the public mind and had adopted a corporate name including both surnames with equal prominence? We submit that the mere asking of these questions suggests a negative answer; and yet an affirmative answer to such questions, had they arisen in the Clark case, must be assumed before it can be said that the decision in that case shall control the case at bar.

In *Fuller* v. *Huff*, 104 Fed., 141 (C. C. A.), complainant had traded for many years under the name of "Health Food Company," and under such name had acquired a wide reputation for his goods. Defendant's principal, after having presented its goods to the public for years under the name "Sanitarium Foods" and "Invalid Foods," adopted the name "Sanitarium Health Food Company." While it may be difficult to reconcile the "Health Food case" with the case of *Goodyear Rubber Co.* v. *Goodyear Rubber Mfg. Co.*, *supra*, it is still clearly distinguishable from the case at bar. In this case the name "Remington-Sholes Company" and the fanciful name "Rem-Sho" as used by defendant are manifestly a step further removed from any of the complainant's pseudoynms and from the name of its machine than were the names "Remington-Sholes Typewriter Company" and the name "Remington-Sholes" as formerly used. In the

Health Food case complainant became known by the name "Health Food Company," and manifestly, as defendant appropriated all of complainant's name, the prefix "Sanitarium" employed by defendant, being a word of kindred meaning, might not readily serve as a means whereby the public could differentiate the two names. There is certainly nothing in this Health Food case to indicate any purpose of the court to modify its decision in the Duryea case, the facts in which are so singularly like the facts in the case at bar.

In *Roy Watch Case Company* v. *Camm-Roy Watch Case Company*, 58 N. Y. S., 979, it appeared, on a motion for temporary injunction, that defendant company had acquired the right to use the name of "Roy Manufacturing Company." Thereafter, and with the manifest purpose of invading complainant's trade, defendant adopted the name "Camm-Roy Watch Case Company." The court (at special term) restrained defendant, not because of its use of the name "Camm-Roy," as it admittedly had the right to use the name "Roy Manufacturing Company," and obviously the right to use the name "Camm-Roy Company," but because, by adopting the combination of words "Roy Watch Case Company," it unfairly and unnecessarily used all of complainant's name.

In *S. Howes Co.* v. *Howes Grain Cleaner Co. et al.*, 52 N. Y. S., 468, it appeared that complainant, being engaged in the manufacture of grain-cleaners, etc., had become known in the trade by various pseudonyms, such as "The S. Howes Grain Cleaner Co." Five out of seven of defendant's incorporators had up to two weeks before its incorporation been in the employ of plaintiff, and one of these, C. N. Howes, defendant's president, had been

one of the executors and manager of complainant's business for the executors. C. N. Howes, as the court stated, possessed no greater knowledge or experience in the business than the other incorporators, and there was therefore no reason for making prominent his name except that it might be used as a decoy to attract complainant's trade. The name "Howes" was the distinctive name common to both companies and was the only name upon which the public would rely, since the words "Grain Cleaner" appearing in defendant's name would be as readily associated and had in fact been associated with complainant's name because of the identity of their business.

In *International Silver Co.* v. *Simeon L. & George H. Rogers Co.*, 110 Fed. Rep., 955, Shipman, J., August, 1901, it appeared that Simeon L. and George H. Rogers were sons of one of the three Rogerses who comprised the original firm of "Rogers Brothers." George H. Rogers was a farmer and Simeon L. Rogers had been a workman on day wages in the silverware business prior to the organization of defendant company. The trade-mark adopted by defendant company closely resembled the trade-marks of complainant and *special prominence* was given to the word "Rogers" and "Rogers Brothers." In this connection the court said:

> "In point of fact the prefixes and suffixes are obscure and to the ordinary observer, enigmatical. They actually convey no meaning. *The marks simulate the marks of the complainant*, and under the guise of simulation present the appearance of the marks of the complainant."

The preliminary injunction was granted as to the trade-marks.

The preliminary injunction was refused as to defend-

ant's corporate name, although the court said that "if this case was at final hearing upon precisely the same evidence that is now presented, the history of the corporation would strongly tend to a conclusion that its name had been selected unnecesarily for the purpose of unfair competition."

It appeared that the defendant company had put out circulars which described its goods as "real Rogers' goods," and had in various ways sought to palm off its goods for complainant's.

While this Rogers case is parallel in some respects to the case at bar, it is clearly distinguished therefrom in the very particulars that produced the unfavorable decision and criticism of his Honor Judge Shipman. In that case, as in this, the defendant company was organized by men whose father had acquired a wide and favorable reputation. This motive for using the name Rogers by the defendant company was recognized by Judge Shipman as a legitimate and proper one since he distinctly says in speaking of Simeon L. Rogers, "he brought no peculiar element of success to the new business except the declaration that he was the son of one of the original members of 'Rogers Brothers.'" But the Rogers case is clearly distinguished from that at bar in the following respects: Simeon L. Rogers had been but a mere day laborer in the silverware business. In this case, Franklin Remington had not been a day laborer in the typewriting business but he had been associated with Mr. Sholes for months in the construction and perfection of the typewriting machine that was to be manufactured by the company to be organized; he had paid from his own pocket the expenses to the amount of thousands of dollars for the work upon this machine; he had subscribed to a large part of the capi-

tal stock of the company organized for the manufacture of this machine, and with the personal assistance of Mr. Sholes he had for the first year or eighteen months of the company's existence personally managed the business and superintended every detail of manufacture. In the Rogers case two parties of the name of McFayden were associated in the defendant company, but their name was concealed, notwithstanding the fact that they had a deserved reputation in the silverware business and were to be the active managers of the corporation In this case, on the contrary, the name of Sholes appears with equal prominence upon the machines with the name Remington.

Another difference between the Rogers case and that at bar is found in the fact that in that case there was apparently a purpose on the part of the defendant company to conceal the identity of the complainant and to create the impression that the defendant company was itself the old original company. In the present case, on the contrary, the defendant company by word of mouth, by circulars, by letters of instruction, by advertisements and in every conceivable way has advised the public that it does not manufacture the well-known Remington typewriter or the Remington Standard typewriter. Moreover, in like manner defendant, by its agents and salesmen, has uniformly compared the two machines, pointing to the Remington Standard as the "well-known and excellent machine" that has been favorably before the public for many years, and pointing to the new machine as an improvement over the old machine, but made by an entirely different concern. And while defendant has sought to obtain advantage from the use of Mr. Franklin Remington's name, it has never sought to palm off its machine for complainant's but has simply used the name in such

a way as to inform the public that its machine was being manufactured under the supervision of Mr. Franklin Remington, the reputation of whose family was world-wide long before the existence of a typewriting machine.

In *Meyer* v. *Dr. B. L. Bull Vegetable Medicine Co.*, 58 Fed. Rep., 884, the court had before it a case in which the defendant had, with the intention to decieve, adopted as a name for its medicine the words "Dr. Bull's Cough Syrup," being precisely the name with which complainant's medicine was marked. The court there said:

> "The defendant devised, constructed and arranged the name as well as the wrapper of its article for the fraudulent purpose of causing it to be mistaken and sold in the market for complainant's article, and that the tendency of defendant's acts in the premises was to effect that result."

The court therfore enjoined defendant against the use of the name "Bull's Cough Syrup" or "Dr. B. L. Bull's Cough Syrup," but did not enjoin defendant against the use of its corporate name.

In *Plant Seed Co.* v. *Michael Plant Seed Co.*, 23 Mo., 579, the case came before the court upon demurrer to a bill or petition that alleged fraudulent adoption of defendant's name. The demurrer admitted the fraud charged and was therefore overruled.

No Unfair Trade Competition by Defendant or the Remington-Sholes Company.

The Circuit Court of Appeals in its majority opinion said (R. 1522):

> **"We do not find in this voluminous record sufficient evidence that defendant" (by which name, as the opinion states, the Remington-Sholes Company is designated) "has itself done**

anything to promote confusion in the mind of the public, except to use the name Remington on its machines and in its literature. It may very well be that it understood quite clearly that by using the name, defendant gave to all middlemen and dealers, outside of its own agents, opportunity and perhaps a suggestion to misrepresent the parentage of the machines, but, if it had the right to use the same, it cannot be held responsible for the consequences of such use."

This unanimous finding might well excuse this court from the tedious examination of the record in the absence of any specific showing by complainant of material error in such finding. But we trust that your Honors may at least go far enough into the testimony to see how uniformly fair have been defendant's methods, and how complainant's record of over a thousand pages is padded with a mass of improper, irrelevant and incompetent matter such as foreign advertisements with which defendant admittedly had no connection, newspaper "squibbs," hearsay depositions of employees, "trap" testimony of detectives, manufactured evidence proven to be false, letters asserting confusion where no attempt was made to produce the writers, etc. And these foreign advertisements and like irrelevant matter are so ingeniously interspersed with testimony regarding matters occurring in this country that they produced on the mind of the Circuit Court the erroneous impression that the transactions abroad and here "emanated from a common source." (See opinion, R. 1497.) Thus, for example, on R. 884 is found an invoice of the Howe Scale Company; on R. 885 various foreign advertisements; on R. 886 extracts from defendant's catalogue; on R. 887 to 909 more foreign advertisements; on R. 910 to 920 cor-

respondence of one of complainant's detectives with defendant's salesmen, etc., and so on through the record.

So, to, the misleading way in which counsel included in their brief before the Court of Appeals garbled extracts from the testimony and exhibits, impels us to ask that this court will consult the record wherever any apparently reprehensible act or expression for which defendant or its principal may be responsible, is brought into question.

Facts Pertinent to the Determination of Unfair Trade Competition.—As complainant can have no exclusive right to the name "Remington" as a valid trademark and as it has been shown that no fraud was practiced by the organizers of the Remington-Sholes Company in the adoption of its corporate name, it remains for the court to determine whether the record discloses any such unfair trade competition as will support the charges of the bill of complaint. In its determination of this question it is important that the following points be considered:

(A) The offices of complainant are established in every city and town of importance throughout the United States, and its agents have been instructed to report to its New York office matters that may have bearing upon the questions involved in this suit. (R. 526, 538, 638.)

(B) For more than six years the machines of the Remington-Sholes Company and its predecessor have been upon the market in open competition with complainant's machines, and during the greater part of this time complainant's agents have been gathering material for use in this cause. It is, therefore, highly probable that if any instance of deception or confusion has occurred complainant has been advised thereof.

(C) In the case of machines such as typewriters,

which are usually sent out on trial before purchase (R. 547) which are comparatively expensive and which are bought usually direct from the manufacturer, a far greater degree of care may reasonably be expected on the part of the purchaser than in the case of smaller articles, such as medicines, soaps, thread or the like, where the cost is small and the need of care in selection correspondingly slight.

(D) All of complainant's machines have been conspicuously marked with the name "REMINGTON," with the name "REMINGTON STANDARD TYPEWRITER," with the name and address "MANUFACTURED BY WYCKOFF, SEAMANS & BENEDICT, ILION, N. Y., U. S. A." and with the "RED SEAL" trade-mark, are finished in black enamel, and have been before the public with these marks for many years, while the machines of the Remington-Sholes Company have been distinctly marked with its trade-mark "REM-SHO" and with the words "REMINGTON-SHOLES COMPANY, MFRS., CHICAGO," and have been highly ornamental and finished in bronze, as distinguished from the conventional black of all other machines.

(E) Complainant's offices are provided with signs bearing its name, its "Red Seal" trade-mark, etc., etc., while the offices of the Remington-Sholes Company and of the dealers in its machines are furnished with conspicuous signs reading "REM-SHO TYPEWRITER, MANUFACTURED BY THE REMINGTON-SHOLES COMPANY, CHICAGO, ILLS.," with catalogues giving the name of the machine, the name and address of the Remington-Sholes Company, the notice that it has no connection with complainant's machine, etc., so that no one entering such offices could fail to observe these most distinctive points.

With an army of agents and salesmen scattered over the country, it would scarcely seem reasonable that complainant should have found it necessary to employ detectives to gather evidence to be used in this cause, and yet, as will be presently shown, it is upon testimony of such that it must mainly rely to sustain the charges of this bill.

When this court considers complainant's voluminous record it must be surprised not merely at the lack of evidence showing actual confusion in trade or the passing off of defendant's for complainant's machines, but will, we believe, view with astonishment and aversion the methods that have been resorted to to support the allegations of its bill,—methods that should wholly discredit the honesty of its case.

And yet, as we shall presently show, counsel for complainant urgently ask this court to credit the testimony of such witnesses as the detective employee Crean *alias* Francis *alias* Hood, who from Montreal to Baltimore vainly sought by deception and falsehood to entrap defendant's salesmen in his effort to manufacture evidence for use in this case; and the testimony of the witness Scheumaker, who at the instigation of Crean and under the pay of Wyckoff, Seamans & Benedict sought by a series of lying letters to worm himself into the employ of defendant that he might aid complainant's feeble case and whose attempt to induce defendant's agent to misrepresent defendant's machine was so promptly resented; and the shameless witness Scorer, whose efforts to prove that he had acted dishonestly while in defendant's employ were so completely refuted by the very persons he claimed to have deceived; and the witness Platt, who was admittedly a party to the most dastardly conspiracy to make testimony against defendant; or the witness John-

son, who produced and swore to a *typewritten copy* of a memorandum made as the result of his visits to various typewriter users, when the production of his original notes showed his statements false; to say nothing of the string of employee witnesses who gave the baldest kind of hearsay testimony while claiming that they might have produced the parties whose statements they pretended to repeat.

Not only must this court visit with its condemnation the production of such testimony, but must wonder that complainant's unscrupulous efforts have been so often foiled and that its unconscionable witnesses have not been more successful in their attempts to manufacture proof.

What Necessary to Establish Charge of Unfair Competition.—Before passing to a consideration of the testimony offered to support complainant's charge of unfair trade competition, the attention of the court is invited to the following points:

First, it is by a defendant's course of conduct and not by minor or sporadic acts that unfair trade competition must be proven. *Gorham Mfg. Co.* v. *Emery-Bird-Thayer Co.*, 104 Fed. Rep., 243, C. C. A.

The purpose of infringement proof in litigation like the present is to show to the court the way in which defendant is in the habit of conducting its business under ordinary conditions, that the court may determine whether such way is an honest or a fraudulent one. Obviously, the extraordinary machinations of a detective seeking by deception and falsehood to persuade a defendant's salesman into committing a wrong can not enlighten the court as to a defendant's usual course of business, because they

produce an abnormal condition that in actual trade could not possibly exist.

Brown Chemical Co. v. *Meyer*, 139 U. S., 540.
Centaur Co. v. *Marshall et al.*, 97 Fed. Rep. 785 (C. C. A.).
Lorillard v. *Peper*, 86 Fed. Rep., 956 (C. C. A.).
Sterling Remedy Co. v. *Eureka etc. Co.*, 80 Fed. Rep., 105 (C. C. A.).
Rogers v. *William Rogers Mfg. Co.*, 70 Fed. Rep., 1019 (C. C. A.).
Mueller Mfg. Co. v. *McDonally & Morrison Co.*, 132 Fed. Rep., 585.

Such matters as the selling by a defendant of its machine at a lower price than complainant's (*Lorillard Co.* v. *Peper, supra*) and the hiring of complainant's salesmen and the canvassing of the same territory (*Coats* v. *Merrick Thread Co.*, 149 U. S., see p. 566; *National Starch Co.* v. *Duryea, supra*) have all been recognized as fair competition with which a court will not interfere.

Second, the authorities are uniform in holding that it is the "passing off" by a defendant of his goods as and for those of complainant that must form the basis of an action of this character. As was said by the Supreme Court of the United States in the very recent case of *Elgin National Watch Co.* v. *Illinois Watch Case Co., supra*:

> "The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another."

In *American Washboard Co.* v. *Saginaw Mfg. Co.* (C. C. A.), 103 Fed. Rep., 281, the court, after reviewing the various authorities to the effect that complainant's right to relief is founded exclusively upon the fact that defendant's goods were offered for sale as and for the

goods of complainant, uses the following language with respect to a case in which such injury to the complainant was not proven:

> "It loses sight of the thoroughly established principle that a private right of action in such cases is not based upon fraud or imposition upon the public, but is maintained solely for the protection of the property rights of complainant."
>
> *Goodyear Co.* v. *Goodyear Rubber Co., supra.*
>
> *McLean* v. *Fleming*, 96 U. S., 245.
>
> *Wells* v. *Ceylon Perfume Co.*, 105 Fed. Rep., 621.

A consideration of the record here must not only satisfy the court that the whole course of conduct of the Remington-Sholes Company and of defendant is clearly irreconcilable with any purpose of passing off its machines for complainant's but must show also a most striking absence of even those questionable acts of minor character that are found in nearly every case of this kind, where a large business is transacted through many agencies and where the zeal of the salesman is apt to outrun his discretion.

Foreign Advertisements and Acts by Persons Over Whom Defendant and Its Principal Had No Control.—It is true that the machines referred to in these foreign advertisements were all made by the Remington-Sholes Company, **but it distinctly appears by stipulation in the record (R. 662) that the machines advertised in the various foreign publications were sold to an independent German company and were in turn sold by such company to the parties by whom the advertisements were made.** No attempt was made to prove that these advertisements came to the knowledge of defendant or of the Reming-

ton-Sholes Company either before or after their publication. Nor has the slightest attempt been made to establish any connection between defendant and such foreign advertisers, nor to show that the Remington-Sholes Company ever had any relations whatever with such parties other than as an outright vendor of its machines.

In the opinion of the Circuit Court it is said with respect to these foreign advertisements, "but the laws of those countries would not govern or vary the rights of parties here in respect to transactions emanating from here, although carried out there." This statement is plainly in disregard of the stipulations in the record with respect to these foreign publications. These publications have nothing whatever to do with "transactions emanating from here, although carried out there;" nor does the record show a single instance of any transaction "emanating from here, although carried out there." On the contrary, the sales of the Rem-Sho machines by defendant's principal to foreign merchants were in all cases *carried out here* by the delivery and receipt of payment for such machines in this country. Advertisements in foreign countries emanated from *there* and were carried out *there* independently of defendant or its principal and without their authority, knowledge or consent.

The statement repeatedly made by complainant's counsel in their former briefs, that these advertisements emanated from "agents *and dealers*" of defendant's principal, is incorect and misleading because the record shows that all advertisements authorized by defendant or its principal were fair and true, while such advertisements as were unfair were put out in foreign countries by independent dealers beyond their control. **Reiteration by counsel of the phrase "dealers and agents," however often**

repeated, cannot convert dealers into agents, nor make defendant or its principal liable for acts of strangers utterly beyond any agency control.

This suit is directed against the Howe Scale Company, which, as the bill of complaint asserts, was the sales agent for the *United States* of the Remington-Sholes Company. The bill charges infringement *solely within this country* (R. 8), and is silent as to any injury to complainant's foreign trade or as to any wrong doings in foreign countries. If the Remington-Sholes Company was deemed responsible for these foreign advertisements this suit should have been directed against that company. If, on the other hand (as the record plainly shows), these foreign acts and advertisements were by independent dealers, then the remedy should have been against such dealers and in the countries where the wrongs were committed. Complainant, by the bringing of this suit, has elected its forum, and having limited its complaint to a sales agent for this country alone and to wrong doings alleged to have occurred solely within this country, it is manifestly proper that the testimony should be restricted to the acts of such agent within the specified field of its operations.

The Remington-Sholes Company has undertaken to protect this defendant *against the charges of the bill.* It has not undertaken to shift the issues or to make defendants in this cause of innumerable independent dealers beyond the jurisdiction of this court. The law places no such obligation upon a principal who undertakes the defense of its agent. This court, in its examination of the record in this case, will find an entire absence upon defendant's part of any disposition to suppress or conceal any facts pertinent to the real issue of the bill (*i. e.*, the alleged infringement within the United States) and no

distinction has been made between the acts of the defendant and of the Remington-Sholes Company within their field of action. But the testimony as to the acts of independent dealers over whom it is not pretended that either defendant or its principal had any control, has been uniformly treated as without any fair place or purpose in this record. To have done otherwise than to completely ignore such testimony would have been to burden this record with an interminable mass of depositions and exhibits utterly without bearing upon the real questions at issue.

The Circuit Court, against defendant's objection, has declared this testimony admissible "as a part of the *res gestae* for the purpose of showing the effect upon the plaintiff's trade of putting these other machines (*i. e.*, defendant's) in the market with the name in question upon them" (R. 1497) and has said that "as this is a suit for interference in trade, the boundaries of the dealing and not of governments or countries is material; . . . that the laws of those countries would not govern or vary the rights of parties here in respect to transactions *emanating from here although carried out there.*" The court was plainly in error in assuming that these foreign acts and advertisements of *strangers to this litigation* did in fact show "the effect upon plaintiff's trade of putting these other machines into the market." They show simply that in the war of advertising among foreign dealers in rival machines the bounds of fair dealing have been passed by persons beyond the control of defendant or its principal or of this court; but they give no intimation as to the effect upon the trade abroad of marking machines with the words "REMINGTON-SHOLES COMPANY, Mfrs., CHICAGO," and with the trade-mark "REM-SHO."

The contention of complainant's counsel in the Court of Appeals was that these foreign advertisements were "illuminating and instructive for the court" and that such testimony shows how the "ultimate purchaser is deceived." We quite agree with counsel that the deception of the ultimate purchaser is a rightful test of infringement. But in every case it must be proven that such deception is effected by the *false representations of the defendant* and not of independent dealers over whom the defendant has no control. Even had it been proven (which is not the case) that the foreign advertisements or misrepresentations of foreign dealers had worked an injury to complainant's trade, *such proof would have merely shown the result of such advertisements and misrepresentations* and would have shed no light whatever on the effect of *marking the machines*, for which alone defendant's principal is responsible. The contention of counsel for complainant that defendant is, as it were, *particeps criminis* with these independent foreign dealers in any injury they may have done complainant's trade (although no such injury is asserted) is without force. It might with equal reason be said that the manufacturer of a shot gun was party to a murder committed with such gun by one to whom the gun had been sold in ordinary course of trade.

These foreign advertisers were supplied by the independent German company handling the Rem-Sho machine (see stipulation R. 662) and the highest court of Germany had declared that the name "Remington-Sholes" could be rightfully used. If therefore the German company had a lawful right to use such name upon machines manufactured by the Remington-Sholes Company it could not be said that in thus acting within its

lawful rights it was unlawfully placing in the hands of others an instrument by which the ultimate purchaser might be deceived. If defendant or the Remington-Sholes Company has the right to mark machines with the words "REMINGTON-SHOLES COMPANY, Mfrs., CHICAGO" and with the trade-mark "REM-SHO"—and this is the only real question involved in this case—they cannot be held reprehensible for exercising that right nor for any abuse of the right that may be effected by others. The remedy for such abuse must be had by action against the wrong-doer in a court having jurisdiction over him, for a court of equity of this country will not destroy a right existing here as a means of correcting an abuse of such right by strangers abroad.

The authorities are uniform and conclusive in holding that a manufacturer is not responsible for the acts or wrong doings of mere dealers, and for the obvious reason that between a manufacturer and a mere dealer in his products, no such agency relation necessarily exists as would render the manufacturer liable for the acts of the dealer. Thus, in the leading case of *Coats* v. *Merrick Thread Co.*, 149 U. S., 562 (573), the Supreme Court used the following pertinent language:

> "If the purchaser of such thread desires a particular make he should either call for such, in which case the DEALER if he put off on him a different make, would be guilty of fraud *for which the defendants would not be responsible.*"

See also *Brown Chemical Co.* v. *Meyer*, 139 U. S., 540; *Proctor & Gamble Co.* v. *Globe Refining Co.*, 92 Fed. Rep., 357 (362); *Sterling Remedy Co.* v. *Eureka, Etc., Co.*, 80 Fed. Rep., 105 (108); *Illinois Watch Case Co.* v. *Elgin Co.*, 94 Fed. Rep., 667, 671 (C. C. A.); *National Starch Co.* v. *Duryea et al.*, 101 Fed. Rep., 117.

Plainly, therefore, the Circuit Court and the Court of Appeals were in error in refusing to reject the mass of testimony as to foreign advertisements introduced on behalf of complainant.

We submit also that it was error upon the part of the lower court to consider the secondary evidence introduced by complainant in violation of the plainest rules of evidence. Thus, for example, in their argument below counsel laid great stress upon the "Davis & Rose Letter" (R. 1000); that is a letter purporting to have been written to complainant's Richmond office by Davis & Rose and asking for a catalogue of the "Rem-Sho," adding: "If you do not make this machine turn this over to the proper branch;" and a copy of one of the "Rem-Sho" booklets alleged to have been received at complainant's office and bearing the endorsement "Is this same as your writer?" (R. 999) was emphasized as indicating confusion in trade and was admitted by the lower court as competent evidence. No attempt was made to produce the writers of this letter or this endorsement or to account for their absence or to excuse the introduction of the exhibits on rebuttal.

The incompetency of such testimony is too manifest for argument. We would, however, direct the attention of the court to the readiness with which testimony of this kind may be manufactured *ad libitum*, and when the court considers the testimony of complainant's numerous detectives and their machinations to entrap defendant's salesmen, the marvel must be that there are not many more exhibits of this kind. With its salesmen in every city in the land, in constant contact with the typewriter user in soliciting the sale of supplies and machines, and instructed to report matters bearing upon this litigation

(R. 526, 536, 638), with its close alliance with the four largest typewriter companies in the so-called typewriter trust (R. 197), and with its agents collecting or making evidence for use in this cause for nearly six years, certainly this court will not view with favor secondary evidence as a means of proving complainant's charge that defendant's machines are being foisted on the public for complainant's. Defendant is clearly entitled to be confronted by these witnesses, to cross-examine them and to thus ascertain not only whether they did in fact write these letters, but also whether they were written at complainant's instigation and for the purposes of this case, or whether there was in fact confusion existing in the minds of the writers with respect to defendant's machine.

The Inquiry, What Connection Between Remington-Sholes Company and Complainant.

When the Remington-Sholes Company and its predecessor entered the field, complainant had a world-wide reputation. It was but natural, therefore, that salesmen of the Remington-Sholes Company and its predecessor should be often asked "what connection existed" between such companies and complainant. However strenuously it may be argued that the asking of such questions indicates confusion in the public mind, we submit that it warrants no such inference. On the contrary, the very fact of the inquiry indicates a recognition in the mind of the inquirer of the existence of complainant as distinct from the company concerning which such question is asked.

The pertinent fact is not whether the public wondered as to the existence of any *connection* between complainant and the Remington-Sholes Company, but whether it

regarded these companies as *identical*. The situation of a company having the wide reputation of complainant is like that of a public character, yet the circumstance that a common citizen bearing a like name may be asked if he is connected with such public character would scarcely support the conclusion that the inquirer confounded the *identity* of the two. As was said in *Rogers Co.* v. *Simpson*, 54 Conn., 568:

> " The question is not whether the defendant's business is represented as being similar to the plaintiff's, BUT WHETHER IT IS REPRESENTED AS BEING THAT VERY IDENTICAL BUSINESS."

With corporations, as with individuals, inquiries of this kind are the result of a natural curiosity. Thus, in the deposition of Mr. F. L. Sholes (R. 1202 and 1203), we find that while in charge of the Philadelphia office of the Remington-Sholes Company the question was often asked him what connection, if any, such company had with the Remington Machine Company, of Wilmington, Delaware, or with Remington & Sherman Company, of Philadelphia. The testimony shows that these inquiries, which were frequent in the early history of the Rem-Sho machine, gradually became less frequent as such machine came to be better known in the market. (R. 1200-1080-1099-1334.) That inquiries of this kind are without significance was distinctly recognized by the Illinois Appellate Court in the Hazelton Boiler case, *supra*, where the following language occurs:

> " The real question in this case, is, therefore, have the defendants been guilty of fraudulent competition in business, or have they made such use of the plaintiff's name as to deceive, mislead or confuse the mass of purchasers? Some slight confusion has arisen;

INQUIRIES IN QUITE A NUMBER OF INSTANCES HAVE BEEN MADE AS TO WHETHER THE BOILERS MADE BY THE TWO CORPORATIONS ARE THE SAME, AND AS TO WHETHER ONE HOUSE IS A BRANCH OF THE OTHER, but in only one instance does any purchaser appear to have been misled, and that is not one of which the plaintiff can complain."

Goodyear Co. v. *Goodyear Mfg. Co., supra.*

Richardson & Boynton Co. v. *Richardson & Morgan Co.*, 8 N. Y., 52.

"The Only Machine Now Made by a Remington."

In their argument before the lower court great stress was laid by counsel for complainant upon the fact that upon the inside of the cover of one edition of the Rem-Sho No. 2 catalogue—the issue of which was discontinued several years ago (R. 1008)—and in one or two advertisements the statement appears, "The only machine now made by a Remington," and upon the fact that some of defendant's salesmen admit the use of such expression when explaining to prospective purchasers and others the history of the Rem-Sho machine, and when refuting the allegation of complainant's salesman that such machine was a "counterfeit." (R. 1102.)

Complainant's counsel, in their brief before the Court of Appeals, quoted *incomplete* extracts from statements in which the expression in question was used, such incomplete extracts being manifestly misleading. Thus, it was said (old brief, p. 179) that in the Phonetic Journal "will be found the statement concerning the Remington-Sholes typewriter, that *'it is the only typewriter manufactured by a member of the well-known Remington family, the original manufacturers of the Remington Standard Type-*

writer'," whereas, the *complete sentence* contained the words *"but it is not to be confused in any way with the latter machine."* (R. 887.)

Except for the reason that complainant apparently regards itself as vested with the exclusive right to mention the name Remington in any manner in connection with typewriting machines, it might be difficult to see upon what ground it can be heard to object to the expression "The only machine now made by a Remington," whether the same be true or false. It is not pretended that complainant's machines are made by a Remington. On the contrary, they are distinctly marked "Manufactured by Wyckoff, Seamans & Benedict, Ilion, N. Y., U. S. A." Nor has it been anywhere asserted that any Remington is or ever was in any way associated with complainant. Literally, perhaps, this statement that the "Rem-Sho" was the only machine now made by a Remington was not true, because the Rem-Sho machine was not manufactured by a Remington solely, but by a company of which a Remington was the general manager; but as such expression would be understood by the general public it was true, for there is not one word in the record of this case to show that any Remington is or ever was connected with any concern now making typewriting machines, except the Remington-Sholes Company.

Used, as this expression always has been (when used at all), in connection with the name and address of the Remington-Sholes Company as manufacturers, the public would obviously understand it to mean what it was intended to mean and nothing more, viz., that the "Rem-Sho" was being manufactured by the Remington-Sholes Company, under the direction of Mr. Remington, and that it was the only typewriting machine at such time be-

ing made under the direction of a Remington. It is to be noticed, moreover, that this expression, as used by Rem-Sho salesmen, was not an isolated statement, but was part of the general history of the origin of the machine, as outlined in the Rem-Sho catalogue (R. 1047) and was given after complainant had challenged the right of the Remington-Sholes Company to use its name and had pronounced its machine a counterfeit. (R. 1101.) The fact is clearly shown that whenever and wherever this expression, "The only machine now made by a Remington," has been used, it has been in such connection that no possible confusion in the public mind could be created thereby. This statement being true, therefore, in substance and in fact, falls within the cardinal principle of trade-mark law that equity will not enjoin a defendant against speaking the truth. (*Elgin National Watch Co.* v. *Illinois Watch Case Co., supra.*)

The statement of complainant's counsel in their former briefs (*e. g.*, C. C. A. brief 173) that defendant's machines were not in fact made under the superintendence of Mr. Franklin Remington is plainly disproved by the testimony of their own witness, Mr. Sholes (R. 434; 429), and of defendant's witness, Mr. Hochklassen (R. 1105).

In the leading case of *Canal Co.* v. *Clark*, 13 Wall., 311, which the Supreme Court in a later case said embodied "the philosophy of law applicable to trade-marks (*Lawrence Co.* v. *Tennessee Co.*, 138 U. S., 537), the following language was used by Justice Strong:

> "Purchasers may be mistaken, but they are not deceived by false representations, and EQUITY WILL NOT ENJOIN AGAINST TELLING THE TRUTH."
>
> *Amoskeag Manfg. Co.* v. *Spear*, 2 Sandf. (N. Y.), 599.

William Rogers Manufacturing Co. v. *Rogers*, 84 Fed. Rep., 639 (affirmed on appeal, 95 Fed. Rep., 107).

In *Monarch* v. *Rosenfeld et al.*, 39 Southwestern Rep., 236, the Kentucky Court of Appeals had before it a case in which the defendant, a corporation, of which S. I. Monarch was president, manufactured whisky, the barrels of which were labeled with the words "S. I. MONARCH, HAND MADE SOUR MASH." It was contended by the complainant that this was an improper use of Monarch's name, but the court in this connection said:

> "So in my opinion if there is no other reason why S. I. Monarch should not use his name in the business, he has, in view of his conection with this company, and under the opinion and judgment of the Court of Appeals, and the judgment of this court pursuant to that judgment, the right to use his name in this Co., *and to brand his name* on their whiskey barrels; and this Co. has the right, under such authority, as long as S. I. Monarch's present connection with said company exists." (Pp. 338, 339.)

In the case of *Holmes, Booth & Hayden* v. *Holmes, Booth & Atwood Co.*, 97 Conn., 278 (a case that turned upon defendant's estoppel), it was said:

> "Respondents may in any legitimate way indicate to the trade that their business had the benefit of the experience, skill and reputation of these gentlemen (Holmes and Booth.)"

In *National Starch Manfg. Co.* v. *Duryea et al.*, 101 Fed. Rep., 117, the following statement occurs:

> "The statement that the starch is prepared by Duryea & Co., whereas it is manufactured by the Sioux City Starch Company, in the most significant indication of an attempt to deceive; but the evidence in this case, from letters which passed after the date of the contract with that company between the par-

> ties to it, contains stronger and more convincing proof than was presented on the motion for preliminary injunction that the starch was actually being perfected by the improvements suggested or directed by the defendants, and that the manufacture was actually under their supervision." (Pp. 118, 119.)

In *Leather Cloth Co.* v. *American Leather Cloth Co.* (Cox Am. T. M. Cases, 688), 11 Jur. N. S., 513, it was urged before the House of Lords that defendants were guilty of misrepresentation in printing upon their labels the statement, "Manufactured by their manager, late with J. R. & C. P. Crockett & Co." In disposing of this point, Lord Kingsdown said:

> "If this statement be true the defendants are justified in making it; but if it be untrue, however reprehensible the statement may be, it does not constitute a colorable imitation of the plaintiff's trade-mark or amount to an infringement of their rights."

Jennings v. *Johnson*, 37 Fed. Rep., 364 (365).

Tarrant & Co. v. *Hoff*, 76 Fed. Rep., 959 (961) (C. C. A.).

In *Goodyear Co.* v. *Goodyear Rubber Co.*, *supra*, and in later cases, this court has said in speaking of suits to restrain unfair trade:

> "Relief in such cases is granted only where defendant by his marks, signs, labels, or in other ways represents to the public that the goods sold by him are *those manufactured by the plaintiff.*"

Even admitting, for the argument, that the public being blind to all other reading matter so conspicuously and invariably put forth by the defendant,—its name, its address, etc., etc.—saw only the phrase "the only machine now made by a Remington" and derived therefrom the impression that defendant's machines were being made by a Remington, or even by "the Remingtons" or "the

Remington people," this would offer no ground of complaint, for it would not be passing off defendant's goods for "*those manufactured by plaintiff*," since complainant has no Remington with it, is not "the Remingtons" nor "the Remington people."

Complainant's Deception of the Public.—It is with a self-righteousness, truly refreshing, that the sporadic statement that the Rem-Sho "is the only machine now made by a Remington" is challenged by complainant as a fraud, while by asserting a right to the use of the names "the Remington Company," the "Remington people" and "the Remingtons," and by encouraging the public to believe that its machines are in fact made by Remingtons, it is itself creating a false impression on the public mind. Can complainant be heard to say that its machine is "now made by a Remington"? Or is it fair that it should encourage the public to believe that it is in fact the "Remington Company" or the "Remingtons"? If not, then how can the statement, "the only machine now made by a Remington," when used in connection with the "Rem-Sho," be claimed as indicating an intent upon the part of the Remington-Sholes Company to pass off its machine as complainant's?

In *Manhattan Medicine Co.* v. *Wood*, 108 U. S., 218, this court has condemned in no uncertain way, the conduct of a plaintiff who holds out his wares as made by another, although such other be his predecessor. The impression fostered by complainant that its machines are the product of the "Remingtons" or "the Remington Company" or "the Remington people" is as false in fact as its contention that the assignment from E. Remington & Sons (whereby they agreed to remain out of the business ten years) precluded that corporation from forever re-

suming all use of the name "Remington" in connection with the manufacture of typewriters is false in law. Manifestly, complainant cannot decry against the use by any Remington or by any corporation bearing that name, of such individual or corporate name in fair and honest fashion. Not only would it be entirely proper for E. Remington & Sons (if that concern were still in existence) to manufacture typewriting machines and mark them with its name, but the same is true of the Remington Arms Co., or, indeed, of any of the other existing corporations bearing the Remington name.

If defendant or the Remington-Sholes Company has been guilty of wrong-doing by permitting the expression "The only machine now made by a Remington" to be used, regardless of the fact that such use has been in manner incapable of producing deception, or, indeed, has been guilty of any other sporadic act that might injure complainant (although none such has been proven), still under the authorities this would afford no warrant for enjoining the use of the corporate name of the Remington-Sholes Company or the use of the fanciful name "Rem-Sho" upon its machines. In such case the remedy must be directed merely to the specific wongful act.

Singer Mfg. Co. v. *June Mfg. Co., supra.*
Singer Mfg. Co. v. *Bent,* 163 U. S., 205.
Burgess v. *Burgess,* 3 DeG. M. & G., 896.
Samuel v. *Berger,* 24 Barb., 163.
Manufacturing Co. v. *Spear,* 2nd Sandf., 607.

In this last cited case Duer, J., said:

> "At present it is sufficient to say that in all cases where a trade-mark is imitated the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and it is only where this false representation is directly or indi-

> rectly made, *and only to the extent to which it is made* that the party who appeals to the justice of a court can have a title to relief."

Remington Moscow Affidavit.—Before the Court of Appeals complainant's counsel dwelt with much emphasis and little fairness upon an affidavit made by Franklin Remington when at Moscow, Russia, in December, 1899, more than a year after the bringing of this suit. The affidavit (subject to defendant's objection) was admitted by stipulation (R. 660-661) and appears in full at R. 983. In their former briefs counsel have quoted *portions* of this affidavit. By reference to its full text this court will see that it was given because of the "false reports" that were being spread by unfair competitors and that it contains the following statement that is conclusive against danger of mistake:

> "(4) That my machines, manufactured in Chicago are known here by the name 'Remington-Sholes,' and should not be confounded with any other machines bearing the name 'Remington.'"

And the affidavit is signed by Franklin Remington as "general manager of the Remington-Sholes Company."

The copy of the affidavit in the record states in its first paragraph that "I am the son of the original inventor and manufacturer of the Remington typewriter," but the stipulation (R. 660-661) shows that the words "inventor and" did not appear in the original affidavit. The attempt of counsel to connect Mr. Remington with certain objectionable advertisements put out by one Hagen, because of the statement in the affidavit that Hagen was "the only agent for the sale of the Remington-Sholes in Russia" is utterly without force in view of the stipulation (R. 660-661), that Hagen's exclusive

agency was *from the independent German Co.*, from which he bought all his machines.

Alleged Actual Deception of Customers.

Bearing in mind the fact that the business of complainant and of the Remington-Sholes Company has for a long time been conducted by agents and dealers throughout the principal cities and towns of the United States; that the agents of complainant have been instructed to report to their home office instances of confusion in the trade or the like; that testimony on behalf of complainant for this purpose has been taken at many points; and that complainant alleges that the Remington-Sholes Company was organized for the fraudulent purpose of selling its machines as and for the machines of complainant, the court might naturally look for at least a considerable number of instances in which customers had been deceived into buying the machines of the Remington-Sholes Company for those of complainant. ON THE CONTRARY, IN THE MULTITUDE OF WITNESSES ON BEHALF OF COMPLAINANT, THREE ONLY ARE PRODUCED TO PROVE THAT DECEPTION HAS IN FACT OCCURRED, VIZ., THE WITNESSES WEINGART, DOWNS AND STALLWOOD.

A CONSIDERATION OF THE TESTIMONY OF THESE WITNESSES MUST CONCLUSIVELY SHOW THAT, WHILE THEY MAY HAVE BEEN MISTAKEN, THEY WERE NEVER DECEIVED NOR WAS THE SLIGHTEST ATTEMPT EVER MADE TO DECEIVE THEM.

The Weingart Sale.—The purchase by Weingart of a Rem-Sho machine, while under the impression, as he asserts, that it was a Remington typewriter, will doubtless be relied upon by complainant's counsel as the best instance of the deception of a purchaser. An examination of the evidence will conclusively show, however, not only that there was no attempt to deceive Weingart, but that it was made plain to him before his purchase of the machine that it was in no way connected with the Remington Standard and differed therefrom both as to origin and structure.

The most impressive feature of the deposition of this witness is his utter unfairness and unreliability. On his first examination he testified (R. 511) that in the store of Page, Dennis & Company his eye was caught by a sign which he states read "Remington Typewriter Co.;" that thereupon he inquired if they sold the Remington typewriter and was informed that they did; that he purchased a Rem-Sho under the belief that it was a Remington and ordered it sent to Highmount, Ulster County, New York, after being advised that the discount to school teachers would be thirty-five per cent.; that there were no typewriting machines in the store of Page, Dennis & Company at that time, and that he did not examine any; that he looked for the name and address on the machine, but could not find either (R. 513); that he is positive the name "Sholes" was not mentioned, and that "this (*i. e.*, the day of his testimony) is the first time I heard the word Sholes;" that he did not remember ever having seen or heard the name Sholes prior to such day (R. 514); that even if he had been told that the Rem-Sho was made by the Remington-Sholes Company, of Chicago, Illinois, or that it was not made by Wyckoff, Seamans & Benedict,

it would have made no difference in his impression that it was the Remington machine.

On cross-examination, however, Weingart's drilling as a witness fails him. He admits (R. 513) that he does not know what appeared upon the sign in the office of Page, Dennis, & Company; that "there may have been the word Sholes on the sign" (R. 516); that he does not know whether or not the words "Remington-Sholes Co., Chicago, Ills." appeared upon the machine, since, he admits (thus contradicting his former statement), "I never looked" (R. 514); that he is not sure whether or not the names "Remington-Sholes" or "Rem-Sho" were mentioned at the time of his purchase of the machine; and, on re-direct examination, when asked "what reply, if any, did they (at Page, Dennis & Company's) make to your inquiry if they had the Remington typewriter," he finally admits, "*I don't know*, I SUPPOSE they said yes or I would not have bought it."

Against these uncertain and manifestly unreliable statements of Weingart stands the clean-cut testimony of Parker, who was formerly an employee in the office of Page, Dennis & Company, and who sold the machine to Weingart, the testimony of the salesman Hatch, who visited Weingart at his school before the sale, and an array of uncontrovertible circumstances that must conclusively prove not only that Weingart was not deceived, but that he was fully advised in regard to the Rem-Sho machine, its makers and its differences from the Remington Standard. Parker testifies (R. 1279) that he remembers Weingart's call at Page, Dennis & Company's store; that he showed and explained to him both the Rem-Sho No. 2 and No. 3 (R. 1279); that Weingart's is the only instance in which he quoted school teachers' discounts or sold a ma-

chine to a school teacher; that he made out a sales slip (R. 1460), in which a commission on the sale was credited to Hatch; that Weingart talked to no other typewriter salesmen besides himself; that in answer to Weingart's inquiry whether they had a Remington machine, he replied: "No, but we have a better machine, one which combines the best qualities of a Remington with those of a Smith-Premier, and I went to work to explain to him the difference between this machine and the Remington." In his cross-examination Parker reiterates in detail the circumstances of Weingart's call and why he so distinctly remembers it. (R. 1295, 1296, 1300.)

In this connection Hatch testifies (R. 1054) that prior to the sale of the Rem-Sho machine to Weingart he called at the latter's school, left his card (like "Defendant's Exhibit Page, Dennis & Co. Card," R. 1450) and talked to Weingart in regard to the machine. This witness also distinctly recalls that Parker inquired of him as to the discounts to be made to school teachers.

When called as a witness in rebuttal, Weingart states (R. 641) that he does not remember Hatch's call, although he says that "a great many agents hand in their cards to me and I never look at them." On cross-examination he admits, however (R. 646), that he thinks he saw a card like "Defendant's Exhibit Page, Dennis & Co. Card," but whether before or after his purchase of the Rem-Sho machine he cannot say. When complainant's counsel read to him the substance of Parker's deposition, he denies its correctness, but adds: "I do not remember any such conversation. On cross-examination Weingart at first denies positively that he had ever seen the name "Sholes" prior to his purchase of the Rem-Sho machine, but when shown "Defendant's Exhibit Sign from Office

of Page, Dennis & Co." (R. 1447) he admits with marked reluctance, "I certainly have seen a sign— I don't know whether it was this or one similar; I certainly saw a sign." (R. 643.) He further admits that he does not recall whether the name "Rem-Sho" or the name "Sholes" was on the sign (R. 644), but he remembers that the sign was a large one and was on the wall over that part of the store in which Rem-Sho typewriters were sold. He does not remember the name Rem-Sho at all (R. 645), although the invoice, "Defendant's Exhibit Weingart Invoice" (R. 1459), furnished him at the time of the sale, distinctly defines the machine as "1 Rem-Sho," etc. He admits also that Parker may have said that the Rem-Sho was better than the Smith-Premier, and admits that he can not say positively that there was no typewriting machines on exhibition in the store, although in his former examination he denied this.

The testimony is uncontroverted that at the time of Weingart's purchase of the Rem-Sho machine "Defendant's Exhibit Rem-Sho Sign from the Office of Page, Dennis & Co." was upon the wall over the typewriter department of the store (R. 1249) and in the exact location of the sngn that Weingart claims to have seen. This sign, the dimensions of which are about 10x4 feet, reads (R. 1447) **"Rem-Sho Typewriters, Manufactured by the Remington-Sholes Company, Chicago, Ills."** It appears also that on the front show windows of the store of Page, Dennis & Co. there was painted the sign "Remington-Sholes Typewriters" (R. 1256); that there were displayed in these windows large cardboard signs like "Defendant's Exhibit Rem-Sho Pasteboard Sign" (R. 1249); that at the time of Weingart's visit there were also Rem-Sho machines on exhibition (R. 1249), Rem-Sho cata-

logues (R. 1250) to be given out to all inquiring callers, and blotters like "Defendant's Exhibit Rem-Sho Blotter No. 1" (R. 1250) were there for distribution.

The uncertain assertion of Weingart that he was deceived must fall before the statements of the witnesses Parker and Hatch, corroborating as they do these undisputed facts.

Weingart may have been mistaken, but, under the circumstances, it cannot possibly be said that he was deceived. It may be urged, however, that, even if he was not deceived, still his purchase of the Rem-Sho machine upon the supposition that it was complainant's indicates a tendency towards confusion in trade. The conclusive answer to such contention is, *first*, that if the Remington-Sholes Company rightfully used upon its signs the words "Manufactured by the Remington-Sholes Company, Chicago, Ills.," no ground of complaint exists; and, *second*, that if Weingart ignored the information afforded him by the various signs, the business card, the name on the invoice, the name on the machine, not to mention the specific but disputed information as to the differences between the Rem-Sho and the Remington, which Parker says he pointed out to him, he was not using in any degree that ordinary or reasonable caution which the courts invariably require every purchaser to use.

The large sign that attracted Weingart's attention did not offer the Remington typewriter, but, on the contrary, distinctly advertised the "REM-SHO," a name not only totally unlike Remington both in sound and construction, but one that of necessity must be devoid even of suggestion to anyone who, like Weingart, had never before heard or seen the name Sholes. Nor did this large sign mention complainant's name or address, nor anything sug-

gestive of these, but, on the contrary, it distinctly stated that the machines were made by the "REMINGTON-SHOLES COMPANY, CHICAGO, ILLS."

Weingart states that so long as the name "Remington" appeared upon the sign all the rest was to him without significance; that even had the words "Not made by Wyckoff, Seamans & Benedict" appeared it would have made no difference in his impression. (R. 515.) Such carelessness or stupidity the law does not undertake to protect. The effect would have been the same had the name of the firm "Remington & Sherman Company," or "Remington Arms Co.," or of any other existing firm containing the name Remington as part thereof been displayed. The contention, therefore, that force be given to Weingart's mistake must be predicated upon the broad ground that complainant has the exclusive right to the use of the proper name "Remington" not only as a trade-mark upon its machines, but in any combination of corporate or firm name in which it may be used however truthfully with the ordinary *personal* meaning by persons engaged in the typewriter business. As we have already shown, the law recognizes no such exclusive right with respect to personal names.

The Downs Sale.—It needs but a glance at the short deposition of this witness to show that he was neither deceived nor misled. His company had been users for many years of the Remington machine (R. 247), which they had been in the habit of buying from Joseph E. Platt while Platt was the New Haven agent of Wyckoff, Seamans & Benedict. Down states that he simply applied to Platt "for A MACHINE"—not a Remington machine—"on the supposition that he was the agent of the Remington Typewriter Co." He says that he did not

get the impression that he had received a Remington machine from any statement made by Platt. His short cross-examination tells the whole story as follows (R. 248):

"8 X-Q. Were the machines which you say your company used for several years—about thirteen years—similar to the machine now on the table before you?

"A. Yes, sir.

"9 X-Q. And were marked with the words Remington Standard Typewriter, Manufactured by Wyckoff, Seamans & Benedict, Ilion, New York, U. S. A.?

"A. Yes, sir.

"10 X-Q. Did you examine the Remington-Sholes machine that was left with you by Mr. Platt?

"A. No, sir.

"11 X-Q. You do not recall, then, how that machine looked or how it was marked, do you?

"A. It is my impression that the name Rem-Sho appeared upon the machine, but I would not state that as a fact.

"12 X-Q. Do you remember whether the name Remington-Sholes Typewriter Company appeared upon the machine or not?

"A. I do not. The information was given me by the representative of Mr. Platt that the machine was a Rem-Sho.

"13 X-Q. You knew that Mr. Platt had been the agent for the Remington Company prior to the time that he sent the Rem-Sho machine to you, did you not?

"A. Yes, sir.

"14 X-Q. And that was why you applied to him for a machine?

"A. Yes, sir.

"15 X-Q. And that was why you supposed that you were going to get a Remington machine, was it not?

"A. Yes, sir."

Certainly there is nothing in this incident for which the

Remington-Sholes Company can be blamed. The record shows that it is a common practice for typewriter agents or dealers to pass from the employment of one company to that of another. Had Downs ordered a Remington machine, or indicated in any manner that he supposed that he was going to get a Remington machine, doubtless Platt would have corrected the false impression.

The Stallwood Rental.—The testimony of Stallwood shows that he was not deceived, and it will not be pretended that any attempt was made to deceive him. He went to the Chicago salesroom of the Remington-Sholes Company, where he says he saw a number of typewriting machines exhibited (R. 483); that he got the address from the Chicago Telephone Directory; that he rented a machine and continued to pay the rental monthly for several months.

J. F. Hobbs was at the time in charge of the Chicago sales office of the Remington-Sholes Company, and his testimony shows that there were a number of signs conspicuously displayed upon the doors, the windows and the walls of the office announcing the fact that the machine sold there was the "REM-SHO" and that it was manufactured by the Remington-Sholes Company of Chicago. The various receipts upon the bill-heads of the Remington-Sholes Company introduced in evidence, and which Stallwood admitted he saw, and the fact that the machine delivered to Stallwood bore the usual name-plate, must conclusively show that no care or precaution whatever was exercised by Stallwood if at the time he rented the Rem-Sho machine he in fact intended to rent a Remington. Stallwood says (R. 485) that he obtained the address of the Remington-Sholes Company from the Chi-

cago Telephone Directory, where it and complainant's name and address appeared in the following order:

> "No. North 572. Remington-Sholes Typewriter Factory, 127 Rees.
>
> "Main 3036. Remington-Sholes Co.; City Salesroom, 204, 126 State.
>
> "No. Main 137. Remington Standard Typewriter, Wyckoff, Seamans & Benedict, 144 Madison."

But although the witness must necessarily have read through both of the addresses of the Remington-Sholes Company in order to ascertain its city salesroom, he says: "I will state that I did not look any further after I saw the name Remington." This witness, like the witness Weingart, knew only the name Remington. It would have made no difference to him what other name or what addresses were associated with this name. It follows, therefore, that unless complainant is entitled to the exclusive use of the name Remington, regardless of its association with other names and regardless of its rightful use by other individuals bearing the same name, it cannot be contended that the mistake of the witness Stallwood was such as can be relieved by a court of equity.

In other words, to sustain the complainant's contention and the decree of the lower court, this court must, like the witnesses Weingart and Stallwood, "look no further" than the name Remington, but must give to complainant a monopoly of that name even when used in such way as to convey, as it did to these witnesses, a purely personal meaning.

The Law Assumes that Purchasers Will Use Ordinary Care.—The law applicable to mistakes such as were made by Weingart, Downs and Stallwood is plain from a reading of the authorities. Courts natu-

rally look with indulgence upon a degree of carelessness on the part of purchasers who, in distinguishing a merchant's goods, rely upon some purely fanciful or newly-coined name like "Sapolio" or "Celluloid," or who rely upon some arbitrary or fanciful mark or some peculiar or characteristic "dress" of package, because in each of such cases the public is justified in assuming that the first to adopt such arbitrary or fanciful distinction for his wares is entitled to its exclusive use. In the case of personal names, of geographical names, of descriptive terms or the like, a different rule prevails. The law presumes the public to know that no one can have an exclusive right to appropriate to his wares the use of any such names, and expects the public to avoid relying *solely* upon such names as a means of distinguishing the goods of a manufacturer.

In *Rogers* v. *Simpson et al.*, 9 At. Rep., 395 (54 Conn., 568), the rule is laid down as follows by the Supreme Court of Connecticut:

> ". . . If the first appropriator of his name as a mark adopts the name simply, without any accompanying word or symbol by way of prefix or suffix, another manufacturer of similar goods having the same name, may lawfully impress it upon his goods, if, as in the case at bar, he accompanies it with such designating devices by way of prefix and suffix, as that a consumer who will take note of the whole will not be misled. **And if consumers, who take notice of nothing but the name are misled, and there is consequent loss of trade, it must be borne as the result of the act of taking a name as a trade mark."**

Again, in *Harson* v. *Halkyard et al.* (Sup. Ct. Rhode Island, May, 1900), 46 At. Rep., 271, it was said:

> " No person can acquire a right to use his surname

as a trade-mark or trade name to the exclusion of others bearing the same surname. Unless, therefore, signs, labels and other advertisements of the respondent's are such independently of the name 'Harson' as to deceive the public into the belief that they are buying the goods of complainant when they are buying the goods of respondents, the complainant has no ground of complaint."

In *Centaur Co.* v. *Marshall et al.* (C. C. A., 8th Circuit, October, 1899), 97 Fed. Rep., 785, the rule is thus stated:

"The law imposes no duty upon the appellees to see to it that the careless and indifferent know that the Castoria that they buy is made by the appellant and not by another. They discharge their full duty to the appellant if they so dress their product that one who seeks to ascertain whose manufacture it is can readily learn by a reasonable examination of their wrappers whether it is made by the appellant or by themselves. *Coats* v. *Thread Co.*, 149 U. S., 564, 567, 572, 573. . . . The wrapper of the appellees gives fair warning that the product which it contains is not made by the appellant and that it is not manufactured in New York. It carries on its face the statement 'Prepared by Castoria Medicine Co., Kansas City, U. S. A.,' and the words and letters 'Castoria Medicine Co., Kansas City, U. S. A.' are printed in large black letters which will readily catch the eyes and fasten the attention of any buyer who examines the product to learn its manufacturer."

In *Coats* v. *Merrick Thread Co.*, 149 U. S., 562, the Supreme Court said:

"He (the purchaser) is chargeable with knowledge of the fact that any manufacturer of 6-cord thread has a right to use a black and gold label and he is bound to examine such label with sufficient care to ascertain the name of the manufacturer."

Scott Co. v. *Scott Co.*, 15 N. Y. S., p. 325.

Faber v. *Faber*, 49 Barb., 357.

The cases are conclusive upon the point that mistakes due to carelessness on the part of purchasers offer no ground for enjoining a defendant whose goods are bought for complainant's. Thus, in *McLean* v. *Fleming*, 96 U. S., 245, Clifford, J., said:

> "A court of equity will not interfere when ordinary attention by the purchaser of an article would enable him at once to discriminate the one from the other."

Liggett, etc., Tobacco Co. v. *Finzer*, 128 U. S., 182.

Sterling Remedy Co. v. *Eureka Co.*, 80 Fed. Rep., 105 (C. C. A.).

Gilman v. *Hunnewell*, 122 Mass., 139.

Ball v. *Siegel*, 116 Ill., 137.

Monroe v. *Tousey*, 129 N. Y., 138.

Supreme Lodge K. of P. v. *Improved Order of K. of P.*, 71 N. W., 470 (Sup. Ct. of Mich.).

Singer Mfg. Co. v. *Wilson*, 2 Ch. Div., 477.

Popham v. *Cole*, 66 N. Y., 69.

The authorities are conclusive in showing that the determination of what degree of care is to be looked for in the purchasing public must depend upon the character of the article sold, its cost, the class of purchasers and the manner in which the sales are ordinarily made.

Thus, in *Fairbanks Co.* v. *Bell Co.*, 77 Fed. Rep., 869, this court said:

> "In applying the test recognized by the authorities —the likelihood of deception of an ordinary purchaser exercising ordinary care—regard must be had to the class of persons who purchase the particular article for consumption and to the circumstances ordinarily attending their purchase."

And again in *Columbia Mill Co* v. *Alcorn*, 150 U. S.,

460, the Supreme Court of the United States in applying this rule to the case before it said:

> "It is also shown by the testimony in this case that the flour manufactured from spring wheat, such as that dealt in both by the complainant and the defendants, is not sold or bought simply on the brand, but usually, if not always, by actual sample, and the proof fails to establish that the brand of the appellees was calculated to mislead, or did actually deceive or mislead anyone into supposing that the flour of the complainant was being bought. So it cannot be said that the defendants were personating the complainant's business by using such a description or brand as to lead customers to suppose that they were dealing with the appellant. Even in the case of a valid trade-mark the similarity of brands must be such as to mislead the ordinary observer."

In the case of *Morse* v. *Worrel*, Price & Steuart cases, p. 8, it was said:

> "When an article is costly or is used principally by persons above the ordinary standard of intelligence and is likely to be closely inspected, the danger of deception would necessarily be less than in the case of an article of stove polish sold at retail for ten cents and used chiefly by the humbler and more ignorant classes. (*Monro* v. *Smith*, 59 Hun., 624)."

Certainly, considering the expense of high grade typewriting machines like complainant's and defendant's, the intelligence of the class of persons who purchase and use them and the fact that it is a common practice to sell them upon trial gives ample warrant for expecting a degree of care and attention in their purchase above the casual attention that is given by purchasers of ordinary, cheap commodities such as patent medicine, thread, soap, etc.

The contention of complainant's counsel that many purchasers of typewriting machines are not users, and hence

not familiar with the machine, is but a captious one. Purchasers of typewriting machines are in the main of two kinds, viz., operators and those who purchase for operators. It would be absurd to contend that with a machine so universally known as complainant's any operator could be mistaken or misled into the purchase of a Rem-Sho or any other machine for it. On the other hand, if the non-using purchaser bought a Rem-Sho or other machine supposing it to be a Remington, the operator would speedily advise him of his mistake.

The Phillips Transaction.—In the course of the rebuttal testimony, attempt was made to prove that one H. W. Phillips had purchased a Rem-Sho machine, supposing it to be a Remington machine, or a machine sold by complainant. Complainant's testimony concerning the Phillips transaction was objected to as manifestly not proper rebuttal and as incompetent, but if considered it must show clearly the extremes to which complainant has resorted in its effort to sustain the charges of its bill of complaint.

The testimony offered by complainant with respect to the Phillips matter is found in the deposition of George T. Newton, the manager of complainant's New Haven office. (R. p. 618.) Newton testifies that on January 9, 1900, he received a letter in an envelope addressed to the "Remington Typewriter Agency, New Haven, Conn.," the letter bearing the signature of H. W. Phillips. A reproduction of this letter is found in the Record, page 940, and it reads as follows, viz.:

> "Some six weeks ago I bought a new Rem. typewriter at your New York office, giving in exchange and old model No. 6. For various reasons, I have not been at all satisfied with the trade, the new ma-

chine not giving anything like the satisfaction derived from the old. I now beg to inquire if I can not in some way get back my old typewriter or one of the same series or model. Inasmuch as I paid a heavy difference for the new one and have only used it about six weeks, it appears that we ought to exchange with a financial difference in my favor. However, I will be pleased to receive one of your salesmen any evening at my residence. Please write and state what evening I may expect him, as my time is so occupied that an appointment is quite necessary if I am to meet him."

Phillips was not produced as a witness because, as Newton alleges, he could not be found. (R. 620.) Newton states that on the evening of January 9, 1900, he called at Phillips' residence and found there a Rem-Sho typewriter. He states also that at that time Phillips exhibited to him the bill or invoice of said machine. An alleged copy of this invoice, which was marked for identification "Copy of Phillips' Bill" (R. 620), read as follows, viz.:

"N. Y. Nov. 12, 1899.

H. W. Phillips, To Remington-Sholes Co., Dr.,

One Pica hd 4-1736	95.50
By old machine	45.00
	50.50

Received payment

J. E. A."

From the cross-examination of Newton it appears that on January 10, 1900, he wrote to complainant's New York office with regard to the Phillips matter, enclosing the Phillips letter (R. 624 and 626), and subsequently he exchanged with Phillips and upon an even basis (R. 625) a new No. 6 Remington machine for the old Rem-Sho machine, which was offered in evidence as "Complainant's Phillips Exhibit Rem-Sho Typewriter." (R.

620.) He states further that Phillips afterwards, at his request, and, as he thinks, some time in February, 1900, visited complainant's New York office.

The testimony in surrebuttal with respect to this matter clearly shows that the Phillips transaction was a fraud from start to finish, and was designed for the two-fold purpose, first, of procuring a new No. 6 Remington machine for a second-hand Rem-Sho; and second, of manufacturing evidence to be used in this cause. The Rem-Sho machine obtained from Phillips by Newton is a No. 4 model and bears the serial No. 5376 (R. 1375), this number appearing at the bottom of the front foot of the machine, where all serial numbers are marked in No. 4 Rem-Sho machines.

The testimony of Joseph E. Platt, the New Haven manager for the Manhattan typewriter, called as a witness in surrebuttal, shows that about November 1, 1899, Platt ordered from the Remington-Sholes Company of Chicago a Rem-Sho machine which bore the number 5376 and was shipped to his New Haven office on November 3, 1899. (R. 1415.) The date of shipment of this machine to Platt is clearly proven by the testimony of Fred. W. Payne, then, as now, shipping clerk at the factory of the Remington-Sholes Company (R. 1416), and by the factory record. The testimony of Payne also shows the fraudulent character of the alleged Phillips invoice, as machine No. 1,736 mentioned therein was not a No. 4 machine, was never shipped to New York City, but was shipped to Berlin, Germany, in December, 1898. (R. 1415.)

Platt further testifies that after the receipt of this Rem-Sho machine No. 5,376 he rented it for several months to different parties and then co-operated with Phillips in his

plot to procure in exchange for it a new No. 6 Remington Standard. To this end the Rem-Sho machine was delivered to Phillips' house about the 1st of January, 1900, by Mr. George R. Bradley, who at that time was a clerk in Platt's office, but who within a short time thereafter became and now is a salesman in complainant's New Haven office. (R. 1383.) The testimony of Platt also shows that Phillips took this Rem-Sho machine No. 5,376 for the sole purpose of trading it for a new No. 6 Remington, as he understood that Wyckoff, Seamans & Benedict were ready to trade their new machines for old Rem-Shos on an even basis, if no cash in addition could be procured. (R. 1377.) He did not give Platt for the old Rem-Sho either any cash or a second-hand machine, as alleged in the "Phillips Letter" and invoice. (R. 1376.) Having obtained the Rem-Sho machine, Phillips at once wrote to complainant's New Haven office the letter that has been offered in evidence. Mr. Newton, the New Haven agent, as his testimony shows, promptly responded to this letter, and made the exchange with Phillips, who thereupon gave the new Remington No. 6 to Platt, and he in turn exchanged it for several second-hand machines, (R. 1379.)

While Phillips, with the co-operation of Platt, succeeded in obtaining a new Remington No. 6 typewriter for a second-hand Rem-Sho, thus accomplishing the first object of the Phillips plot, we scarcely think that the court, in the light of the evidence, will permit the second obvious purpose of this plot, viz., to show that confusion existed, to be attained.

Aside from the fraudulent character of the transaction so fully disclosed by the testimony of Platt and Bradley, it is clearly proven by both these witnesses that there

could not possibly have been any confusion in Phillips' mind with regard to the Remington and the Rem-Sho machines. Phillips was an advertising solicitor for the "New Haven Leader," and so had been for nine months before the transaction in question. (R. 1388.) Platt's office (the agency of the Manhattan typewriter) was located across the street from complainant's New Haven office, and Pratt says that Phillips was up and down the street "fifty times a day" (R. 1378), while Bradley admits that he passed the office frequently. (R. 1384.) Complainant's New Haven office, at its employee Bradley states, had its front windows "decorated with our large Red Seal, which is, I believe, the trade-mark," and in front of the office window a large sign bearing the name "Remington Standard Typewriter," and the name "Wyckoff, Seamans & Benedict." (R. 1388.)

Alleged Deception of Purchasers by Scorer.

In his direct examination, complainant's witness Scorer (R. 350) testified that he believed that a Mrs. Vance, then residing at Sharpsburg, "bought a Remington-Sholes machine, supposing that it was manufactured by the Remington people;" and in his cross-examination he gives the names of the following additional persons who he says bought Rem-Sho machines believing them to be Remingtons, viz., Williams, Sloan & Griffiths, Greensburg, Pa.; Robbins & Kunkle, Greensburg, Pa., and Halstead & McNaugher, Pittsburg, Pa.

While the statement of Scorer that the parties mentioned were deceived was manifestly incompetent, the testimony of the parties themselves being the only proper evidence to such fact, *all of these parties were produced as witnesses on behalf of defendant*, and their evidence

makes it entirely plain that in none of the cases was any deception attempted, nor did any confusion exist.

The Mrs. Vance Transaction.—It is a noticeable fact, appearing from both complainant's and defendant's records (R. 708 and R. 1219) that during the taking of Scorer's deposition in Pittsburg, and while he was so glibly testifying that Mrs. Vance had been deceived, **Mrs. Vance was present in an adjoining room, having come there at the request of complainant.** But complainant's counsel did not place her upon the stand. The testimony of Scorer shows (as does that of Mrs. Vance and various other witnesses) that Mrs. Vance was a stenographer of long experience, and for many years had used the Remington machine; that she was well acquainted with the Pittsburg office of complainant, and was a frequent visitor to that office prior to the transaction in question. (R. 586.) It further appears that she knew that the Remington machine was made by Wyckoff, Seamans & Benedict at Ilion (R. 1210), and that the Rem-Sho was a competing machine. (R. 1211.) It appears from Scorer's deposition (R. 366) that she declined to buy a Remington machine because of her personal dislike for the Remington agent.

She testifies, when called as a witness for defendant, that "she never supposed that the Rem-Sho was the same as the Remington" (R. 1210); that she merely took the Rem-Sho machine on trial (R. 1208); that when Scorer first called he explained to her the advantages of the Rem-Sho over the Remington (R. 1209); that Scorer informed her that the Rem-Sho was as good as the Remington; that it was a new machine and that one of the parties who was connected with it had *once been connected* with the manufacture of the Remington (R. 1212); but that

she knew that the Rem-Sho was not made by the same persons who made the Remington, and that it wasn't a Remington. (R. 1212.)

Subsequently Mrs. Vance was recalled by complainant and was shown a typewritten statement (R. 572) alleged to have been dictated by her to a Miss Stein (whose married name is Ferguson). With respect to this statement her testimony is very clear that the body of such statement was dictated to Miss Stein by Mr. Thomas F. Crean and that she objected to the contents of the statement as not being correct. (R. 575.) Mrs. Ferguson (*nee* Miss Stein) when called as a witness for complainant, says that Mrs. Vance dictated the statement, but admits on cross-examination that *Crean did make some suggestions* that were incorporated in the statement. (R. 588.) No attempt was made to produce Mrs. Ferguson's note-book in which she claims to have taken down Mrs. Vance's statement, nor was any search made for the note-book, which would have shown what changes were made in the course of the dictation of the statement. (R. 587.)

Crean testified, when recalled as a witness, that Mrs. Vance dictated the statement and that she made no corrections therein. His testimony was given after Mrs. Vance had left the stand and the allegation made by him that her husband said that Mrs. Vance would not go on the witness-stand unless paid $50 is manifestly unworthy of consideration in view of the admitted fact that Mrs. Vance was closeted with counsel for complainant when Scorer gave his deposition, and could have been had by subpœna at any time. (R. 600.)

A reading of Crean's answer to Q. 10 of his last deposition (R. 591) and a comparison thereof with the typewritten statement and a comparison also of this statement

with the deposition of Mrs. Vance must clearly show by its very language that it was framed by Crean and not by Mrs. Vance. Thus, Crean says (R. 592) in regard to his interview with Mrs. Vance, "I had a conversation with her and told her that I understood she had purchased a Remington-Sholes typewriter about a year previously, and that when she purchased such machine she was given to understand that *it was a species of Remington machine.*" The fact also that the bill of complaint (*filed a year before the Vance transaction*) charges the sale by defendant of Rem-Sho machines as a "species" of Remington machine and that the alleged statement of Mrs. Vance is drawn in the technical language employed by the bill of complaint and by Crean and not in such language as would be expected from a woman, will surely not escape the notice of the court.

In the course of his cross-examination Crean makes an admission, however, with respect to this Vance transaction which clearly establishes the fact that Mrs. Vance did not understand that the Rem-Sho machine was in any sense a product of complainant's factory, as will appear from the following question and answer (R. 597):

> "X-Q. 36. Did you not understand from her that she supposed the Rem-Sho was the same make of machine that she had been using or was manufactured by the parties who were at that time making the familiar Remington machines? Is that correct?
>
> "A. Not so far as the make of the machine is concerned, but *not that it was manufactured by the same people who were at that time making the Remington,* but that it was a Remington machine inasmuch as it had been invented and put on the market by the same people who invented and put the other Remington on the market. This was my understanding of her conversation."

In the light of the statement of Mrs. Vance, the fact that she had long been familiar with the Remington machine, its Pittsburg agent and office, its place of manufacture, and that she understood that the Rem-Sho was a competing machine of different manufacture, no force whatever can attach to the allegation of Scorer that she was deceived at the time she took the Rem-Sho on trial.

Williams, Sloan & Griffiths Purchase.—The testimony of Mr. Williams, of the law firm of Williams, Sloan & Griffiths, when called as a witness on behalf of defendant, clearly refutes the allegation of Scorer that the sale of the Rem-Sho machine to such firm was an instance of deception or mistake. Mr. Williams testifies (R. 1221) that his firm were old users of Remington machines; that he always understood that such machines were made by Wyckoff, Seamans & Benedict (R. 1222), and that they had always dealt with Mr. Martin, complainant's Pittsburg agent, whom witness had known for twenty-five years. This witness further testifies that before the purchase of the Rem-Sho it was taken on trial for several weeks; that he understood that it was made by the Howe Scale Company; that he gave an old Remington in part payment for it; that he understood the Rem-Sho to be a competitor of the Remington; that Scorer explained to him that "Rem-Sho" was an abbreviation for "Remington-Sholes," and that witness, "as a chaffing remark," insinuated that there might be likelihood of deception, although, as the witness very naturally adds, "It did not have on my mind the impression I suggested." (R. 1226.)

This testimony of Williams clearly refutes the statement of Scorer as to confusion or deception in the Williams, Sloan & Griffiths sale.

Halstead & McNaugher Sale.—When Mr. McNaugher was called as a witness for defendant, he made plain the fact that there was no deception or confusion in connection with the purchase by his firm of the Rem-Sho machine. He says that his firm had used Remington machines until 1898 (R. 1227); that they then bought a Rem-Sho at the suggestion of Mrs. Vance and gave their old Remington in part payment. He produced an invoice (R. 1228), in which the machine is billed as a "Rem-Sho," and in which the old machine is specified as a "Remington." He further testifies that at the time of the transaction in question he knew that the Rem-Sho was made in Chicago, and that the Howe Scale Company was its agent; that prior to the purchase of the Rem-Sho he had had business with the Pittsburg office of complainant. McNaugher further states that at the time the sale was made, Scorer compared the Rem-Sho with the Remington (R. 1229), and witness understood that the Rem-Sho was not made by the same parties who made the Remington, but was a competing machine. (R. 1229.)

This testimony plainly shows that there was no deception or confusion connected with the Halstead & McNaugher sale.

Robbins & Kunkle Sale.—The record shows (R. 1361) that the law firm of Robbins & Kunkle had for a long time been users of the Remington machine. Mr. Kunkle, who negotiated the purchase of the Rem-Sho from Scorer, testifies that they gave their old Remington machine in part payment, and the invoice furnished them by the Howe Scale Company shows this fact (R. 1464), as does also a contemporaneous written agreement be-

tween this firm and the Howe Scale Company. (R. 1464.) Kunkle further testifies that at the time of the sale Scorer pointed out the advantages of the Rem-Sho over the Remington (R. 1364), and gave witness to understand that the Rem-Sho was a different machine and *made by different persons from the makers of the Remington with which it was in competition.*

The witness further states (R. 1365) that Scorer delivered his business card with the name Rem-Sho and a picture of a machine thereon, explained that the Rem-Sho was made in Chicago, was a new machine and made by a new concern, and explained also that the name Rem-Sho was an abbreviation for Remington-Sholes. On cross-examination Mr. Kunkle further states (R. 1366) that Scorer informed him that some one *who had been connected* with the manufacture of the Remington machine was interested in the manufacture of the Rem-Sho; that as witness recalls the name of such person was Remington, but that at that time such person *"had severed his connection with the Remington people entirely."*

From the depositions of the various witnesses whom Scorer claims to have misled or deceived at the time they purchased the Rem-Sho machines it is manifest that there is not one word of truth in such part of Scorer's testimony. The testimony of these witnesses also conclusively proves the falsity of Scorer's statement that he believed the Rem-Sho and Remington to be the same machine during the time he was engaged in selling the former.

Carcaba Advertisement.—In the course of his deposition as a witness on behalf of complainant, Byron A. Brooks (who has long been connected with complainant and who is a stockholder in the so-called typewriter "Trust") (R. 196) states that on the 8th of March, 1899,

he visited St. Augustine, Florida, and saw there copies of the St. Augustine Daily Herald in which the defendants' typewriter was advertised. (R. 192.) Brooks produced three copies of the Herald dated respectively January 23, February 8 and February 10, 1899 (R. 193), and these were introduced in evidence by complainant. Carcaba was the local dealer for the Rem-Sho machine and in advertising such machine used a wood-cut thereof in conjunction with the words "Remember the name, the Remington-Sholes Standard Typewriter." (R. 194.)

Brooks states that he called upon Carcaba, who was a cigar manufacturer, and saw a placard upon the wall of his store advertising the Rem-Sho machine (R. 195), saw there the usual Rem-Sho catalogue describing such machine (R. 202) and was informed by Carcaba that he was selling the Rem-Sho machine. He further states that Carcaba told him that it was an improved Remington "invented by the son of the man who invented the Remington typewriter, who had associated with him Mr. Sholes of Chicago." It is admitted by stipulation (R. 1354) that Carcaba bought the Rem-Sho typewriters from the Remington-Sholes Company; that he was the local dealer for the territory including St. Augustine; that he was originally appointed by Page, Dennis & Company, and that his dealership was continued by the Remington-Sholes Company.

From the same stipulation it also appears that under date of February 20, 1899, Mr. Fay, the president of the Remington-Sholes Company, having been advised of the Carcaba advertisement in question, immediately wrote to Carcaba protesting against his use of the word "Standard" in such advertisement (R. 1473), and that thereupon Carcaba at once changed his advertisement to read "Remember the name, the Rem-Sho Typewriter;" that

said changed advertisement was published by Carcaba in the St. Augustine Daily Herald between February 22 and March 2, 1899, and from that time forth whenever said Carcaba advertised said typewriter. (R. 1354.) Brooks states (R. 202) that he went to the office of the Herald to see the changed advertisement of Carcaba; that the only paper he could get was the one introduced in evidence, and that he could not find that any change had been made. It is singular, to say the least, that although Carcaba's new advertisement *admittedly appeared in the Herald immediately before Brooks arrived in St. Augustine,* he was unable to find this advertisement, although he succeeded in procuring *three* copies of the older one to which Mr. Fay had objected. We submit that no intention to confuse or mislead the public can be predicated upon this suppressed Carcaba advertisement.

The record shows that the word "Standard" is truly applicable to any high-grade machine such as the Rem-Sho, and that it is commonly used by the typewriter companies in the typewriter "Trust" in describing their different makes of machine. (R. 1087 and R. 1470-1472.) Thus the Yost, the Densmore, the Caligraph are all designated as "standard" typewriters. The advertisement in question gave the name and address only of Mr. Carcaba, and the intending purchaser, even if he was confused by the words "Remington-Sholes Standard Typewriter" and was led to the Carcaba store supposing that he might find there the usual Remington standard machine, would have been met with the Rem-Sho signs and catalogues that were admittedly displayed there and which gave not only the name and address of the makers of the Rem-Sho, but also a full history of the machine, and the statement that it had not connection with complainant's machine, in the light of which no confusion could possibly exist.

Diamond Supply Co. Advertisement and Sign. —The record shows (R. 1394) that in March, 1899, the Diamond Supply Company, of St. Joseph, Mo. (a trade-name adopted by the firm of Bates & Pennewill), undertook the dealership of the Rem-Sho machine. They bought *only one* Rem-Sho typewriter, and have *it still, as they never sold any.* (R. 1395.) After their purchase of the Rem-Sho machine they inserted an advertisement in the St. Joseph Sunday Herald. (R. 523 and R. 958.) This advertisement specifies the typewriter as "The REM-SHO, Remington-Sholes, STANDARD TYPEWRITER," shows an illustration of the machine and makes various statements with respect thereto, including the statement in bold-face type that it is "NOT IN THE TRUST." This advertisement was not submitted to the Remington-Sholes Company before its publication (R. 1400), and there was no agreement whatever between the Diamond Supply Company and the Remington-Sholes Company whereby the latter might control such advertisement.

What has been said with respect to the Carcaba advertisement applies, therefore, to the advertisement of the Diamond Supply Company. Certainly an inspection of such advertisement must convince the court that it could not produce confusion or deception in the public mind. That it did not do so, or indeed have any effect whatever, is evidenced by the fact that the Diamond Supply Company did not sell a single machine. Indeed, complainant's witness, testifying with respect to this advertisement, says (R. 525) that he did not pay a great deal of attention to it at the time, but merely mailed a copy of the paper to complainant's Kansas City office *as there was a standing order or an understanding that salesmen were to keep complainant posted on all matters transpiring in their territory.* (R. 526.)

In its rebuttal testimony complainant's witness Holton states (R. 524) that in the early part of May, 1899, he noticed a sign in the window of the Diamond Supply Company containing simply the name "Remington," the purpose of such testimony being to convey the impression that the sign in question was meant as an advertisement of the Rem-Sho typewriter. No reason was given why complainant did not introduce this testimony while its *prima facie* proofs were being taken, and the suspicion that the testimony was designed to convey a false impression is confirmed by the deposition of Mr. Bates when called as a witness in surrebuttal on behalf of defendant. Bates testifies (R. 1397) that the store of the Diamond Supply Company occupied two adjoining buildings that were connected by a doorway; that in May, 1899, the Diamond Supply Company undertook the agency for the sale of the Remington bicycle and purchased one wheel from the Remington Arms Company; that this wheel was enclosed within a paper case upon which was printed the name "Remington," and that he cut the name from the case and displayed it in the window in connection with the Remington wheel. The testimony of this witness shows (R. 1398) that at such time the Rem-Sho typewriter was in a position for use in the adjoining store and where it could not be seen from the window in which the Remington wheel and its sign were displayed. A reading of the deposition of Bates conclusively proves that there was not the slightest intent to use the name Remington in connection with the Rem-Sho typewriter.

Alleged Unfair Conduct of Rem-Sho Dealers.

The Charge of Misrepresentation Alleged in the Bill of Complaint is Utterly Unsupported by the Proofs.—The witnesses produced to establish this charge are Crean, one of complainant's employees and its chief detective; Lewis, a man hired to accompany Crean in the attempt to entrap defendant's salesmen; Miss Danaher, an employee of complainant who attended Crean on a similar mission; Scheumaker, a hired detective; Scorer, a former employee of defendant, but now in the service of the Typewriter Trust; and Holton, another of complainant's employees. From such an aggregation disastrous results might well be looked for, but fortunately defendant has been able to refute the testimony of these witnesses at every point.

Thomas F. Crean, while manager of complainant's Pittsburg office, was detailed for detective service in this case. (R. 105.) For this purpose he visted the cities of Montreal, Baltimore, Washington, Philadelphia and Camden, and in each place he went with a lie upon his lips and under an assumed name.

In considering the testimony of complainant's witnesses Crean and others, who went "trapping," as the English decisions term it, the court will perceive the force of the folowing pertinent language of Byrne, J., in the recent case of *Truefit* v. *Edney,* 20 R. P. C., 321:

> "When a party goes in who has his mind full of catching another through the medium of a trap, he goes with his mind full of the kind of answer he expects to get, and the kind of question he is going to put."

Crean's Montreal Visit.—Crean testified that on August 7, 1898, he called at the office of Messrs. Clement & Clement in Montreal, who at such time were engaged in the sale of various typewriters, the Rem-Sho among others. He says that he informed Mr. Clement that he had called at the request of others to look at a Remington machine (R. 128), which was manifestly false, and that he had called to learn the address at Montreal of the office of the Remington typewriter, which he admittedly knew. (R. 128.) He further testifies that Mr. Clement informed him that that was the office of the Remington typewriter in Montreal, after which he was taken to an outer room and was shown a Rem-Sho machine, which he states, however, was pointed out to him as a Remington machine. Crean further testifies that Clement told him that the machine was made by the inventors and former manufacturers of the old Remington machine, and that it was the new improved Remington machine; that "Mr. Sholes had made some recent improvements on the old Remington and that such machine was the result of the combined efforts of the Remington people and Mr. Sholes."

These allegations of Crean, when considered in the light of the facts admitted in his testimony, must appear not only improbable but incredible. He admits that upon the door of Mr. Clement's office was painted the sign "REMINGTON-SHOLES TYPEWRITER" (R. 106), and that Mr. Clement gave him one of the usual "Remington-Sholes catalogues, a large quantity of which were on the table in the salesroom." (R. 107.) He admits also that a number of Rem-Sho machines were exhibited and, as he believes, bearing the words "REMINGTON-SHOLES COMPANY, MFRS. CHICAGO." (R. 134.) Now,

having in mind these admitted facts and the further fact that the catalogue of the Remington-Sholes Company makes plain the origin and history of the Rem-Sho machine, and disclaims all connection with complainant's machine, one must assume that either Mr. Clement was both fool and knave in making the statements attributed to him or that the witness has not spoken truly.

The deposition of Mr. Clement, however, must set at rest any question as to the truthfulness of Crean's statements regarding his Montreal visit. Clement denies emphatically (R. 1308) not only that he ever made such statements, but says that in view of the threatened litigation he had instructed his salesmen to use the greatest precaution to prevent any possibility of confusion arising by reason of the appearance of the name of the Remington-Sholes Company in connection with the machines offered for sale. (R. 1322.) This witness was asked in cross-examination the following pertinent question (R. 1318):

> "X-Q. 97. Now in your opinion as one having knowledge of the trade, don't you think that the title Remington-Sholes, is likely to lead to confusion between a machine manufactured by the Remington-Sholes Company and the Remington Standard Typewriter?"

He answered:

> **"A. My experience of two years with the Remington-Sholes has shown me that no such confusion has ever arisen and my opinion is necessarily based on my experience."**

Certainly, in the light of the testimony of Clement and of the facts admitted by Crean, no force whatever can attach to the testimony of Crean with respect to his Montreal visit.

The fact that Mr. Clement did not recall the Crean visit is of no importance (*California Fig Syrup Co.* v. *Taylor Drug Co.*, 14 R. P. C., 564, High Court of Appeals). The folowing language of Farwell, J., in *Ripley* v. *Griffiths*, 19 R. P. C., 591, is pertinent:

> "Of course one looks with a certain amount of suspicion on a trap set, because it is quite obvious that people go there with the intention of successfully trapping and they are apt—possibly unconsciously, but at any rate they are apt—to set their trap in the way that traps are usually set, so that it will not be seen. If you want the court to rely upon the testimony of persons trapping, when they have completed their trap and have got the victim in it, the least they can do is to tell him that that is the occasion that they are going to give evidence about in court, so that, then and there, he may be able to recall and recover his recollection of the circumstances and be ready to give his account in court, so that the court should not be asked to rely upon the testimony of the witnesses for the plaintiff on the ground that the defendant cannot possibly remember what took place."

Crean's Baltimore Visit.—Crean further testifies (R. 108) that on October 4, 1898, he called at the office of the Tribune Cycle Company in Baltimore and saw their representative, J. T. Gillelan, the Tribune Cycle Company being at such time the representative of the Howe Scale Company for the sale of the Rem-Sho typewriter. He told Gillelan that he had called at the suggestion of a Mr. Johnson, of Washington, who he said had advised him that he (Gillelan) had an improved Remington typewriter; that while examining the machine he asked Gillelan the direct question, "Is this a Remington machine?" to which he says Gillelan replied: "Yes, it is the new Remington; it is manufactured by the former

manufacturers of the old Remington and was invented by the inventors of the old Remington;" that Gillelan repeatedly said: "It is the new Remington and it is a decided improvement over the old Remington."

Upon this visit Crean was accompanied by an assistant detective—hired for the occasion (R. 256)—Roger E. Lewis. *This witness testified from a written memorandum made in duplicate by Crean* (R. 252), and as long as he adheres strictly to the memorandum he is found to corroborate Crean and avoid telling the truth. But when Lewis departs from his memorandum we begin to get an intimation of the fact that no attempt whatever at deception was made by Gillelan.

The facts admitted by Crean and Lewis are plainly at variance with any attempt upon the part of Gillelan to misrepresent the Rem-Sho machine. Thus both Crean and Lewis admit that they saw in Gillelan's office the usual catalogues of the Remington-Sholes Company. (R. 108.) Crean admits that Gillelan stated that his company was the representative for the sale of the "Remington-Sholes" typewriter in Baltimore, and that there were eight or ten Rem-Sho machines displayed. He also says:

> "Mr. Gillelan told me that the Mr. Remington and Mr. Sholes, whose names were applied to the machine which he was offering, formerly made the old Remington which they sold some time ago to people called Wyckoff, Seamans & Benedict. That these latter people were now making the old Remington, so that the old Remington was no longer being manufactured by the Remington people, but by three individuals, Wyckoff, Seamans & Benedict, and that the only typewriting machine which the Remington people were now offering was the Remington-Sholes typewriter."

Mr. Lewis, when asked what kind of typewriting machines were exhibited in the store of the Tribune

Cycle Company, answered: "The machine was known as the Rem-Sho" (R. 250); "and bore that name" (R. 253); that the catalogues that he saw displayed there set forth in detail the Rem-Sho machine. (R. 253.)

Departing from his memorandum, Mr. Lewis begins to tell the truth in regard to the Gillelan interview, as will appear from the following questions and answers (R. 253):

"X-Q. 16. Is it not a fact that Mr. Gillelan said in substance that the Rem-Sho machine was an improvement on the old Remington?

"A. No it is not. I WAS PUT UNDER THE IMPRESSION BY MR. GILLELAN THAT HIS MACHINE HAD NO CONNECTION WHATEVER WITH THE STANDARD REMINGTON, but as he stated in answer to a question of Mr. Crean's, that it was an improved Remington.

"X-Q. 20. You the positive, are you, that the name Wyckoff, Seamans & Benedict was not mentioned during that conversation?

"A. The name of Wyckoff, Seamans & Benedict was mentioned once, as I remember, by Mr. Gillelan.

"X-Q. 21. In what connection?

"A. Wherein he stated that Mr. Remington and Mr. Sholes had sold the old Remington to the people mentioned.

"X-Q. 22. And did Mr. Gillelan state that said latter people were then making the Remington typewriter?

"A. I think he did.

"X-Q. 23. DID YOU HEAR MR. GILLELAN DESCRIBE TO MR. CREAN ANY OF THE ADVANTAGES OF THE REM-SHO MACHINE OVER THE REMINGTON TYPEWRITER?

"A. I DID.

"X-Q. 32. And do you not recollect whether or not he (Gillelan) said that that was the office of the Remington-Sholes Company?

"A. I do not."

These statements and admissions of Lewis, while not in keeping with the facts, show plainly that there could have been no attempt upon the part of Gillelan to represent the Rem-Sho as being the same as the Remington or Remington Standard, *first,* because he described to Crean its superiority over the Remington; *second,* because he stated that it was not manufactured by Wyckoff, Seamans & Benedict; *third,* because he exhibited the machines themselves which bore the name and address "REMINGTON-SHOLES COMPANY, MFRS. CHICAGO;" and, *fourth,* because he displayed the catalogues, one of which Mr. Lewis took, which gave the full and true history of the machine and of its company. It is inconceivable that Gillelan, thus offering the Rem-Sho as a machine competing with and superior to the Remington, should have attempted to represent it as being the same machine, either as to structure or origin.

But a consideration of the testimony of Mr. Gillelan, at present the agent for the Manhattan typewriter (R. 1325), clearly refutes the statements of Crean and Lewis. Gillelan produces the Rem-Sho business card used by him, which clearly shows no attempt in this particular at confusion with complainant's machine. (R. 1450.) He specifically denies the statements of Crean and Lewis and explains that he, like other salesmen of the Rem-Sho machine, had been instructed to explain to prospective buyers and others that the Rem-Sho was in no way connected with the Remington Standard, these instructions having been given after complainant had denied the right of the Remington-Sholes Company to use its name.

Crean's Washington Visit.—Crean testifies that on September 20th and October 15th, 1898, he visited the Washington office of the Rem-Sho typewriter, and that

on the occasion of his first visit he met Frank L. Sholes, who was in charge of such office. (R. 110.) He states that Sholes told him that his (Sholes') uncle, "who was the original inventor and had been the manufacturer of the Remington machine, had combined with the Remington people and that together they were making the Remington-Sholes typewriter." He says that he suggested to Mr. Sholes that he could "influence" an order through the Army Department for a Remington machine, and asked him if it would be entirely safe for him to fill the order with a Remington-Sholes machine; that Sholes said that he would not hesitate for one moment about filling the order, etc.

The testimony of Mr. F. L. Sholes (R. 1165) shows that Crean sought to entrap him. In this connection Sholes says:

> "A gentleman came into the office representing himself as Charles T. Francis of Norfolk, Va., saying that he was an instructor at the Naval Academy and that he had in his possession a requisition for a No. 6 Remington standard typewriter. He told me that he was impressed with the Rem-Sho machine, I having explained it to him a few moments before this, and asked me would I fill this requisition with a Rem-Sho machine and that if I made the bill to read Remington No. 6, I would get my money and he would get the machine and we would both be satisfied. This I most positively refused to do. I told him that if he really desired to get a Rem-Sho machine he could undoubtedly have the requisition changed to read Rem-Sho. He said that he had had a hard time in getting a requisition for a new machine and that he was afraid that if he went back to have it changed there might be some hitch. . . .
>
> "Q. 30. Did you ever tell such person that you would not hesitate for one moment about filling the order for a Remington-Sholes machine if he could obtain it?

"A. On the contrary, I refused to do any such thing, for if I had agreed to do so the machine would have been sold and delivered . . .

"Q. 33. Did you tell such person with whom you had said conversation anything regarding the history of the Rem-Sho machine or of the Remington-Sholes Co.?

"A. Yes, I did.

"Q. 34. What did you tell him in this connection?

"A. I told him Mr. Zalmon G. Sholes, the inventor of the Remington-Sholes machine, was a son of C. L. Sholes, who was the principal inventor of the old Sholes & Glidden typewriter, from which the Remington had been developed. I stated that Mr. Remington's father was of the old firm of E. Remington & Sons who originally made the typewriters and from whom they derived their name and that the two had formed a company and were now manufacturing the Rem-Sho machine at Chicago, Ill., and I might say that the gentleman looked at me as though he knew all that I was telling him."

These plain statements of Mr. Sholes, coupled with the fact, as the testimony shows, that his office was provided with the usual signs, catalogues, cards, etc., of the Remington-Sholes Company, must clearly refute the allegations of Crean's testimony as to his first Washington visit. Crean, although produced as a witness in rebuttal, offers no word of denial of these specific statements of Mr. Sholes.

On the occasion of his second Washington visit, Crean took with him Miss Danaher, an employee in the Washington office of Wyckoff, Seamans & Benedict. They testify that they found Mr. Sholes absent, but talked with M. J. L. Russell, a young man who was in the employ of Brice & Lipscomb, real estate agents, part of whose office was rented for the business of the Remington-Sholes Company. (R. 1145.) Crean testifies that Russell said that

he had charge of the sales of the Remington-Sholes machines under the supervision of Mr. Sholes; that he told Russell that he (Crean) understood "his machine was an improved Remington," and that Russell replied: "Yes, it is; it was invented by the inventors of the old Remington and is made by the people who make the old Remington; it has all the good points of the old Remington and many new ones in addition;" that Russell pointed to a Remington No. 2 machine in the opposite corner of the room and said: "That his machine was not controlled by any combination as the old Remington was and he was able to offer it at $85.00," adding: "You see this machine was invented and is being made by the same people who make the other Remingtons, but as no one controls Mr. Sholes, he is able to sell it at a lower price."

That no value should be attached to Miss Danaher's testimony is made plain from her cross-examination. When asked in what manner she had refreshed her memory she seeks to evade the truth by saying (R. 262): "I have tried to recall as best I could what was said during that conversation." When further pressed as to the manner in which she had refreshed her memory, she reluctantly admits that *on the morning of her examination she read over a memorandum which she says was "made by Mr. Crean and contained in substance what I have said."* The whole tenor of this witness' deposition shows that she was drilled to say that Russell had stated that the "Remington-Sholes was being manufactured by the same people as the Remington," but from her cross-examination it is plain that Russell did in fact make it appear that the Rem-Sho machine was a machine competing upon the market with the Remington and was in no sense the same machine. Thus she admits (R. 258) that Russell said

that the machine he showed her was "not in the Trust." And regarding the Russell conversation she further testifies (R. 260):

> "X-Q. 15. You are positive, are you, that the language he (Russell) used was to the effect that both the Remington-Sholes machine and the Remington standard machine were being made at that time by the same persons?
>
> "A. I *inferred* from what he said that the Remington-Sholes machine was made by the same people who made the Remington machine. . . .
>
> "X-Q. 20. DID THE YOUNG MAN (RUSSELL) EXPLAIN ANY ADVANTAGES OF THE REM-SHO. MACHINE OVER ANY OTHER MACHINES?
>
> "A. I THINK HE DID OVER THE REMINGTON MACHINE. . . .
>
> X-Q. 22. Do you recall whether he stated how much cheaper the Remington-Sholes machine could be bought than the Remington?
>
> "A. For $80.00 or $85.00, I do not remember for which figure.
>
> "X-Q. 23. And he stated that such price was less than that at which the Remington was being sold, did he?
>
> "A. Yes, sir. . . .
>
> "X-Q. 27. Can you not state whether the young man said that the Remington-Sholes machine was not controlled by any combination or Trust?
>
> "A. He stated the Remington-Sholes machine was not in the Trust and that was the reason that it was sold for so much less than the Remington."

The testimony of J. L. Russell, when produced as a witness on behalf of defendant, as well as the testimony of F. L. Sholes, establishes beyond question the fact that what Crean stated in respect to his second Washington visit was false and that what Miss Danaher *"inferred"* with respect to such visit was a mistake. Russell's testimony shows (R. 1145) that he was employed exclusively

by Brice & Lipscomb and had no connection whatever with the Rem-Sho office. He recalls the conversation with Crean and Miss Danaher; remembers telling them that the Rem-Sho machine was "not in the Trust as the Remington people were" (R. 1148); that he said that the Rem-Sho was manufactured by the Remington-Sholes Typewriter Company; that he never stated that such machine was being made by the people who are making the Remington machine; that he gave Crean or Miss Danaher a Rem-Sho catalogue; that he showed them the Rem-Sho typewriter and also the Remington machine which was the property of Messrs. Brice & Lipscomb, and indicated, as he says, "the many good points that the Rem-Sho typewriter had that were lacking in the Remington;" and that he further stated "that the Rem-Sho typewriter was invented by the son of the inventor of the old Remington." Russell having no connection whatever with the Remington-Sholes Company or defendant, manifestly statements made by him to Crean could be of no effect; but his testimony is pertinent as evidence of the falsity of the statements of Crean regarding his expeditions that were made for the purpose of entrapping salesmen of the Rem-Sho machine.

The Washington office for the sale of the Rem-Sho typewriter was equipped with the usual signs of the Remington-Sholes Company, the sign on the outside of the building reading "REM-SHO TYPEWRITER, MANUFACTURED BY THE REMINGTON-SHOLES COMPANY, CHICAGO, ILLS." The usual Rem-Sho catalogues, cards, etc., were also employed, these being extensively distributed by Mr. Sholes. (R. 1163.) Certainly, in the light of these facts, it is incredible that any attempt could have been made by Sholes or Russell to create the impression

of identity either as to construction or origin between the Rem-Sho machine and the Remington Standard, with which it was admittedly compared as a competitor, both in construction and price.

Crean's Philadelphia Visit.—The climax of this witness' chicanery was reached on the occasion of his visit to Philadelphia July 19, 1898, and the circumstances surrounding this visit must utterly condemn both the methods and the man capable of practicing them.

From Crean's cross-examination we find that on this visit he approached defendant's salesman with not only a spoken but a written lie. After his arrival at the Hotel Lafayette he first went to a printing office and caused a letter-head to be printed with the name of "BROOKS & CO., general Importers, Jamaica, W. I." ("Defendant's Exhibit Brooks & Co. Letter," R. 1477). Upon this bogus letter-sheet he wrote the following (R. 130 and 131):

> "JAMAICA, W. I., July 12, 1898.
>
> "JAS. A. HOOD, ESQ.,
>
> "Baltimore, Maryland, U. S. A.
>
> "*Dear Sir:*—Since our last advises to you on the subject of writing machines we have received the requisition of the Depart. of Justice of the Island District, authorizing us to furnish them with a writing machine. THE SPECIFICATION CALLS FOR 'ONE (1) WRITING MACHINE OF THE STYLE REMINGTON, WITH COVER OF TIN AND WOODEN BOTTOM.'
>
> "We have as yet had no advices from you in response to our last communication on the subject of writing machines and not knowing what action you may have taken will not attempt specific instructions so far as the filling of this order is concerned. If you have consummated an arrangement with the manufacturers you are at liberty to forward the ma-

chine with next shipment in usual course, well wrapped. Type like last sent.

"We shall write your further regarding other matters by later post.

"Very truly yours,

"BROOKS & Co."

"ASTOR HOUSE, N. Y., N. Y., July 28/98.

"HOWE SCALE Co.,

"Phila., Penn.

"Referring to letter 19th regarding typewriters, above letter just received. AM INCLINED TO SHIP MACHINE ON THIS ORDER IF YOU WILL BILL SO AS TO COVER LANGUAGE OF SPECIFICATION. If so, prepare machine and mail me invoice and measurements *at once* to Astor House, N. Y. Will send shipping directions accompanied by check, less cash discount within few days. BE PARTICULAR TO MAKE OUT BILL 'OF THE STYLE REMINGTON,' etc.

"Hastily,

"JAS. A. HOOD.

"Return above letter with bill."

The postscript to the above letter was written by Crean at a later date. (R. 134.) Crean testifies that after writing this letter he telephoned the office of the Howe Scale Company and requested that a typewriter salesman be sent to the hotel; that within a few minutes thereafter Mr. W. J. Romig called, presented his card, spent a few minutes with him and left to return later in the day. Crean states that when Romig returned he stated in substance (R. 112) that:

"The machine he (Romig) was offering was an improved Remington machine; that it was made by the former manufacturers of the old Remington but was being handled through the Howe Scale Co., by the Remington-Sholes Co., whose office was in Chicago. He said to me that the Remington machine

was at present not manufactured by the Remington Co., but by Wyckoff, Seamans & Benedict, and that his was really the Remington machine."

In carrying out his plot to entrap Romig, Crean introduced himself as Jas. A. Hood of Baltimore and showed Romig the bogus Brooks & Company letter, telling him that there was an opportunity to do business in Jamaica, but that the only machine known there was the Remington. He requested Romig to write him a letter embodying in substance what Romig had stated in the course of their conversation regarding the Rem-Sho machine. Later Romig returned to Crean with the letter that was introduced in evidence on behalf of complainant (R. 971), but this leter telling the truth and consequently not satisfying Crean, he *induced* Romig to add the postscript upon which great stress will doubtless be laid by counsel for complainant.

Romig's testimony with respect to his interview with Crean (*alias* Hood) is in part as follows:

"Q. 18. State fully what occurred at that conversation between yourself and the party representing himself as James A. Hood, of Baltimore.

"A. He told me that he represented an export house in Jamaica, who were in the market for a typewriter as a sample machine, and if sample were satisfactory further orders would follow. He stated that the parties for whom he was buying were familiar only with the Remington typewriter, but that he was dissatisfied with the treatmnet accorded him by the Remington Company, and wished to secure another machine to take its place, if possible a machine similar to the Remington. I expplained to him the Remington-Sholes Machine from catalogues of said machine, which I brought with me. I told him the machine was in many respects similar to the Remington and possessed many features superior to the Remington. When asked in what particular it resembled

the Remington machine and some of its characteristics, I called his attention to the universal keyboard and the shift key, stating that Remington operators would experience no difficulty in operating the Remington-Sholes machine. There were other small matters mentioned which I do not exactly recall. These were in regard to shipping, price, etc. He at that time stating that dealing with me was rather awkward from the fact that he did not know whether he was dealing with the Remington-Sholes Co. or the Howe Scale Co., I informed him that he was dealing with the Howe Scale Co., and explained to him that the machine was manufactured by the Remington-Sholes Co., and that Howe Scale Co. were the sale agents. When the matter of price was brought up, not being familiar with the export prices of the machine, I returned to the office at 508 Market street, to ascertain what prices I could quote him. After ascertaining the price, returned to Mr. Hood, giving the price of the machine for export. He promised to favor me with an order later on, stating that he was going to New York and would send me the order from there. To identify himself with an export house he showed me a letter from Messrs. Brooks & Co., Jamaica, W. I."

Romig states further that at his interview with Crean (*alias* Hood) he left with him a Rem-Sho catalogue, as he always did with parties interested in the subject of typewriters (R. 1117 and 1123), *callled his attention to the statements at the back thereof with respect to the origin of the Remington-Sholes Company and its name* (R. 1135): and told him the machine was made by the Remington-Sholes Company of Chicago. Romig stated that he had no recollection of writing "Complainant's Exhibit Romig's Seddon Letter," which was not present during his examination, nor its postscript, but as the postscript appears to be in Romig's handwriting, we have stipulated that it was written by him. While this

postscript, taken alone and without regard to the circumstances under which it was written, or the party for whom it was written, might be important, we submit that under the circumstances it cannot serve to show any purpose whatever on the part of Romig to influence Crean to believe that the Rem-Sho machine was identical with or had any connection whatever with complainant's machine. As Romig testifies (R. 1135) Crean (*alias* Hood) was "thoroughly familiar with the Remington machine," and Romig had fully explained to him, by the Rem-Sho catalogue and in conversation, the history of the Remington-Sholes Company and of the origin of its name and that its machine was a competitor of complainant's machine.

After the Romig interview, Crean went to New York and from there sent to the Howe Scale Company's Philadelphia office the bogus Brooks letter that had been shown to Romig, writing the postscript at the bottom, urging that the Rem-Sho machine should be invoiced "*of the style Remington.*" The machine was not shipped to Crean (*alias* Hood), but apparently an invoice was sent in which the machine was described as "1 Remington-Sholes Typewriter of the style Remington."

Crean's Camden Visit.—Crean testified that on September 16, 1898, he visited Camden, N. J., and telephoned the Howe Scale Company's office in Philadelphia to send over a typewriter salesman; that in response to his request Mr. Wilgus called; that he showed Wilgus the letter that Romig had written with its postscript; and that Wilgus made practically the same statements as Romig had made in regard to the Rem-Sho machine. Crean further testifies that he received from Wilgus a copy of the Rem-Sho catalogue, together with various newspaper

clippings and advertisements with regard to such machine, and that Wilgus gave him (Crean) a copy of the Remington-Sholes Company's nine-page letter of "Instructions to Agents," and called his attention particularly to the following parts thereof:

> "The escapement of our machine is nothing more than the escapement of the old No. 2 Remington machine. . . . The machine has now been fully explained and it remains with the salesman to add such other interesting facts, the connection of our Mr. Remington with this machine and the relation to the old Remington standard; the fact that this is the second generation of typwriter builders, and that the same standard of excellence is being maintained in the manufacture of this machine as all other goods which have been produced by the Remingtons."

Crean further testifies that later in the day Wilgus returned with a Rem-Sho typewriter which was then delivered to Crean and was paid for by him; that at the same time Wilgus delivered an invoice which designated the machine as "1 Remington-Sholes Typewriter No. 2,993, of the Style Remington."

From the testimony of Wilgus, when produced as a witness on behalf of defendant, it appears that he, too, gave Crean (*alias* Hood) a copy of the Rem-Sho catalogue, calling his attention particularly to the statements upon the last page thereof in regard to the name and origin of the Remington-Sholes Company. (R. 1339.) In regard to the invoice for the machine which Wilgus delivered to Crean, the testimony of Wilgus is as follows (R. 1339):

> "Q. 17. What, if anything, was said by Mr. James Hood, so-called, in regard to the invoicing of the Rem-Sho machine at the time this invoice was delivered to him by you?
>
> "A. Mr. Hood had an invoice of a prior date and

wanted the new one made out '1 Typewriter, style Remington,' which I refused positively to do.

'Q. 18. What reason did you give Mr. Hood for refusing to provide the invoice as he requested?

"A. I explained to Mr. Hood that it was not a Remington machine and therefore I could not bill it in that way.

"Q. 19. What reason did Mr. Hood give for wishing to have the invoice billed as '1 Remington Machine,' or '1 Remington Typewriter'?

"A. He stated that he had a requisition for a Remington typewriter and to bill it that way could avoid any question with his party, but that he wanted to use our machine in place of the Remington."

Wilgus admits writing the invoice delivered to Crean, but denies that he placed the word "Remington" in quotation marks. While Crean, when called in rebuttal, says that he did not place such quotation about the word Remington, an inspection of the original invoice will clearly show, we think, from the color of the ink, and appearance of the quotation marks, that they must have been added after the invoice was delivered to Crean, and for an obvious purpose.

Indeed, in view of the fact that the Rem-Sho machine has the universal key-board, the upper and lower case type bars, and many other features that characterized the old Remington Standard Typewriter (the patents on which have long since expired), it might not require much persuasion by so plausible an individual as Crean to induce a zealous though honest salesman to bill defendant's machine as "a Remington-Sholes typewriter of the style Remington."

Defendant's Letter of Instructions to Salesmen.—Wilgus denies emphatically the untruthful statements attributed to him by Crean. He admits that he gave Crean the nine-page Letter of Instructions for the

reason that he believed it would assist him in "successfully handling the Rem-Sho typewriter." (R. 1341.) An examination of this "Letter of Instructions to Agents" conclusively shows an entire absence of any intention that it should be used for the purpose of confusing the Rem-Sho with complainant's machine. The instructions are on their face designed to indicate to the salesman how he is to present the mechanical construction of the Rem-Sho to an intending purchaser, and particularly how to show its superiority over the Remington. Thus, on page 1 of the Letter of Instructions we find the words (R. 875):

> "Rem-Sho is a shift key machine same as Remington, but principal difference between the Rem-Sho and Remington, besides many improvements to be explained later, is its method of shifting for capitals. (Salesmen here illustrate by depressing cap button.) Remington machine prints capitals by shifting the carriage, a loose construction as any one can see. (If Remington machine is convenient, illustrate.) . . . As against the loose construction of the shift on the Remington carriage then, we have at all times a rigid disk whether printing capitals or small letters. . . If Remington machine is handy, call customers' attention to looseness of construction of the Remington carriage and compare it with the rigidity of the Rem-Sho. . . . On the Remington this is accomplished only by taking the bar and hanger out and riveting the hanger tighter. It requires the tools and service of an expert and costs money. On the Rem-Sho, if necessary, the operator himself can adjust any type bar. . . . On the Remington, the hanger and type bars are set up on top of the disk. . . . This is not the case in ball bearing carriages, such as the Smith Premier has. . . . This has a very easy adjustment, much easier than on the Remington machine."

Thus, reading the Letter of Instructions and having in mind the purpose for which it was designed, it becomes at

once plain that there is absolutely nothing either untrue or misleading therein. The scheme of Crean in selecting a part of this Letter of Instructions to read into the record is but another evidence of his unfairness (to express it mildly) with which the record abounds. The later letter of instructions issued by the Remington-Sholes Company and which was introduced in evidence as "Defendant's Exhibit Remington-Sholes Co. Instructions to Dealers" (R. 1453) contains practically the same matter as that in the nine-page letter of instructions before considered, and in addition thereto a "Notice" to the salesmen to let the Rem-Sho machine speak for itself, to sell the machine on its merits alone and to avoid connecting either the machine or the company with complainant.

Certainly extended argument is not necessary to satisfy this court that detective testimony, such as that of Crean (*alias* Francis, *alias* Hood) is unreliable and of little value.

Gorham Manfg. Co. v. *Emery-Bird-Thayer Co.*, 92 Fed. Rep., 774 (affirmed 104 Fed. Rep., 243), was a case in which complainant sought to establish infringement by having detectives mislead and entrap defendant's salesmen. The facts in such case and the views of the court with respect thereto are so pertinent that we quote at length from its opinion:

> **"A superserviceable detective is very apt to discover, in his eagerness to illustrate his fidelity to a self-imposed master, what he seeks. The persistent conduct of the complainant in sending spies upon the unsuspecting clerks of this house is calculated to excite some incredulity as to the virtue of this class of testimony.** The evidence shows that next came an agent of the complainant, representing its business in the Western territory, who also entered this store under the guise

of a purchaser, and applied to this same lady clerk for the purchase of a spoon. She distinctly told him that the spoon he bought was not of the Gorham pattern.

"Still determined to find some evidence, if possible, against the defendant company, he represented to her that he wanted the spoon to give to a friend out in Kansas who had a preference for the Gorham pattern, and persuaded her to write upon the duplicate sale ticket given him therefor the word 'Gorham.' This is verified by the fact that the duplicate sale bill which went to the defendant's accounting office did not contain the word 'Gorham,' which was written on the duplicate taken by said agent after it was returned from the accounting office to the clerk to be given to the purchaser. The clerk's evidence is that she reluctantly yielded to the agent's insistence, merely to oblige him, which act on her part, however reprehensible from a business point of view, certainly cannot be taken advantage of by the party who procured it.

"The evidence shows, without contradiction, that it *was the well-known rule of this house that no goods were to be represented by employes to customers to be other than what they were*, and that all customers buying goods of the house which proved to be dissatisfactory had the right to return them within a reasonable time and receive back the purchase money. The evidence on the part of the complainant not only fails to show that any *bona fide* purchaser had ever been decieved in the matter of purchasing something else for Gorham goods sold by this house, but, on the contrary, the evidence on behalf of the defendant shows that no such complaint had ever been made to the defendant; and, with the exception of the sale made by young Sheldon, the first intimation ever received by the agents or managing officers of defendant company of any false sale of the Gorham goods was on the filing of this suit.

. . . . . .

"Nobody was deceived or defrauded into the sales claimed to have been made to the detectives sent to

defendant's store to get evidence. They knew exactly what they were getting. The conduct of complainant's agent, who, by deceit and falsehood, induced the saleswoman to mark on the sale ticket the word 'Gorham,' shows that the scheme and purpose were to procure a wrongful act, to make it the basis of a law suit.

"A man who procures another to slander him can not make it the basis of an action for damages. *Sutton* v. *Smith*, 18 Mo., 120. **This is based upon the fundamental principle that no person has the right to entrap another, by false and fraudulent appearances, in order to induce an act on which to base a claim for damages in a court of justice.**

" How much more should this rule apply in a court of equity, which, in its search after justice, looks into the very heart, to divine the motive. . . ."

See also *Hostetter Co.* v. *Bauer*, 74 Fed. Rep., 235.

Manifestly, when a complainant's agent makes purchases in an ordinary manner from a salesman of a defendant, such purchases may serve to prove infringement; but where, as in this case, complainant employs a detective who by deception *induced* defendants' salesman to commit an act on which to base a charge of unfair dealing, complainant cannot avail himself of it. That the witness Crean did in fact induce defendants' salesmen Romig and Wilgus to invoice the Rem-Sho machine purchased by him as "1 Remington-Sholes typewriter of the style Remington" is made plain not merely by the testimony of these witnesses, but is conclusively proven also by the bogus Brooks & Company letter, which Crean exhibited at his first interview with Romig. This letter directed attention to the fact that "specification calls for '1 writing machine *of the style Remington,*' " etc., the very language in which Crean persuaded Romig to state the invoice.

In Sebastian on Trade-Marks, p. 140, it is said:

"However, where a defendant had, in obedience to express directions, put up his silk in imitation of the plaintiff's bundles, his execution of the order was held not to be conclusive against him (citing authorities). So, too, where a defendant packed inferior brandy in the plaintiff's cases at the express request of an agent of the plaintiff, who was seeking to entrap him, Malins, V. C., refused the injunction with costs," (citing authorities).

The record shows that both Romig and Wilgus have long since left defendant's employ. This fact is to be considered not only because it relieves their testimony from question of prejudice, but also because it shows the improbability of a repetition of any acts that they may have committed in violation of the specific instructions given by defendant and the Remington-Sholes Company to its salesmen to avoid any confusion of the "Rem-Sho" with complainant's machine.

Scheumaker's Detective Work.—Scheumaker was a young man employed to do detective service by Thomas F. Crean on behalf of complainant. (R. 179 and 180.) His cross-examination upon this point is as follows (R. 179):

"X-Q. 57. When Mr. Thomas F. Crean called your attention to the Rem-Sho typewriter in August, 1898, what did he state that he wished you to do?

"A. He wished me to take up the agency for it.

"X-Q. 58. Do I understand you to say that Mr. Thomas F. Crean, representing Wyckoff, Seamans & Benedict, wished you to take up the agency of Rem-Show typewriters?

"A. Yes, sir.

"X-Q. 59. You knew that he was a representative of Wyckoff, Seamans & Benedict at that time?

"A. Yes, sir.

"X-Q. 60. What reason did he give for wishing you to take the agency of the Rem-Sho typewriter?

"A. So that I might obtain information of the Remington-Sholes Company and their product which Wyckoff, Seamans & Benedict desired to obtain.

"X-Q. 61. What arrangements were made with Mr. Crean in regard to paying you for this service?

"A. The assurance that a fair compensation would be given me.

"X-Q. 62. By whom was such compensation to be given you?

"A. Wyckoff, Seamans & Benedict.

"X-Q. 63. And in pursuance with this understanding with Mr. Crean you were to obtain the agency for the Rem-Sho typewriter?

"A. Yes, sir."

In furtherance of his plan to get into the employment of the Remington-Sholes Company in order, as he admits, to disclose its affairs to complainant, but more probably to commit some act upon which complainant might hang its charge of unfair competition, Scheumaker conducted a correspondence with Page, Dennis & Company, who were then representing the Howe Scale Company and the Remington-Sholes Company at New York. A consideration of this correspondence, which is in evidence (R. 911-920 and R. 1478-1481), must show, on the one hand, the entire fairness of those representing the Rem-Sho machine, and, on the other hand, the lying methods practiced by complainant's witness in his attempt to obtain or manufacture evidence in this case. An example of the Scheumaker correspondence is found in the letter quoted upon page 182 of Complainant's Record. The answer of the Remington-Sholes Company by Mr. Seddon to that part of the letter in which Scheumaker inquires "whether I can advocate this machine as the only Remington, and that the machine known as the Remington Standard is not the Remington—that is, the original Remington." must clearly disprove any purpose to deceive Scheumaker

or to confuse the Rem-Sho with complainant's machine. This answer reads (R. 1481):

> **"Our machine is not known as the Remington Standard, or have we any connection with the Remington Standard typewriter; our machine is known as the Rem-Sho, manufactured by the Remington-Sholes Co. Regarding the history of our machine you will find it embodied in the catalogue which we send you under separate cover."**

Certainly this brief, frank statement of Mr. Seddon is a relief from the tedious screed of Scheumaker (R. 185), to which it is an answer. We submit that it is an answer also to any pretense that there was attempt upon the part of Seddon to deceive this witness. Not only did Seddon thus write Scheumaker, but the witness admits that Seddon also told him that the Remington-Sholes Company was not in the "Trust" (R. 188), gave him a copy of the Rem-Sho catalogue (R. 186), told him to explain to purchasers that Wyckoff, Seamans & Benedict sold the Remington Standard typewriter (R. 178) *and advised him to suggest to an intending purchaser to try the Smith-Premier and the Remington side by side with a Rem-Sho.* (R. 178.)

In the light of this correspondence and of the admissions of this detective witness we scarcely think that the court will predicate upon his testimony any charge that defendant has been guilty of unfair dealing.

A. J. Scorer's Alleged Misrepresentations.—This witness, who is now in the employ of the United Typewriter and Supplies Company in selling the "Trust" machines, was produced to show that during his few months of service (from December, 1897, to July, 1898) as salesmen for defendant he misrepresented the Rem-

Sho machine and to show also that parties purchased from him such machines under the impression that they were of complainant's manufacture.

We have already shown the error of that part of Scorer's testimony alleging that various parties purchased Rem-Sho machines under the belief that they were complainant's. We submit that the testimony of this witness clearly proves that he understood fully that the Rem-Sho was a competitor of complainant's machine, and that notwithstanding his attempts to show that he was guilty of misrepresentation he did not in fact confuse the Rem-Sho with complainant's machine nor cause others to do so. The testimony of defendant's witnesses who purchased machines from Scorer leaves no shadow of doubt that both he and they fully understood that the Rem-Sho was a competing machine and had no connection whatever with complainant.

When Scorer went into the employ of the Howe Scale Company, of Pittsburg, there were Rem-Sho catalogues in that office accessible to the salesmen and for their use in enlisting the interest of prospective purchasers. (R. 1234.) Scorer at the outset of his Pittsburg service used a business card containing a picture of the Rem-Sho typewriter, his own name printed across it and the words "Representing the Rem-Sho Typewriter, Howe Scale Co., 107 Market St., Tel. Pittsburg 494" appeared thereon. (R. 1232 and R. 1463 and R. 358). At a later period of his service he used the ordinary card of the Remington-Sholes Company ("Defendant's Exhibit Remington-Sholes Company Pittsburg Card") (R. 1469 and R. 357) that contained the Chicago address and the Pittsburg address of such company.

He had been a typewriter salesman for several years

before he entered defendant's employ, he was familiar with complainant's machine, its wide reputation, and must have known that close competition existed between the various makes of typewriters. He knew that the Rem-Sho was manufactured in Chicago (R. 362, Q. 117), that it was competing with complainant's machine and that of other standard makes. He knew the Pittsburg agent of complainant and its office (R. 361) and that the Rem-Sho was not manufactured by complainant (R. 362.) His pretension that he did not know that the Rem-Sho was made by the Remington-Sholes Company of Chicago is incredible upon its face in view of all the facts appearing from his testimony and from the testimony of defendant's witnesses Beitel, Evans and Alkire and from the fact that the name "REMINGTON-SHOLES COMPANY, MFRS., CHICAGO" appeared on every machine. He admits that he explained to purchasers that the two machines were in competition (R. 363), and that the relative superiority of the two machines was discussed when offering the Rem-Sho. (R. 368.)

In the light of Scorer's own admissions and of the testimony of the witnesses produced on behalf of defendant it is perfectly plain not only that he must have been fully aware of the origin and history of the Rem-Sho machine, but also that in his dealings with customers he represented it as a competing machine and not as one having any connection whatever with complainant.

Alleged Confusion in Trade.

A great many witnesses have been produced on behalf of complainant for the purpose of showing that the public has confused the Rem-Sho typewriter with complainant's machine or has in some way supposed that the Rem-Sho

was a product of complainant's factory. These witnesses with few exceptions, are employes either of complainant or other companies associated with it in the so-called typewriter "Trust." We confidently submit, not only that their testimony fails to establish any uncertainty in the public mind as to the identity or origin of the Rem-Sho machine, but the very multitude of witnesses from all parts of the country and the absence of any proof of confusion should conclusively prove that no such confusion in fact exists.

JOSEPH E. PLATT, when called as a witness on behalf of complainant, testified (R. 144) that while he was agent for the Rem-Sho he found at his office in New Haven that the prevalent opinion of his patrons and the public generally was that the Rem-Sho was manufactured and put upon the market by Wyckoff, Seamans & Benedict, and he attributed the existence of such opinion (R. 145) to the use of the name Remington in connection with defendant's machine. That Platt's testimony can have no force whatever is clearly shown from his own deposition and from that of complainant's witness Downs. (R. 247.) Platt for many years had been the New Haven agent of Wyckoff, Seamans & Benedict in the sale of the Remington typewriter, and during the latter part of such time had occupied the office at No. 27 Centre street. (R. 1374.) He gave up the agency of the Remington machine and immediately became the local dealer for the Rem-Sho machine. (R. 142.) It was not unreasonable, therefore, that many of his patrons and of the local public, familiar with the fact that he had long represented complainant, should assume that the new machine that he was offering for sale at the same store might have some connection with complainant. This was the reason, as Complainant's Record shows (R. 248), why Mr.

Downs, not knowing that Platt had passed from the service of complainant to defendant, supposed that he would procure from Platt a Remington machine, when he gave Platt an order for *"a typewriter,"* without other designation.

Platt's deposition shows that he kept on hand a supply of Rem-Sho catalogues, folders, etc., and gave all information necessary to enlighten any one as to the origin of the Rem-Sho machine and as to the fact that it had no connection whatever with complainant's. (R. 145 and 147.) It will not be pretended that Platt ever made an untruthful representation with respect to the origin of the "Rem-Sho," but, on the contrary, his testimony shows that he freely circulated catalogues, advertisements, etc., fully advising the public with regard to such machine.

MISS ELIZABETH WILSON, when called as a witness for complainant, testified (R. 265) that she remembered reading a letter received at the office of the U. S. District Attorney for the District of Columbia (at which office she was employed as stenographer), and that such letter referred to the "Rem-Sholes" typewriter. When asked what impression was made upon her mind as to the origin of the machine referred to in said letter she answered (in language strikingly suggestive of the detective witness Crean) that she *inferred* that the machine was being put out by the firm which *had* manufactured the Remington machines, "and that the name Sholes was the name of the man who had made some very important improvements, and therefore his name had been used in connection with the old Remington typewriter; and naturally that the Remington-Sholes, *better known as the Rem-Sho*, was an improved Remington typewriter."

It appears from the cross-examination of this witness (R. 266), and also from the deposition of Mr. Frank L. Sholes (R. 1171), that the letter to which the witness referred read as follows:

> "*Dear Sir*:—We received the award for furnishing typewriters for the Department of Justice for the coming year. We take pleasure in sending you under separate cover a catalogue. Should you be in need of anything in this line, we will be pleased to receive your order through the Department of Justice.
>
> "Yours very truly,
>
> "REMINGTON-SHOLES COMPANY,
>
> "F. L. SHOLES, Manager."

It also appears that this letter was written upon the usual letter-head of the Remington-Sholes Company (R. 1170), whereon appeared in large letters the name "REM-SHO," the name of the company, the names of its officers, the Chicago factory address, the Washington address and a picture of the machine. Certainly there was nothing in this letter to warrant the "inference" of Miss Wilson, and if she read the catalogue which accompanied the letter it must have set at rest any question that such inference may have raised in her mind.

A. ROGERS LEE, when called as a witness for complainant, produced a letter addressed to complainant because, as he stated, he thought that complainant was the proprietor of the Rem-Sho machine, which his employer was at that time using. It appears from the testimony of this witness, however, that he had nothing whatever to do with the purchase of the machine, never used it (R. 388), *never examined it to ascertain by whom it was made*, but that he knew that it was a Rem-Sho. He admits that he *does not know why he assumed that Wyckoff, Seamans & Benedict manufactured the Rem-Sho.*

(R. 388.) Except for the fact that Lee's employer had before owned a Remington Standard, there is no more reason why Lee should have addressed a letter relating to repairs for a Rem-Sho to Wyckoff, Seamans & Benedict than to any other typewriter concern. The testimony of the witness is suggestive, however, as showing the exhaustiveness with which complainant has gathered together every scrap of testimony that might have even the remotest bearing upon the case.

F. LYMAN BROWN, a dealer in typewriters in New York City, in answer to leading questions of counsel for complainant, states (R. 448) that he has heard defendant's machine "called the Remington, and by some the improved Remington." He does not attempt to state, however, *when* he heard defendant's machine so called, nor *by whom*—whether by complainant's employees or detectives or others. This witness also states that the Rem-Sho machine could be sold as and for the Remington machine to parties not knowing the difference between the machines (R. 449), but this is readily explained by his testimony (R. 448), "I have customers very frequently who purchase machines from me *and buy whatever I tell them is a Remington,* they not knowing the difference between the machines." The bias of this witness is plainly manifest in his volunteer answer to direct question 31 (R. 449), and is due doubtless to the fact that he failed to effect a connection with the Remington-Sholes Typewriter Company at the time negotiations to that end were pending. On cross-examination he admits (R. 452) that he never sold a Remington-Sholes typewriter, and further admits that he cannot give the name of any one who ever bought such typewriter supposing it to be a Remington Standard machine.

In view of the fact that this witness has had no experience whatever with the sale of the Rem-Sho machine his statement that others might be confused or misled is without foundation and can amount to nothing. In the case of *Cook* v. *Starkweather,* 13 Ab. Pr. (N. S.), 392, the court, in commenting upon the worthlessness of expert testimony in trade-mark cases, said:

> "An expert may easily detect a counterfeit bank bill, but his opinion as to whether the public could detect it is not entitled to any more weight than the opinion of any other person."

In *California Fig Syrup Co.* v. *Taylor Drug Co.,* 14 R. P. C., 564 (High Court of Appeals), in speaking with regard to the trade witnesses who testified that defendant's goods could be readily passed off for complainant's, Rigby, L. J., said:

> "As regards the actual facts, when we come to the proof of them we have got certain gentlemen who are ready to say in their opinion—it never occurred to them that they never had any experience —that, if they were asked to supply 'American Syrup of Figs' they would supply 'California.' I think that is a rather strong thing to say if that were all, but it is a pity for the plaintiffs that they did not go to one of these gentlemen and by experiment find out what would be done."

A. PALMER BROOKS, a sales agent for complainant, after giving incompetent testimony (R. 240) with respect to an Army bid which he never saw (R. 243), states (R. 242) that on several occasions he was told by people that they had purchased a Remington machine at better figures than he could give and that on inquiry he found that such persons did not refer to complainant's machine, but to the Rem-Sho, and he mentions specifically a statement made by some person at the War Depart-

ment to the effect that they had received some Remington machines which witness found on examination to be Rem-Sho machines. The manifestly incompetent testimony of this witness was objected to and it is believed that this objection will be sustained.

The cross-examination of this witness shows that he never even attempted to see the original bid at the War Department (R. 243); that he is unable to give the names of the persons who, as he states, "having bought Rem-Sho machines told him that they could purchase Remington machines at a better price;" and although he admits that he could find at least one of such persons, no attempt whatever was made to produce such person as a witness. Such testimony as this, so easily manufactured, so incompetent and so incapable of rebuttal, can certainly have no weight.

S. W. CRANDALL, manager of complainant's Chicago office (R. 288), when asked (R. 289):

> "13 Q. What inquiry, if any, has been made of you or come to your knowledge concerning the origin of the Remington-Sholes typewriter, or Rem-Sho typewriter, and as to the connection, if any, of Wyckoff, Seamans & Benedict therewith?" answered:
>
> "A. Many inquiries, not always the same, of a general character have been made. **I do not recall specific cases."**

The witness goes on to state the nature of these general and indefinite inquiries and draws from them the conclusion that "the impression in the mind of the inquirer was beyond any question whatever an impression that the machine which was the subject of the inquiry possesses merit of manufacture in some degree of the same character as the Remington typewriter." (R. 290.) While the witness attempts, under repeated

urging of counsel for complainant (R. 303), to recall in a general and indefinite way instances of confusion, he admits upon cross-examination that he cannot give the names of any persons who were confused (R. 308), and he adds: "I simply retain it as a *recollection of a condition.*" He further admits (R. 308) that the instances referred to by him *"occurred the greater part three or four years ago,"* and that **"no case has arisen of any moment in the last two years."**

He admits also that in the cases mentioned in which the alleged inquirers had received business cards of the Remington-Sholes Company such cards contained the name "REM-SHO," the names of Mr. Fay and Mr. Remington, and the factory address of the Remington-Sholes Company in Chicago. His cross-examination shows that wherever this witness has attempted to cite any instance of confusion he is unable to locate it in such manner that the parties could be identified for the purposes of rebuttal. Thus he explains his inability to give the name of the party mentioned in one of the instances cited by him because, as he says, it occurred "at least a year and a half ago." (R. 309.) The following question and answer must show the indefinite character of the witness' statements and the worthlessness of his testimony as proof of any confusion existing in the pubilc mind between complainant's machine and that of the Remington-Sholes Company (R. 310):

> "87 X-Q. In your answer to direct question 14, when testifying in regard to the character of the inquirer's name concerning the origin of the so-called 'Rem-Sho' typewriter, you state that 'there was without exception in the case of such inquiries referred to a confusion on the part of the inquirer as to the manufacture, and in some instances even of the sale of the so-called 'Remington-Sholes' or

'Rem-Sho' as distinct from the 'Remington typewriter.' Now, I ask you to give me all the facts, names of persons, dates, etc., of a single instance within your own experience in which the use of the name 'Rem-Sho' in connection with defendant's machine has been the cause of any confusion as to the source or origin of said machine? In answering this question you will please give me all data within your recollection that will enable me to identify the parties concerned.

"A. **In view of the fact that no case has come under my personal observation for a year and a half; in view of the fact that these cases as a whole transpired three and four years ago,** that no memorandum of persons, dates or the events was made, that no reference to any memorandum or statement or correspondence has been made, or any thought give to the subject whatever, *I do not retain in my recollection the names of any parties, any dates or other data bearing upon this question;* but in making the answer I did as to the confusion of the public on the subject of manufacture of the so-called 'Rem-Sho' machine, I had in mind what was a common report, common rumor and talk between different members of my organization and myself, ourselves and our customers."

The unreliability of the witness' testimony is also evident from the fact that the name Rem-Sho had been adopted only two years prior to the time when his deposition was given. If the testimony of this witness can prove anything it is that the alleged confusion or the inquiries concerning which the witness speaks have ceased since the adoption of the name "Rem-Sho" as a trademark for the machines of the Remington-Sholes Company. In view of Mr. Crandall's indefatigable efforts in supplying complainant with material to be used in evidence and of his repeated appearances upon the witness stand for complainant it is fair to assume that the barren-

ness of fact and profuseness of opinion that characterize his deposition may be construed in defendant's favor.

JOHN S. BAYES, another salesman for complainant, was called to prove that there was an impression in the public mind that the Rem-Sho typewriter was in some way connected with complainant, but the following question and answer, which avoided the necessity of any cross-examination, shows that the testimony of the witness simply makes for defendant, viz. (R. 280):

> "11 Q. Do you now recall the instances when any inquiry was made as to Wyckoff, Seamans & Benedict's connection with the so-called Rem-Sho typewriting machine?
>
> "The same objection as to the last question.
>
> **"A. I don't recall any specific case. Say three or four years ago it was quite general."**

If the testimony of this witness proves anything it is that since the adoption of the name "Rem-Sho" the inquiries referred to have ceased.

A. D. BROWN, manager of complainant's St. Paul office (R. 282), was produced for the purpose of showing that in the Northwest confusion existed in the public mind as to the origin of the Rem-Sho machine. The only specific instance that Mr. Brown is able to give (R. 285) is stated in his answer to Q. 22, which reads as follows:

> "A. About four months ago a gentleman by the name of Pierce, living at Rochester, Minnesota, called at our office in St. Paul and he had with him a card that was either sent or left with him by the Rem-Sho people, and the card was printed Remington-Sholes. He came in our office at St. Paul, thinking it was a branch of their office in Minneapolis *I suppose* as *that was the address on the card*, and wanted to see the machine. We of course were unable to show him the Rem-Sho, BUT DID SHOW HIM THE REMINGTON."

On cross-examination it appeared that the card which Mr. Pierce produced was the usual card of the Remington-Sholes Company containing its Chicago factory address, the names of its various officers, the address of the branch office in St. Paul, the picture of the machine, the name "REM-SHO," etc. (R. 286.) This witness, like the other employees of complainant produced for the purpose of showing confusion in the public mind as to the origin of the Rem-Sho machine, **admits that he can not name any particular instances.** (R. 287.)

E. A. CONYNE, a salesman for complainant (R. 312), attempts to cite two instances (R. 312) of confusion as to the origin of the Rem-Sho machine. The witness is unable, however, to identify the parties referred to in any adequate manner, nor is attempt made to produce them. Certainly his testimony as to the "impressions" of these parties is without force.

D McKAY, another salesman of complainant (R. 316), also claims to have found confusion in the mind of the public as to the origin of the Rem-Sho machine (R. 317), but when asked to state any facts tending to show such confusion he states:

> "In the course of my experience selling Remington typewriters, I can remember of some instances where that has been the case. **I cannot give the data nor can I state where this has occurred, as I do not remember it now."**

When pressed to give an instance of confusion he mentions the case of Mrs. Sternberg, who, as he alleges, informed him *some four years before* (R. 319) that she had sent her machine to the Remington-Sholes office for repairs while under the impression that it was the office of the Remington typewriter. This witness attempts to

explain his inability to recall specific instances of confusion as follows (R. 318):

> "When the Remington-Sholes machine was first put on the market it was known as the 'Remington-Sholes,' hyphenated name, *and during the time that it continued under that name* there was constantly more or less misunderstanding with the buyers of typewriting machines whether this machine was manufactured by the Remington Co., or not."

On cross-examination the following question and answer occurs:

> "20 X-Q. I ask you to state a single instance within the past two years in which, within your own knowledge, any such confusion has occurred, and I ask you to give me sufficient data with respect thereto as will enable me to verify such statement?
> **"A. I can't remember any specific instance where that has occurred at present."**

W. J. McNALLY, a manager of complainant company (R. 320), after stating as his *own conclusion* that there has been confusion in the public mind as to the origin of the Rem-Sho typewriter, was asked to recall facts or circumstances tending to prove such confusion, and to this question he answered:

> "A. *I don't recall any particular case. The matter has gone out of my mind because I didn't pay any particular attention to matters of this kind that would come up.* I have frequently been asked by purchasers if the companies were not the same or if the Remington typewriter did not manufacture this machine and sell it under *another name.* In fact I have had quite a number of cases where confusion arose on account of the similarity of the name 'Remington' **but I don't recall any particular case."**

When pressed on cross-examination for data about the

alleged instances of confusion the witness is unable to give any, since, as he states:

> "I didn't make any mental or other note at the time. In fact I didn't pay any particular attention to it other than meeting it in the regular course of business." (R. 327.)

GEORGE E. FIELD, the Indianapolis manager of complainant (R. 336), testified that the Rem-Sho typewriter had been on sale in Indianapolis for about a year and a half, its office being at 122 E. Market street. (R. 339 and 340.) He alleges that, aside from the matter of mistakes in telephone calls (which will be considered in a subsequent part of this brief), there have been instances of persons calling at complainant's office with goods intended for the office of the Rem-Sho typewriter. (R. 341.) No attempt whatever was made to produce any person who had confused the Indianapolis office of complainant with that of the Remington-Sholes Company, nor were any names or addresses given by the witness, nor in fact any data that would enable the court to discover whether there was in fact any *bona fide* confusion or even instances of confusion due to accident or carelessness.

The testimony of this witness does show, however, that the Indianapolis office used in its business the ordinary card of the Remington-Sholes Company (R. 343), giving the name of the machine "REM-SHO," a picture of the machine, the Chicago factory address, the names of the officers, the Indianapolis office address, etc.; and the testimony of this witness also shows that complinant's Indianapolis business address is given in the city directory under the name "Remington Standard typewriters —Wyckoff, Seamans & Benedict, 12 E. Market," while the business of the Remington-Sholes Company appears

under the name "Remington-Sholes Company, the Rem-Sho typewriter, 122 E. Market."

JOHN LUPTON, another of complainant's clerks (R. 481), was produced to identify a freight bill directed to "Rem. Typewriter Co., 127 Rees Str." He states that he sent to the freight office for the packages referred to in said bill and found that they were addressed "Rem-Sho Typewriter Co., 127 Rees St.;" that thereafter he telephoned the Remington-Sholes Company and the packages were taken away.

We submit that no proof of confusion is made by this freight bill or by the testimony of the witness with respect to it.

J. S. BAYES, an employee of complainant, was recalled and W. A. SMITH was produced to prove that on November 17, 1899 (a few days before their depositions were taken), Bayes received a Remington machine that had been previously tendered at the office of the Remington-Sholes Company, and that Smith, while acting as billing clerk for the W. B. Gibson Company, of Chicago, had delivered to an expressman said machine with its stand and cover (the latter bearing the name "Remington"), and had entered upon the delivery book of the Gibson Company the direction: "Remington-Sholes Co., No. Madison St. Chicago, bet. Clark and Dearborn."

Smith does not attempt to explain why he made this entry on the delivery book—a significant fact, as it appears that the expressman at the time he received it was given a letter addressed to Wyckoff, Seamans & Benedict. (R. 481.) Nor does Smith say that he thought the Remington-Sholes Company and complainant were either the same or in any manner associated. He had heard the name Remington-Sholes Company before (R. 478), but, as he admits that he did not know at the time

he made the entry (R. 478) either the office or factory address of the Remington-Sholes Company, while he did know complainant's address (R. 477), it is obvious that he did not intend to send the machine to the Remington-Sholes Company. Certainly no confusion can be predicated upon Smith's carelessness when he nowhere alleges that any such confusion existed.

W. A. CATLIN, the Kansas City manager of complainant, produced a copy of the "Kansas City Star" for October 19, 1900. (R. 530 and 532.) In this copy of the "Star" appears an advertisement for "3 stenographers," the advertisement ending "Apply Rem-Sho Typewriter office, 25 E. 9th St." Catlin alleges that on the morning after the advertisement appeared several stenographers called. It is not pretended, however, that any one of these callers identified *this particular advertisement in the "Star," or its date,* and although counsel for complainant asked witness the direct and leading question (R. 531):

> "15 Q. These callers referred to this particular advertisement which you have identified?"

The witness answered:

> "They said 'you have an advertisement in the Star.'"

The fact that all the parties who answered the advertisement were stenographers raises the presumption that they were familiar with various makes of typewriting machines.

The fact that all these callers came on the same day, and that there was never any like instance, either before or after, might fairly raise a suspicion that some of complainant's superserviceable detective-employees, like Crean, had been at work.

The witness admitted on cross-examination that the Kansas City office of Wyckoff, Seamans & Benedict advertised *exclusively in the "Kansas City Star"* (R. 539), but no attempt was made to show by the alleged callers whether they came in response to the particular advertisement referred to or in response to some other advertisement that may have been inserted in the "Star" on other dates by complainant's Kansas City office.

The testimony of this witness was manifestly not proper rebuttal in any sense and was objected to for such reason. It should be stricken out; but whether considered or not, it certainly cannot establish any confusion in the public mind. It appears from the testimony of the witness that for more than a year and a half there had been an office for the sale of the Rem-Sho machine in Kansas City. Certainly within such time there was ample opportunity to discover *real instances* of confusion had such existed. The testimony of the witness is pertinent, however, as showing the practice of complainant's agents throughout the country to report to the New York office of Wyckoff, Seamans & Benedict everything that could have bearing upon this case. (R. 538.)

W. C. GOODHUE, an independent dealer in typewriters for the past five years (R. 565), says that he *has had inquiries as to the relation of the Remington-Sholes Company and complainant*, but he is unable (R. 565) to give the names of persons by whom such inquiries have been made, and when asked the substance of such inquiries says:

> "That is a hard question to answer. The talk along that line *has been so indefinite that I could not give anything intelligible on that line.* I can tell you this: I have had people in ordering machines, or in making inquiries in regard to machines, desig-

nate the Remington Standard as being the machine they wanted, not the Remington-Sholes."

The testimony of this witness clearly makes for defendant.

This court must be impressed with the utter worthlessness of the greater part of all this testimony with respect to alleged trade confusion. Is it reasonable to suppose that any appreciable (not to say injurious) confusion actually exists between complainant and defendant's principal when complainant fails to produce unequivocal testimony to that effect? Is it fair to accept as evidence the *mental impressions* of complainant's salesmen as to instances of confusion when they admittedly cannot recall specific cases? Or is it probable that complainant's salesmen throughout the country, under instructions to "report matters of interest in this case" to complainant would have allowed any *bona fide* case of confusion to escape? During the years through which this case has been pending complainant has ransacked this country from Canada to the Gulf in its efforts to find persons who have acted in mistake or confusion. And as a result they bring forth a mass of hearsay testimony and *mental impression* testimony of their salesmen and others and ask this court to base a finding of fraud thereon.

Alleged Confusion in Mail.

A casual inspection of Vol. 2 of the Record (complainant's proofs, rebuttal and exhibits) might convey the impression that there had been serious confusion in the mail matter of complainant and of the Remington-Sholes Company. This mail matter has been so arranged in the volume of exhibits and so interspersed with irrelevant

and incompetent foreign advertisements, etc., many of which have not been properly proven, as to tend to create a confusion in the mind of the court that cannot exist if a careful consideration of the record be had.

In various instances also, exhibits have been improperly designated in Vol. 2 of the Record. Thus, for example, on page 860 of Vol. 2 appears a series of nine letters, there designated as "Complainant's Exhibit Rem-Sho Indianapolis Envelopes." This might readily lead the court to believe that these envelopes were all instances of letters delivered to the office of the Remington-Sholes Company by mistake. As a matter of fact, there was but ONE, "Complainant's Exhibit Rem-Sho Indianapolis Envelope" (see deposition of Field, R. 339), which is the one designated as No. 9 on page 861, Vol. 2, and which Mr. Field says was the *only* letter delivered by mistake to the Indianapolis office of the Remington-Sholes Company. (R. 339.) The remaining exhibits, 1 to 8, are designated in the Record (R. 338) "Complainant's Exhibit Remington Typewriter Indianapolis Envelopes Nos. 1-8, Inclusive." Under the same heading, "Exhibits Showing Confusion in Business," is listed (R. 867) as "Complainant's Exhibit Rem-Sho Indianapolis Business Card," one of *defendant's* exhibits (R 43), and in R. 859, under the same heading is listed another of defendant's exhibits, "Wyckoff, Seamans & Benedict Card Chicago Office," introduced in R. 469. These are mentioned merely as instances to show the necessity of a careful scrutiny of the record by the court in order that a false impression may not exist.

From the number of letters appearing in the volume of exhibits the court might also be led to suppose that there had been *many* instances during the past four years in which letters had been delivered to various offices of the

Remington-Sholes Company throughout the United States which letters were intended for the offices of complainant. As a matter of fact, these instances are so few as to be insignificant. Thus, for example, in R. 941-945, appear *six* letters, only *one* of which was delivered to the office of the Remington-Sholes Company, and that one by mistake of the letter-carrier, the letter being distinctly addressed "Remington Typewriter Co., Chicago, Illinois." (R. 295.)

Mail at Chicago Office.—The record shows that since the fall of 1897 only twelve letters intended for complainant have been delivered to the Chicago office of the Remington-Sholes Company, these letters being designated as follows, viz.: (1) "Keokuk Envelope" (R. 939, introduced R. 300), postmarked November 6, 1897, and addressed "Remington Typewriter Co., Chicago, Illinois;" (2) "Noble Letter" (R. 871, introduced R. 470), dated September 26, 1899, addressed "Remington Typewriter Co., Chicago, Ill.;" (3) "Springer Letter and Envelope" (R. 932, introduced R. 471), dated August 24, 1899, addressed "Remington Typewriter Co., 48 Lake St., City;" (4) "Dillingham Remington-Sholes Letters and Envelope" (R. 933, introduced R. 295-298), dated August 24, 1898, and addressed "Remington Typewriter Co., Chicago, Ill.;" (5) "Ginn & Company Letter and Envelope" (R. 936, introduced R. 472), dated August 21, 1899, addressed "Remington Typewriter Co., City;" (6) "Mumaw Letter and Envelope" (R. 938, introduced R. 487), dated October 31, 1899, addressed "Remington Typewriter Co., Chicago, Ill.;" (7) "Hansen Letter" (R. 941, introduced R. 295), dated November 15, 1898, addressed "Remington Typewriter Co., Chicago, Ill.;" (8) "Potter Letter and Envelope" (R.

947, introduced R. 295-297), dated October 18, 1898, addressed "Remington Type W. Co., Chicago;" (9) "Commonwealth Iron Co. Envelope" (R. 952, introduced R. 295-299), addressed "Remington Type Writer Agency, Chicago, Ill.;" (10) "Ton Postal Card" (R. 953, introduced R. 479), postmarked November 19, 1899, addressed "Remington Typewriter Co., R 460—53 Dearborn St., Chicago;" (11) "Macomb Shorthand School Letter and Envelope" (R. 989-990, introduced R. 543), dated November 6, 1900, addressed "Remington Type-writer Co., Chicago, Ill.;" (12) "Mumaw Exhibits 1-7" (improperly designated "Mumaw Letter and Envelope," and only three of the seven are reproduced) (R. 991-993, introduced R. 23), envelope postmarked January 30, 1890, and addressed "Remington Typewriter Co., Chicago, Ill."

The following question and answer from the deposition of Crandall, manager of complainant's Chicago office, shows the extent of the alleged confusion in mail at such point (R. 307):

> "75 X-Q. In your answer to direct question 54 you have stated that you know many instances where letters which were intended for Wyckoff, Seamans & Benedict were delivered by mistake or inadvertence to the Remington-Sholes Company. Can you state approximately how many such instances there were, and how long it has been your habit to preserve the envelopes in which such letters were received?
>
> "A. There may have been, probably were, upwards of a *dozen such cases in the last four years. We have attempeted to save the envelopes only in the last two years.*"

In his rebuttal deposition Crandall states (R. 546, 547) that complainant's Chicago office is the largest of complainant's offices in the United States, except that at New

York; that the daily mail ranges from twenty-five to 100 letters, a large part of which is addressed to complainant as the "Remington Typewriter Co." Certainly, the surprise must be that out of the many thousands of letters improperly addressed to complainant within the past four years as the "Remington Typewriter Co." such a small number should have gone astray.

Not one of these twelve letters, which by mistake were delivered to the Remington-Sholes Company's office, shows any indication whatever of confusion in the mind of the writer between the complainant and the Remington-Sholes Company. On the contrary, these letters are mainly from business colleges, shorthand schools and others who certainly were familiar with the Remington Standard machine and its Chicago office. The delivery of the letters to the office of the Remington-Sholes Company was obviously a mistake of the postoffice, a fact apparent from a consideration of the exhibits. Thus, in "Complainant's Exhibit Hansen Letter No. 2" (R. 942), the writer says: "I sent you M. O. for $10.00 on the 15th inst., that the Post Office in Chicago delivered to the Remington-Sholes Co. *by mistake.*" And again, in "Complainant's Exhibit Hanson Letter No. 3," the writer says in this same connection: *"I was surprised as the address on the envelope and in the letter in no way resemble the name of the Rem-Sho firm;"* and in "Complainant's Exhibit Hansen Letter No. 4" the writer says: "I enclose the letter asked for by you, delivered through *mistake of the Post Office* to Sholes Co."

The testimony of complainant's witness Crandall with respect to these letters clearly shows that he also recognized the fact that their delivery to the Remington-Sholes Company was simply by mistake of the letter-carriers, as

he testified (R. 302) that complainant had placed the matter "In the hands of the Postmaster at Chicago *in order that the letter-carriers might be called to account.*"

Mail at Philadelphia Office.—Mr. Sobey, the manager of complainant's Philadelphia office, states (R. 499) that the complainant's Philadelphia office is next to Chicago the largest of complainant's offices. He further states that, although the Rem-Sho typewriter has been on sale in Philadelphia about three years (R. 495), and the Remington-Sholes Company has been selling its own machines at such point about a year (R. 502), there have been but TWO INSTANCES of alleged confusion in mail at such point. (R. 500.) One of these was "Complainant's Exhibit Metropolitan Life Insurance Co." (R. 956, introduced R. 497). The envelope of this letter was incorrectly addressed, as witness states (R. 496-499), "Remington & Co., 11th & Chestnut Sts.," the Philadelphia office of complainant being near the corner of 9th and Chestnut. There is nothing in the letter whatever to indicate any confusion in the mind of the writer. The mistake in the delivery of the letter was plainly a mistake of the letter-carrier and was due doubtless to the improper address. The other instance mentioned by witness was a package addressed to the Remington-Sholes Company, and this the postman inadvertently left at complainant's office. Certainly there was no confusion in the mind of the sender of this package, as it was sent from the London office of the Rem-Sho machine. (R. 496.)

In its rebuttal, complainant introduced "Complainant's Exhibit Chester News Letter and Envelope" (R. 996, introduced R. 648); this letter is dated March 15, 1900, and is addressed "Remington Machine Co., 10th & Chestnut Sts., Philadelphia." There is nothing in this

letter to indicate any confusion in the mind of the writer, and the fact that it was incorrectly addressed to the building in which was the office of the Remington-Sholes Company will readily account for the mistake of the postman in delivering it at such office.

Mail at Indianapolis Office.—George E. Field, the manager of complainant's Indianapolis office, testified that the mail at his office averages about fifteen to twenty-five letters per day. (R. 342.) He produced but a single instance in which a letter intended for complainant was delivered by mistake to the Indianapolis office of the Remington-Sholes Company and admitted (R. 339) that he did not recall any other instances of such kind, although the Rem-Sho typewriter was sold in Indianapolis by the Remington-Sholes Company and had been on sale in such market for about a year and a half. (R. 339.) The letter referred to by the witness is "Complainant's Exhibit Rem-Sho Indianapolis Envelope, March 15, 1899," and is the last letter appearing on R. 861) (introduced R. 339). The envelope is addressed "The Remington Typewriter Co., 12 Market St., Indianapolis." Plainly, this shows merely a mistake of the letter-carrier, as the envelope correctly gives the street number of complainant's Indianapolis office.

Miscellaneous Exhibit Letters and Envelopes.

It is plain from the number and variety of the letters introduced that complainant hopes that their quantity may cure their impertinence.

"Complainant's Exhibit Remington Draft and Envelope" (R. 859); "Complainant's Exhibit Remington

Typewriter Indianapolis Envelopes" (R. 860); "Complainant's Exhibit Remington-Sholes Company Envelope August 25, 1899" (R. 937); "Complainant's Exhibit Remington-Sholes Company Envelope October 21, 1898" (R. 954); "Complainant's Exhibit St. Paul Envelope Exhibits" (R. 871), merely support an allegation that is not denied, viz., that complainant's office is frequently addressed as the "Remington Typewriter Co."

"Complainant's Exhibit Leffingwell Letter and Envelope" (R. 950, introduced R. 658), dated December 5, 1899; the letter is addressed "Remington-Sholes Typewriter Co., Chicago, Ill.," and the envelope is addressed "Remington Typewriter Co., Chicago, Ill." This is the letter referred to in "Complainant's Exhibit Crandall Letter" (R. 949), in which Crandall, in writing to the Remington-Sholes Company, says: "We trust you will overlook the fact that by mis-direction of the envelope we were led to break the seal." It will be noted that not only did they "break the seal," but also had a photographic copy made of the letter and envelope for the purposes of this case.

In R. 948 appears "Complainant's Exhibit Remington Letter July 7, 1899 (introduced R. 460)), and in R. 868 appears "Complainant's Exhibit Wyckoff, Seamans & Benedict Letter July 8, 1899" (introduced R. 460). These letters, although introduced at the same time, are widely separated in the volume of Exhibits by various incompetent domestic and foreign advertisements. They prove nothing except that a letter was addressed to "Mr. Franklin Remington, care Remington Typewriter Company;" that the Chicago office of Wyckoff, Seamans & Benedict opened such letter and forwarded it to Mr. Remington, who promptly replied, thanking complainant

for transmitting the same, whereupon complainant's Chicago office sent Mr. Remington's letter to its New York office with the following statement: "We do not know whether this instance is of any value to Mr. Donnelly or not, the envelope, bear in mind, was adressed in care of Remington Typewriter Co."

"Complainant's Exhibit Mett Letter and Envelope" (R. 869, introduced R. 493) are addressed to "Wyckoff, Seamans & Benedict, 327 Broadway, New York." This letter is not proven, was objected to as incompetent and proves nothing.

"Complainant's Exhibit Rogers Lee Letter November 4, 1898" (R. 870, introduced R. 387), has already been considered in connection with the testimony of Mr. Lee.

"Complainant's Exhibit Barnes Letter" (R. 872, introduced R. 302) is addressed to the "Remington Standard Co., Chicago, Ill." The letter states: "I wrote you some days ago in reference to some copy-holders, but the Rem-Sho people got the letter by mistake," etc. This letter shows no confusion in the mind of the writer.

"Complainant's Exhibit Franklin Remington Envelopes" (R. 931.) These envelopes are addressed "Mr. Franklin Remington, General Manager, Remington Typewriter, Chicago." "Complainant's Exhibit Siegel Cooper Envelope." (R. 951, introduced R. 658.) This envelope is addressed "C. N. Fay, Remington Typewriter Co., Dearborn St., City," and is postmarked November 5, 1899. "Complainant's Exhibit Caldwell, Ohio, Envelope" (R. 981, introduced R. 566), addressed "Mr. Charles Norman Fay, Mgr., Remington Typewriter Co., Chicago, Ill." It is not apparent how any confusion between the business of complainant and of the Remington-Sholes Company is evidenced by these misdirected envelopes.

"Complainant's Exhibit Crescent Produce Co. Letter" (R. 988, introduced R. 536) is dated October 27, 1900, and is addressed "Remington Typewriter Co., Kansas City, Mo." The letter which was objected to, is not proper rebuttal, is not properly proven, and the witness Catlin, who testifies with regard to it, admits (R. 539) that he knows no one connectd with the firm of the Crescent Produce Company. This letter, even if admissible, could certainly prove nothing.

"Complainant's Exhibit R. H. Edmunds-Rem-Sho Envelope" (R. 998, introduced R. 628) and "Complainant's Exhibit R. H. Edmunds Co. Rem-Sho Booklet" (R. 999, introduced R. 628) are manifestly not proper rebuttal and are incompetent. They were objected to for such reason, but, even if admissible, they prove nothing for complainant.

"Complainant's Exhibit Davis & Rose Letter" (R. 1000, introduced R. 633) is dated September 26, 1900, and is addressed to "Remington Typewriter Co., Richmond, Va." The letter was manifestly not proper rebuttal and incompetent, and was objected to.

We submit that the exhibit letters and envelopes introduced on behalf of complainant fail absolutely to show any confusion in the minds of the writers with respect to complainant and the Remington-Sholes Company. They establish, at most, the fact that there have been a few mistakes upon the part of letter-carriers in different sections of the country in delivering to the offices of the Remington-Sholes Company letters that were intended for the offices of complainant and *vice versa*. The law is well settled, however, that such mistakes upon the part of letter-carriers cannot prove the existence of confusion in the minds of the public as to complainant's and defend-

ant's machines or as to the companies by which such machines are manufactured.

Sterling Remedy Co. v. *Eureka C. & Mfg. Co.*, 80 Fed. Rep., 105 (C. C. A.).

Dadirrian v. *Yacubian et al.*, 98 Fed. Rep., 872 (C. C. A.).

Goodyear v. *Goodyear Rubber Co.*, 128 U. S., 598.

Turton v. *Turton*, 42 Ch. Div., 128.

Certainly the marvel of this case must be that with their offices coextensive with the country, and with complainant's agents on the lookout for every bit of material of this kind, there are no instances of mail matter showing confusion in the public mind between the Remington-Sholes Company and complainant. THE CONCLUSION IS SIMPLY IRRESISTIBLE THAT NO SUCH CONFUSION EXISTS.

Alleged Confusion in Telephone Service.

Several of complainant's witnesses have testified that some confusion in telephone service has arisen, but this testimony fails to show that it has caused any inconvenience either to complainant or to the Remington-Sholes Company. Thus, for example, Mr. Crandall, the manager of complainant's Chicago office, upon this point merely says (R. 303):

> "We have been called up by the Telephone Co., and conversation opened with us by some business house referring to some business matter, and it would be noted by us before we had gotten very far along in the conversation that they had intended to call up the Remington-Sholes Co."

This witness does not pretend to say that these calls have been numerous, nor when they occurred, nor that

they caused any material inconvenience. By reference to Crandall's deposition (R. 307) it will appear that in the telephone directory the Chicago office of the Remington-Sholes Company and of complainant were indexed as follows:

> "North 572 Remington Sholes Typewriter, Factory—127 Rees.
>
> "Main 3036 Remington-Sholes Co., City Salesroom—204, 126 State.
>
> "Main 137 Remington Standard Typewriter—Wyckoff, Seamans & Benedict, 144 Madison."

Mr. Hobbs, when called in rebuttal as a witness for complainant, made the following statements (although manifestly not proper rebuttal) (R. 552):

> "A. After our telephone number was changed from Main 3036 to Central 1404 we received numerous calls to repair Remington typewriters. The callers usually asked if this was the Remington typewriter, or the Remington Company; but sometimes simply asked for a repair man.
>
> "Q. 9. What was the occasion or purport of these calls upon the telephone of the Chicago office of the Remington-Sholes Co., wherein the callers asked if this was the Remington Co., etc.?
>
> "A. Our telephone number had been changed, and I believe the number of the Remington Typewriter had been changed at about the same time, *which probably caused the confusion.*
>
> "Q. 10. What was the substance of these calls, or what statements or requests were made by the callers?
>
> "A. I think in most cases they asked for a repair man to adjust Remington machines.
>
> "Q. 11. An in response to these calls asking for repair man to adjust Remington machines, were repair men in the employ of the Remington-Sholes Co. sent to the callers for the purpose of making repairs?
>
> "A. THE EMPLOYEES ANSWERING THE TELEPHONE WERE INSTRUCTED TO EX-

PLAIN THAT THIS WAS THE REMINGTON-SHOLES CO., but in some cases the customers asked if we could repair their Remington machines, and were told that we could do so, and a repair man sent.

"Q. 12. How often, approximately, were calls received at the Chicago office of the retail department of the Remington-Sholes Co., of the nature and character described in your previous answers?

"A. Some times several in one day, but an average, I think, of not more than one or two per day.

"Q. 13. But as a general rule, there was one or more such calls on each business day during the time that you were manager of the retail department of the Remington-Sholes Co.?

"A. *We got few, if any, such calls until after May 1st, 1900, when the telephone number was changed.* It was after that that such calls were received."

This testimony of Mr. Hobbs clearly shows that the alleged confusion of telephone calls was temporary and was due to the simultaneous change in the telephone directory of the call numbers of both complainant and the Remington-Sholes Company. It proves, however, that in this, as in all other matters, *the employees of the Remington-Sholes Company were instructed to avoid any possibility of confusion.*

Mr. R. C. Daniel, formerly in charge of the St. Louis office of the Remington-Sholes Company, when called in rebuttal as a witness for complainant, states in this connection as follows (R. 562):

"In some cases, however, parties would call and ask if that was the Remington Typewriter Co. *I would invariably state that it was not—it was the Remington-Sholes Co.*"

When interrogated further as to cases where calls were

made over the telephone in regard to the purchase of machines, he says (R. 563):

> "I remember about one or two or may be three of such instances, and I responded myself."

On cross-examination the witness states that he was in charge of the St. Louis office of the Remington-Sholes Company about one year, and that during such time calls were received from persons wishing repairs made upon other machines than the Rem-Sho and the Remington.

George E. Field, the manger of complainant's Indianapolis office, alleges that considerable confusion in telephone calls had arisen and states (R. 340):

> "This confusion is due to the fact that the Rem-Sho people had their name in the telephone directory under 'Remington-Sholes Company, Typewriters, 122 E. Market.' The name 'Remington Typewriter Company, Wyckoff, Seamans & Benedict, 12 E. Market St.' did not appear in the alphabetical part of the telephone directory until the issue of December, 1898. We had it placed in this way for the reason that several of our friends gave us the information that the Rem-Sho people were getting a number of telephone calls that were intended for us."

Apparently, the change made in the Indianapolis telephone directory, as indicated by the witness, put an end to the alleged confusion in telephone service because it was not asserted that after such time any trouble occurred.

It will thus be seen that such confusion as has arisen in telephone service was temporary and insignificant. Any one familar with telephone service knows that in a busy office there is scarcely a day in which mistakes in telephone calls do not occur. We submit that the testimony fails utterly to evidence in any degree confusion in the public mind as to complainant and the Remington-Sholes Company.

Rem-Sho Exhibit at Philadelphia Exposition.

At the National Export Exposition held at Philadelphia in 1898, complainant and the Remington-Sholes Company each had an exhibit of typewriting machines. In the Remington-Sholes Company exhibit was exposed an old Sholes & Glidden typewriter, upon which was placed a card bearing the inscription "Two generations of typewriters. This machine was invented by C. Latham Sholes of Milwaukee in the early sixties. Later manufactured by E. Remington & Sons, Ilion, N. Y. It is the original article itself. The 'Rem-Sho' typewriter was brought out by Zalmon G. Sholes, the son of the inventor, and Franklin Remington, the son of the manufacturer of this machine. An instance of the familiar adage that 'History Repeats Itself.'" (R. 498,1172.) It is not seen that any unfairness, much less fraud, can be predicated upon the exposure of this old machine. All that was said about it was true, as the record shows.

The exhibit of the Remington-Sholes Company was marked with a large and conspicuous sign containing the words "REM-SHO TYPEWRITER, MANUFACTURED BY THE REMINGTON-SHOLES COMPANY, CHICAGO, ILLINOIS," and abounded in catalogues, folders, cards, etc., giving the name of the machine and the address of the maker. (R. 1173.) The old Sholes & Glidden machine was displayed, as Mr. Sholes states, "the same as bicycle people sometimes display an old model bicycle for a curiosity" (R. 1192), and had no other purpose than to attract the attention of the passer-by. The exhibit of this "Rem-Sho" machine at the Philadelphia Exposition, at which complainant's ma-

chines were also exhibited, tends to prove the absence of any purpose upon the part of the Remington-Sholes Company to cause its machine to be mistaken for that of complainant's.

In Sebastian on Trade-Marks (4th Ed.), p. 123, it is stated as an evidence of absence of a purpose to deceive:

> "So, again, if the defendant has ventured to display at a public exhibition goods bearing the mark to which exception is afterwards taken (citing *Beard* v. *Turner*, 13 L. T. N. S., 746); or if he has truly stated the connection between himself and the original adopter of the trade-mark." (Citing *Emerson* v. *Badger*, 101 Mass., 82, and *Gilman* v. *Hunnewell*, 122 Mass. 139.)

Alleged Imitation of Complainant's Machine.

The attention of the court has been directed already to the fact that the machines placed upon the market by the old Remington-Sholes Typewriter Company comprised a highly ornate bronzed frame differing radically in appearance from the conventional black enameled frame common to complainant's and other machines. This identical style of ornamental bronzed frame was employed also by the Remington-Sholes Company until the summer of 1900. By that time the test of service had proved that the "dress" or "livery" of defendant's machine—as its frame may rightfully be termed—however distinctive and pleasing to the eye, would not stand the wear and tear of long continued service, and it was therefore abandoned.

In the course of its rebuttal testimony (R. 568) complainant's counsel offered in evidence the No. 6 style or model of Rem-Sho typewriter that had recently been

placed upon the market by the Remington-Sholes Company. This machine manifestly has no place in the case. The evidence with respect thereto was objected to as not proper rebuttal, but if allowed to stand cannot help complainant.

Mr. Hobbs, formerly manager of the Remington-Sholes Company's Chicago office, but now manager of the United Typewriter & Supplies Company, is the only one of complainant's witnesses who has seen this No. 6 Rem-Sho, although Mr. Crandall, complainant's Chicago manager, with his usual facility for adapting his testimony to complainant's emergencies, while admitting that he had not seen it, volunteers the statement from "information" (R. 545) that "it is quite similar in general effect and appearance to the No. 6 Remington typewriter."

Conventional Coloring and Numbering of Machines.—The following from the cross-examination of Mr. Hobbs shows in a general way the established custom of typewriter manufacturers with regard to the numbering of the different models or styles of their machines and as to their coloring and ornamentation (R. 560):

> "X-Q. 56. You know, do you not, that various makers of typewriting machines number their models of styles of machines, beginning with the numbers 1, 2, 3, etc., and numbering each new model with a higher number as such model is brought out?
>
> "A. That is the custom of some companies, including the Remington, Smith-Premier and Jewett.
>
> "X-Q. 57. You know, do you not, that the typewriting machines of most of the standard makes have black enamel frames, striped more or less with gold?
>
> "A. Most machines have black enamel frames, and I believe they are usually striped with gold.

"X-Q. 58. This is true, certainly, is it not, of the Densmore, the Smith-Premier, the Caligraph, the Yost and the Hammond?

"A. It is true of most of the machines you mention, but the Densmore is not striped, the Hammond is not black, and the Caligraph is striped in gold and other colors."

The testimony of Mr. J. A. White must set at rest any question, *first*, as to the common practice of all manufacturers of typewriting machines to use frames of the same general style, coloring, etc., as that of the Remington Standard and others, and as to the custom of progressively numbering the various styles or models of the machines; and *second*, as to the true reason why the Remington-Sholes Company had adopted the particular design of frame and coloring shown in its new No. 6 machine. Mr. White has for a number of years past been the Chicago manager of the F. S. Webster Company, the business of which is the handling of all makes of typewriting machines on the second-hand market (R. 1420), and his experience in the sale of typewriting machines has extended over a period of twelve or fourteen years. He states that it is the common practice of all typewriter manufacturers (with few exceptions) to color their machines with black japan or enamel, and that nearly all manufacturers of typewriters have been in the habit of numbering their various models from 1 up as high as No. 8 (R. 1422), these numbers being generally stencilled in gilt or otherwise in some conspicuous place upon the machine. This witness states further that nearly all typewriting machines are striped in gold or colors or both.

The practice followed by manufacturers of typewriting machines with respect to color and ornamentation is much the same as that of sewing-machine manufacturers, bi-

cycle builders or the like, and this custom is so universally recognized that the court might well take judicial notice of it. In the testimony of Mr. Clapp an illustration of the familiar New Century or Caligraph typewriter was offered (R. 1436, R. 1484), and a glance at this will show a fair instance of the almost universal practice of typewriter manufacturers as to the color, ornamentation and numbering of their machines. The testimony shows also that it is the custom of practically all manufacturers to supply their customers with keyboards of the universal or Remington style. (R. 1143.)

Complainant can have no Exclusive Right to the Style or Coloring of its Machine Frame.—A comparison of the "No. 6 Rem-Sho" machine with complainant's No. 6 machine will show at a glance marked differences in appearance that must appeal to the eye of anyone familiar with complainant's machine. The Rem-Sho No. 6 machine in the style and coloring of its frame is upon the conventional lines common to all makes of typewriting machines. There is a resemblance between the two machines as there is a resemblance between any two typewriters having black enamelled frames, or as there is a resemblance between two sewing machine frames of ordinary conventional design and color, but beyond this there is manifestly nothing suggestive of imitation.

The frame of the Rem-Sho No. 6 machine no more nearly resembles the frame of complainant's No. 6 machine than it resembles the frame of the old Remington No. 2 typewriting machine which was colored in black enamel and was ornamented with the same conventional lines as complainant's No. 6 machine. In the advertisement of the old Remington No. 2 machine, found in

Complainant's Record, 929, is shown an illustration of the machine as sold by E. Remington & Sons over twenty years ago. (R. 93.) A bare inspection of this illustration must disclose the fact that so far as the design, coloring and ornamentation of the frame is concerned it possesses the features common to both the Rem-Sho No. 6 and complainant's No. 6 machine, and the universal keyboard is also the same as in the later machine. The patents of Sholes, Brooks and others under which this machine was made by E. Remington & Sons have long since expired, the Brooks patent on the upper and lower case feature, which mainly differentiated the machine from the No. 1, having been granted on April 30, 1878. Upon the expiration of these patents the public became vested not merely with the right to use the inventions, but also to use them with the same style of frame in which they had been embodied by E. Remington & Sons.

The authorities are uniform and conclusive against complainant's attempt to monopolize either the design of this frame, its black coloring or conventional ornamentation, or the common practice of marking the different models with progressive numbers, which complainant's witnesses all admit were simply intended to indicate the styles of the machines.

Coats v. *Thread Co.*, 149 U. S., 562.

Wilcox & Gibbs Co. v. *The Gibbons Frame*, 17 Fed., 623.

Singer Mfg. Co. v. *June Mfg. Co.*, 163 U. S., 169.

Wilcox et al. v. *Kruse etc., Co.*, 23 N. E. Rep., 1146.

Candee v. *Deere*, 54 Ill., 439.

Philadelphia N. M. Co. v. *Rouss*, 40 Fed. Rep., 585.

Faber v. *Faber*, 49 Barb., 358.

Moorman v. *Hodge*, 2 Sawyer, 78.
McKee Furnace Co. v. *LeBaron*, 127 Mass., 115.
Fairbanks v. *Jacobus*, 14 Blatch., 337.
Putnam Nail Co. v. *Delaney*, 140 Pa. St., 205.

Why Rem-Sho Frame Was Changed.—While in view of the testimony it may not be necessary for the Remington-Sholes Company to explain why it saw fit to adopt the generally accepted style of machine frame of conventional design, color and ornamentation, the testimony of Mr. White clearly shows why this change was made. Being in the second-hand business and in such way having had occasion for several years to handle the Rem-Sho machine, he is in position to speak more intelligently than anyone else as to the practical merits and demerits of the machine. He testifies upon this point as follows (R. 1421):

"Q. 9. As a result of your experience and observation have you noticed anything peculiar about the wearing quality of the copper-plate or bronze finish of the Rem-Sho machines handled by the Webster Co., since you have been its Chicago manager, and have you noticed anything peculiar about the wearing quality of the enamelled black on the same style of frame that had the copper-plate finish?

"Same objection as before and on the further grounds that the record does not show that the facts are such as to qualify the witness to testify as an expert on this subject.

"A. I have; it has been my experience that the copper-plate has worn off and caused considerable deterioration in value of the machine and in use has been objectionable to operators on account of corrosion, whereas the japan on the ornamental frame has chipped off, spoiling the appearance of the machine, thereby depreciating its value.

"Q. 10. Did you ever make any statement to any of the officers of the Remington-Sholes Company in

regard to the wearing qualities of the copper-plate finish or black enamelled finish Rem-Sho machines?

"A. Something over a year ago I had a conversation with Mr. Paulson, at that time treasurer of the Remington-Sholes Company, in reference to the finish of the machine, and strongly recommended changing the finish and japanning the machine; in the same conversation I recommended that they do away with the ornamental finish on the machine and make it plain, giving as my reason that owing to previous experience it would wear better and in my mind make a better impression."

These reasons given by Mr. White and the obvious fact mentioned by Mr. Hobbs (R. 556) that the design of the No. 6 Rem-Sho frame is much lighter and consequently cheaper are ample to justify the change by the Remington-Sholes Company to its new style of frame, however reluctantly it might abandon the old.

In *Lorillard Co.* v. *Peper*, 86 Fed. Rep., 956 (see 961), it was strongly urged as an evidence of fraudulent intent that defendant had so changed the shape, coloring, etc., of his package as to more nearly approximate complainant's. The court in disposing of this contention said:

> "It is true that thereafter defendant put out this package, that his sales increased, and that plaintiff's decreased. And these things, of course, suggest that deceptive imitation which is unfair competition. But, as against this, it must be noticed that the form of the package and the colored stripes were not new in defendant's business; so in these respects he was not simply imitating the plaintiff. Both the forms and the color of the stripes were in frequent use among manufacturers, and the plaintiff had no special rights in respect to either. It has doubtless been found by experience that a cylindrical package is more convenient for slipping into and taking out of a pocket, and therefore they who use tobacco prefer packages in that form. And, as between a white and a striped package, the variety of color appeals to the

> eye, and, other things being equal, the purchaser is apt to take the latter. But these are matters of convenience and attraction in common use, and which any manufacturer is at liberty to adopt, and in adopting which he trespasses not the slightest upon the rights of others." (P. 961.)

While defendant's principal was entirely within its rights in thus changing the design and coloring of its machine frame, the court will not fail to notice that this change was not made until nearly two years after the bill of complaint had been filed in this cause. It cannot therefore detract from the importance of the fact that during the whole period in which the bill asserts that defendant and its principal were endeavoring to pass off their machine for complainant's they were offering to the public a typewriter, the highly ornate bronzed frame of which was so utterly unlike complainant's simple black frame, both in design and color, that the two machines could by no possibility have been mistaken one for the other by any person familiar with either.

The case at bar has no likeness whatever to those cases in which a complainant's product has a distinctive dress or "livery" that is imitated by a defendant with intent to deceive the public, for in this case complainant's machine frame has no distinctive features, its style and coloring are public property and the No. 6 Rem-Sho frame resembles it only in the conventional features common to all typewriting machines.

Conclusion.

The case at bar presents to this court for the first time the question of public importance as to what extent the right to use a personal name as a part (or even as the whole) of a corporate name is limited by the prior adoption of such name by another as a designating mark. We submit that while certain of the prior cases prohibit the use of a single personal name, *coupled with other words that make up the full trade name of another* (as in Higgins Co. v. Higgins *Soap* Co. and DeLong v. DeLong *Hook & Eye* Co., *supra*), no reason exists and no authoritative case can be found to prevent the use of a personal name in the recognized legitimate way, either as the whole or as part of a corporate name. On the contrary, the weight of the decisions of the inferior courts and the law deducible from the decisions of this court, make plain the fact that in the absence of fraud or estoppel, the use of his name in a corporation, like every other honest use, is open to any man.

At the very outset defendant's principal laid its course and nailed its flag to the mast when, in answer to complainant's initial protest against the use of the names Remington and Sholes, Franklin Remington wrote (R. 1444):

> "In using our names, the right to which we have never alienated, we have scrupulously avoided all deception of the public both in the superficial appearance and construction of our machine, and in all our printed and verbal representations regarding it."

To this course it has constantly adhered.

The charge of this bill is the fraudulent invasion of complainant's rights by defendant. The burden was upon complainant to prove this charge. How has it attempted to do this? From the four corners of the earth it has gathered a mass of improper, irrelevant and incompetent testimony—foreign advertisements, with which defendant admittedly had no connection, newspaper "squibs," hearsay depositions of its employees, manufactured testimony of its detectives—and with such has padded its record of over a thousand pages. The Circuit Court of Appeals has burdened defendant with the cost of this material, although it has found that there is not "in this voluminous record sufficient evidence that defendant has itself done anything to promote confusion in the minds of the public," unless such is to be inferred from the bare use of the name Remington-Sholes. We have shown that under the circumstances of this case no such inference of fraud can be drawn.

The two questions vital to this case are:

(1) Has defendant the right to use the fanciful trademark "REM-SHO"?

(2) Has it the right to use the name of its principal, the REMINGTON-SHOLES COMPANY?

As to the first question, we submit that the unanimous voice of the Circuit Court of Appeals has made proper answer in its sententious finding that

> "the arbitrary name Rem-Sho, however, does not seem to us to be sufficiently like Remington to be by itself a reasonable cause of confusion."

As to the second question, it is not asserted that the reputation of his ancestors conferred upon Franklin Remington any superior RIGHT to use his name, although such family reputation supplied a most cogent REASON why he should perpetuate and avail of such name in any

lawful enterprise—whether individual or corporate—to which his whole time, capital and energy were devoted.

We simply ask that to the facts of this case be applied the uniform decisions of this court, that a man has a right to use his name in every reasonable way "the same as other property" (*Brown Chemical Co.* v. *Myer, supra*), subject only to the condition that where such name has acquired a secondary signification it "must be accompanied with such indications that the thing manufactured is the work of the one making it, as will unmistakably inform the public of that fact" (*Singer Mfg. Co.* v. *June Mfg. Co., supra*). And we invoke a consideration of the salient facts that the use of a personal name in that of a corporation is a universally recognized reasonable use, and that the conjoint use of the TWO SURNAMES, Remington and Sholes, and their invariable accompaniment by the full address of defendant's principal, afford a most complete "indication of the source of manufacture."

The application of the law thus laid down by this court will wipe out the stigma of fraud placed upon this defendant, upon its principal and upon the good name of the younger Remingtons, by the decree of the Circuit Court of Appeals.

Respectfully submitted,

AUSTEN G. FOX,
JAMES H. PEIRCE,
GEORGE P. FISHER, JR.,
WILLIAM H. DENNIS,
Of Counsel.

APPENDIX.

TRANSLATION OF OPINIONS OF THE GERMAN COURTS IN LITIGATION REGARDING THE NAME REMINGTON-SHOLES.

Opinion of the German Koenigliches Kammergericht.

Rendered:
July 3, 1897.
(signed) Krug,
Court Clerk.

In the Name of the King.

The case of Henry Newald of Berlin, defendant, cross-complainant and appellant, represented by attorney Fuchs I of Berlin,

against

The firm, Glogowski and Co., plaintiff, cross-defendant, and appellee, represented by attorney Dr. E. Fuchs at Berlin.

In regard to the infringement of the trade mark right, the "10 Civilsenat des Konigliches Kammergericht" (Supreme Court of the Kingdom), have, with the concurrence of the Supreme Justice Busch chairman, Supreme Justice Rabe and Nehse, District Judges Delbruch and Kubler, decided that:—

The judgment rendered March 19, 1897 by the 'vierten Kammer fur Handelssachen des Koniglichen Landgerichts *I*" at Berlin, be altered, as follows:—

1. The petition of the plaintiff is denied.

2. As to the cross-complaint, it is decreed that the plaintiffs acknowledge that they are not entitled to enjoin the defendant from selling the typewriters of the Remington Sholes Typewriter Co., or the casing or enclosures therefor, upon which this firm name is marked, nor from using this firm name in connection with advertisements and the like in the course of business.

The further prayer of the cross-complaint of the defendant and appellant is denied.

3. The costs of court are divided between the parties, the other costs of the parties are set-off against one another.

4. As security for the performance of judgment (2), the plaintiff shall furnish a bond of 10,000 M. payable in gold or in notes of the German Empire or the Prussian States, such bond to be conditioned upon the execution of the judgment.

Statement of Facts.

The plaintiffs are engaged in this city in the business of dealing in American typewriters, which they obtain from Wyckoff, Seamans & Benedict at New York. They allege that they sell in their own name and on their own account, whereas the defendant claims that they sell said machines simply as agents of the above mentioned American concern.

On Feby. 8th, 1896 the word "Remington" was entered as a Trade-Mark in the Register of the Imperial Patent Office at Berlin for and on behalf of the predecessors of plaintiffs Glogowski & Son; said trademark is intended for typewriters and their parts, as well as incidentals; the line of business in which said trademark is to be used, is said to be "The sale of the aforementioned

articles." This trademark has become the property of the plaintiffs. The certificate of registry introduced by the plaintiffs (Record P. 233) is considered.

The plaintiffs allege that with the consent and at the instance of Wyckoff, Seamans & Benedict they have caused this trademark to be registered; in support thereof they have introduced a copy of a document dated Oct. 3, 1894 marked "Power of Attorney," to which reference is made (Record P. 40.)

The defendant carries on in this city the sales of American typewriters made by the Remington-Sholes Typewriter Co. at Chicago. He himself states that he carries on such sales as the employe of said concern and on its account. The typewriters of said American concern introduced into commerce by the defendant, are marked with the full name of said house; such name appears likewise on the advertisements and price lists issued by the defendant; a specimen of such an advertisement is introduced for inspection (Record p. 19) and is considered.

The plaintiffs believe that the defendant, in carrying on such business, violates their trademark rights and moves for a decree as follows:

a) That the defendant, on pain of fine to be imposed in each case of violation, refrain from placing the word "Remington" either singly or in connection with other words, upon any typewriters or casings or coverings thereof, and from circulating in commerce any typewriters so marked, and from using such marks in connection with any advertisements, price-lists, letters, recommendations, bills, etc.

b) That the defendant remove the mark "Remington" from all typewriters, price-lists, letters of recommendation and other printing matter in its possession, or in case

such removal cannot be effected in any other way, then destroy all typewriters and utensils bearing the aforesaid marks. To award immediate execution of the judgment on giving security.

The defendant makes a point as to his competency to be sued, because he does not sell in his own name, but as an employe of the Remington-Sholes Typewriter Co.

The defendant further insists that he has a right to use, in connection with typewriters consigned by said concern, the business name containing the word "Remington"; that said word is a proper name; that two men Franklin Remington and Carver Remington are interested in said business; that they are descendants of the first manufacturer of typewriters, Samuel R. and that years ago they associated themselves with Zalmon Sholes in a concern for the manufacture of typewriters under a business name containing the words Remington and Sholes; that said concern has produced a typewriter totally different in construction from all others; that for many years they have been selling these machines all over the world under such business name, and that its right to place such business name upon its machines has never been contested; that the competing house of Wyckoff, Seamans & Benedict in the United States has never sought to prevent it from placing its business name upon its articles; that only when said Wyckoff, Seamans & Benedict were about to establish a branch at Berlin, they procured the plaintiffs to have said trade-mark registered; that according to S. 13 of the trademark act the trademark rights thereby acquired would not, however prevail as against the Remington-Sholes Typewriter Co. In support of the allegation that Franklin Remington and Carver Remington are interested in said concern, the defendant has produced the affidavits of Franklin Remington and Zalmon G. Sholes,

dated Sept. 3, 1896, which are referred to (see translation pp. 198-201 of record).

The defendant further insists that the plaintiffs are not legally entitled to the trade-mark Remington and under S. 9 of the trademark act he files his cross complaint asking that said trademark be stricken from the register on the ground that its contents are repugnant to actual facts and give rise to a decention. For he says that Remington is a proper name; that such was the name of the first manufacturer of typewriters at N. Y. the plaintiffs Glogowski & Co. or the partners of said firm do not bear that name and are not entitled to its use; nor has the house of Wyckoff, Seamans & Benedict in whose products the plaintiffs are dealing here, any right to use the word Remington as a trademark, as no member of the Remington family has ever permitted them to use such name for their products; that the word Remington gives rise to a deception, inasmuch as the purchasing public may believe that only from the plaintiffs may they obtain articles coming from the famous works of the first manufacturer of typewriters.

The defendant thus moves to dismiss the complaint, and he also files his cross-complaint moving as follows:

a) To decree that the trademark Remington entered for the plaintiffs in the trade-register of the Imperial patent office be stricken out therefrom or that the plaintiffs be made to consent to such striking out.

b) To order the plaintiffs to acknowledge that they are not entitled to prohibit the defendant from carrying on the sale of machines made by the Remington-Sholes Typewriter Co., and their casings and covers marked with said business name nor from using said firm name in connection with advertisements or otherwise in the regular course of business.

To award immediate execution of the judgment on giving security.

Against the claim that the plaintiffs cannot by reason of this trademark prohibit the use of the proper name Remington for the goods of the Remington-Sholes Typewriter Co., the following points are made:

The name Remington contained in said business name has been sneakingly appropriated, in order to unduly compete with the consignors of the plaintiffs; for Franklin Remington who joined said concern, had never theretofore constructed or sold any typewriter, nor had Carver Remington. In support hereof the plaintiffs refer to the affidavit of director C. W. Seamans at N. Y. and produce the affidavit of Thomas Richardson, dated June 23rd, 1896, of Silas W. Crandall, dated June 27, 1896, and of Clarence W. Seamans, dated Dec. 14th, 1895 (see translation record pp. 182-192, 194-196, 150-160). To these documents reference is made.

As regards the cross-complaint, as far as the same seeks to have the trademark of the plaintiffs stricken from the register, the plaintiffs state the following. They sell the machines of Wyckoff, Seamans & Benedict of N. Y. and at their instance have caused the word Remington to be registered as a trademark in connection with such sales, the manufacturers being legally entitled to affix said word to their manufactured articles. For the first typewriter factory has been conducted at New York under the name of E. Remington & Sons, they marked their products with the name Remington. This concern with its business name and all its rights has passed into the hands of the Standard Typewriter Mfg. Co.; the latter in consequence thereof changed its name to Remington Standard Typewriter Mfg. Co. and the last named concern with its business-

name and all its rights finally passed into the hands of Wyckoff, Seamans & Benedict. This concern, therefore, has the right to mark its goods with the name Remington, it exercises this right in the U. S. and the same has never been contested. In support of this contention the plaintiffs introduce an affidavit of Clark Seamans, dated Oct. 4, 1895 (pp. 38 and 39) of Wyckoff, Seamans & Benedict, dated Oct. 3rd, 1894 (P. 40) also the above mentioned affidavits of Clarence W. Seamans and Thos. Richardson, also the certificate of Judge Hardin of date Nov. 30, 1888 (pp. 104-106), the affidavit of Elizabeth Remington (pp. 120-124), the certificates of registry by Benton J. Hall of date Oct. 23, 1888 (pp. 176-180) and by J. P. Fisher of date May 7, 1896 (p. 172.) Reference is had to all those documents.

The defendant contends that Franklin and Carver Remington have allowed the use of their names exclusively in connection with the Remington-Sholes Typewriter Co. He claims that Franklin Remington together with Zalmon Sholes have invented the typewriter named after them, that they started the company and took an active interest in its business; Franklin Remington is manager of the factory, whereas Carver Remington is only financially interested. As to the alleged right of Wyckoff, Seamans & Benedict to use the mark Remington it is insisted that they never acquired that right from any member of the Remington family, although they obtained the rights in the business name of the Standard Typewriter Co from the parent of Franklin and Carver Remington.

In the court below, by judgment of Kammer 4 fur Handelssachen des kgl. Landgerichts 1 of March 19, 1897 the cross-complaint was dismissed and judgment was rendered against the defendant in manner and form as de-

manded by the plaintiffs. As regards the facts, so far as not above stated, reference is made to the finding of facts in said judgment.

As ground of the above decision it is stated that it appears from the allegation of the parties that the defendant's motion to strike the trademark from the register is improper, because Wyckoff, Seamans & Benedict have the right to use that mark for their manufactured products. The decree against the defendant is based on the trademark protection due the plaintiffs, the defendant cannot avail himself of S. 13 of the trademark act, because being the general agent of Remington-Sholes Typewriter Co. it is not competent for him to enforce the rights in that business name on its own behalf.

The defendant has entered his appeal from said decree of April 15, 1897, on the 20th of April, 1897, and moves to modify said decree so as to dismiss the complaint and to find against the plaintiffs and cross-defendants according to the prayer of the cross-complaint. The defendant considers the reasoning of the first decision bad. If the defendant, though only the agent of the Remington-Sholes Co., can properly be sued, he may also avail himself of the provisions of the law beneficial to his principals. According to S. 13 of the act the plaintiffs case must fail because the machines bear only the names of the said Company. As to the cross-complaint, the statement contained in the opinion that the defendant has admitted, that the plaintiffs or their successors had acquired the business-name and right from a member of the Remington family, is incorrect, for the defendant has disputed this very point and so it appears in the statement of fact in said judgment. Defendant refers to the affidavits of Franklin and Carver Remington at Chicago to show that no member

of the Remington family has ever granted the right to Wyckoff, Seamans & Benedict to use the name Remington in the course of business. The motion to strike the trademark of the plaintiffs from the register is, therefore, according to S. 9 of the act just.

The plaintiffs move that the appeal be dismissed. They argue several legal points in support of this motion. The statement by the defendant that he has only acted as the agent of the Remington-Sholes Co. they seek to contradict by a letter of Attorney Meissner of June 16, also by statements in the brief of the defendant of May 13, 1897 (record, vol. II P. 24 *et sec.*), as both documents speak of "the business of the defendant."

Opinion.

1. If that petition of cross-complaint which has for its object the cancellation of the trademark Remington registered for the plaintiffs must be granted, then the decision must be given, without further consideration against the plaintiffs. If this is the case, according to Sec. 12, sub sec. 2, of the act of May 12, 1894, as to trademark rights, the plaintiffs cannot now, nor against any previous infringement, exercise their right to an injunction. Therefore, it is first to be considered, whether or not, this part of the cross-complaint is well founded.

The motion to strike from the register is based on S. 9 of the act; in support thereof it is contended that the contents of the plaintiffs trademark Remington do not accord with actual facts and give rise to a deception. The competency of the defendant to bring this complaint to strike from the register, against the plaintiffs as the registered owners of said trademark, cannot, in the light of S. 9, be subject to any doubt. According to S. 9, No. 3, anybody

may in a case like this, appear as plaintiffs, because the interests of the public require the nullification of deceptive trademarks.

But he who brings such nullification suit is bound to prove actual ground, in order to sustain it; he must allege and prove facts and circumstances, from which it must appear both that the trademark is repugnant to actual facts and also that its contents create a danger of deception. The facts alleged by the defendant do not justify these conclusions.

The defendant is correct in his contention that a trademark, which consists simply in a proper name, may be repugnant to actual facts. For the mark has direct reference to certain specified articles, it is intended to signify them as the articles of a definite concern. If a proper name is chosen, which to the purchasing public or the commercial world generally suggests the inventor or producer of particularly useful and meritorious articles, the use of such proper name as a trademark to signify articles of a different producer or seller, may indeed conflict with actual facts.

The trademark Remington chosen by the plaintiffs is undoubtedly a proper name; a bearer of that name was the first one to construct typewriters adapted for practical use, the idea of practical typewriters is closely associated with that name. The plaintiffs Glogowski & Co. as proprietors of that trademark are not *personally* entitled to the use of that name. However it is incontestable, that the plaintiffs deal exclusively in the products of the American house of Wyckoff, Seamans & Benedict and that with a view to that business and with reference to the products of that house, they have caused the trademark to be entered in the register. If, therefore, the name

Remington may be used as a trademark for those products without violating actual facts, then, in the case at bar, the idea of a deceptive trademark must be eliminated. In order to prove that these articles may lawfully be marked with the name Remington the plaintiffs allege that their manufacturers Wyckoff, Seamans & Benedict, are the immediate successors of that typewriter concern, which under the firm name and style of Remington & Sons was run by the first manufacturer, Samuel Remington. Among the numerous documents which the plaintiffs have introduced in support of their allegation as to that succession, the following are, under S. 403 Civil Code, considered competent evidence.

Three certificates numbered 1043, 1044 and 1045 respectively under the hand of Secretary of State, Richard C. Olney, of date March 11, 1896 (see translations pp. 171-175, 102-107 and 176-181 of record).

Two certificates, under the hand of Secretary of State Palmer, dated Feb. 29th, 1896 and April 23rd, 1896 respectively (see translations pp. 164-168, and 128-140 record).

By these documents it is certified to that the Standard Typewriter Manufacturing Company has caused the word Remington to be entered as its trademark for typewriters in the trademark register at New York on Oct. 23rd, 1888, their predecessors E. Remington & Sons having marked their products with that word even since 1880; said Company changed its name on Nov. 30, 1888, to Remington Standard Typewriter Manufacturing Company; the latter has become merged in the concern of Wyckoff-Seamans & Benedict, having assigned to said concern all its rights, titles, and interests, particularly also said registered trademark.

Under these circumstances it cannot be assumed that the use of the word Remington as a trademark for the typewriters manufactured by Wyckoff-Seamans & Benedict conflicts with actual facts. This word was intended as a suggestion that said concern has become the successor of the first manufacturing concern of Remington & Sons and continued to produce and sell machines which were made by said Remington & Sons under the same name. The defendant has not shown that these facts have been incorrectly stated by the plaintiffs. He states himself that Wyckoff, Seamans & Benedict acquired at the time from the father of the Remingtons the business-name and right of the Standard Typewriter Company. Their continuing to mark the products with the old name of Remington and causing said word to be protected as their trademark, does not violate actual facts.

It is true, the defendant contends that the Standard Typewriter Company never acquired the right to incorporate the name Remington into its business-name or to register a trademark containing that name, from the Remington family, or any member thereof, nor that any member of the Remington family has given that right to Wyckoff, Seamans & Benedict; in support of this contention the defendant refers to the brothers Franklin and Carver Remington at Chicago. These proofs, though they might otherwise have great weight, appear, however, irrelevant in view of the fact, that for the last nine years the Standard Typewriter Company has used the word Remington in its business-name without any molestation and that for the same space of time it has used the trademark Remington. For if Wyckoff, Seamans & Benedict have become the final successors of the old house of Remington & Sons and continue to manufacture

and sell their product, then the old name Remington as a mark on such products cannot be regarded as intrinsically correct, although the members of the Remington family have not given their consent to the use of that name.

The facts cited by the American house of Wyckoff, Seamans & Benedict in support of their right to use the name Remington, may, however, avail the plaintiffs as well, if the question to be settled is whether the trademark conflicts with actual facts; for here we have to consider the name of an American manufacturer and also the articles obtained by the plaintiff from the United States; if the latter, without violating actual facts, may be marked with the name Remington in the United States, then it cannot be assumed that the same name used for the same product violates actual facts in this locality. At any rate, the defendant has not supplied the necessary proofs tending in that direction.

Nor has it been shown, that the adoption of the word Remington for the articles of the plaintiffs, creates any danger of deception. It would have been incumbent on the defendant to show, that the article sold by the plaintiffs under that trademark is not identical with the one which is suggested to the commercial world and the purchasing public by the name Remington; for in order that the motion to nullify may be sustained, the contents of the trademark must, under S. 9 No. 3 of the act, be so deceptive, as to cause mistake regarding the kind and quality of the article. In this respect the defendant has failed to show any tangible grounds to support his motion to nullify.

These considerations have led us to conclude that the cross-complaint, so far as it seeks to have the trademark of the plaintiffs annulled, must be dismissed.

2. The complaint and the cross-complaint (*b*) bear such relation to each other, that if the complaint can be sustained, the cross-complaint must be dismissed and *vice versa.*

In deciding these matters we must start from the premise, that the articles which the defendant sells in this locality, are manufactured by the American house of Remington-Sholes Typewriter Co. at Chicago. Marked with the name of that house, they are introduced by the defendant into commerce, and that name may also be found upon the announcements and advertisements of the defendant. The plaintiffs take the position that by virtue of their trademark rights they may enjoin the Remington-Sholes Typewriter Co. from the use of that name. For two reasons this position cannot be regarded as sound.

In the first place, under SS. 12 and 20 of the act of May 12th, 1894, only such use of a registered trademark can be denied to third persons, as may cause mistakes or confusion about commercial articles; if under the existing facts, such danger is out of the question, then there can be no infringement of the trademark. This principle must be particularly adhered to in the case of a single word used as a trademark. After such a word has been registered its use in commercial life is not necessarily to be condemned, but such use is only so far improper as it may give rise to the possibility of a mistake or deception. According to this principle, the plaintiffs cannot, in the case at bar, be granted the right to enjoin the defendant for their trademark consisting of the one word Remington, cannot be confused with the appellation "Remington-Sholes Typewriter Company," even by purchasers that would not pay attention to the particulars of the trademark. This is not an insignificant distinction, one that

would but little effect the total impression produced by the trademark but a material and striking difference barring all danger of a mistake.

In the second place, the defendant to defeat whatever rights the plaintiffs may have to an injunction, may properly avail himself of the saving clause in S. 13 of the act of May 12, 1894.

The court below denied to the defendant, as the general agent of the Remington-Sholes Typewriter Co. at Chicago, the right to enforce the protection of this trademark. We are unable to sustain this decision. No matter whether the defendant—as he himself alleges—is an employe of said American house or—as the plaintiffs say—he does business on his own account; in either event it is competent for him to use, in Germany, the American business-name in connection with the goods of the American concern in which he deals exclusively. In the first place such trade-mark protection may be derived from S. 23 subsec. 1, of the act. According to the proclamation of the Chancellor of Sept. 22, 1894 (see Reichsgesetzblatt P. 521) the same protection is granted to German trademarks in the United States as to American ones; therefore the protection of the law of May 12, 1894 extends likewise to American concerns, that have no branch in this locality. This protection must, without discrimination, extend to all the goods of the American house which are offered for sale in Germany, although there is no branch of said foreign house here; from this it follows that American goods which are offered for sale here upon commission or by merchants on their own account, are entitled to the same protection. The protection of the act of May 12, 1894 which is guaranteed by S. 23, subsec. 1, extends likewise to the right mentioned in S. 13, to affix the business name and information about the manner and

place of production, on goods, on their covers and to use them in the course of business. Accordingly, the defendant, who in this locality sells the typewriters of the Remington-Sholes Typewriter Co. of Chicago cannot be prohibited from affixing said business name upon the goods of said house nor from using it in the course of business, or announcements, advertisements, etc. It is not open to dispute, that the defendant deals only in typewriters made by said concern, and that he actually obtains his goods from said concern.

The plaintiffs have tried to establish that the Remington-Sholes Typewriter Co. has unlawfully and sneakingly appropriated the word Remington. They do not dispute that two descendants of the typewriter manufacturer Remington, Franklin and Carver Remington, were among the founders of the concern and are still interested in the same; but again they claim that Franklin and Carver Remington entered into said concern only pro forma, to bestow upon it an apparent right to use their name so well known in this line of business. However, whatever the plaintiffs have actually shown by way of foundation to their opposition to the use of the name Remington can in no wise give rise to the conclusion, that in this instance a business name has been sneakingly appropriated. The plaintiffs have confined themselves to the following statements: Franklin and Carver Remington are the sons of Samuel Remington, one of the copartners of the old firm of Remington & Sons; neither of them has ever had anything to do with the running of the business of said firm, or, before entering into the present business under the name of Remington-Sholes Typewriter Co. ever occupied himself with the manufacture of typewriters. But even if both these points had been fully established, it would not result therefrom, that the

two Remingtons would not become real associates in said new house and were only pro forma engaged by said house, that their name might be used for improper purposes. For it is quite possible, yea even probable, that they should have seriously devoted themselves to the business of their father, and acquired special knowledge, in which they were formerly lacking. To choose this business, in order to take advantage of the reputation attached to their name in this line of business, they have a perfect and indisputable right.

The motion of the plaintiffs for the taking of deposition of the manufacturer Seamans as to the above stated allegations of fact is, therefore, denied. But if the plaintiff's objections to the right to use the business name of the Remington-Sholes Typewriter Co. must be overruled, they cannot, according to the above reasoning, be conceded the right sought by their complaint of enjoining the defendant; it follows from the dismissal of the complaint that a decree be entered against the plaintiffs granting the prayer of the cross-complaint (*b*) referring to the acknowledgment of the defendant's right, to use in the course of business the name Remington-Sholes Typewriter Co. as a trademark for the goods manufactured by them.

The decision as to the costs of suit rests on S. 88 Civil Code.

(signed) BUSCH, RABE, NEHSE, KUHLER

also for District Judge Dellbruck who is no longer a member of the "Kammergericht."

Promulgated.

Berlin the 15 October 1897.

(signed) MITTELSTADT

(SEAL OF THE COURT) Court Clerk of the "10 Civilsenats des Konigliche Kammergerichts."

Opinion of the German Reichsgericht.

IN THE NAME OF THE EMPIRE.

In the case of the firm, Glogowski & Co. of Berlin, plaintiff and revision plaintiff, represented by counsel, Patzki of Leipsig,

against

Henry Newald, Merchant, of Berlin, defendant and revision defendant, represented by counsel, Sachs of Leipzig.

The "Reichsgericht, (Supreme Court) zweiter Civilsenat," by the concurrence of the President, Dr. Binger and the "Reichgerichtsrathe," (Supreme Justices) Wielandt, Dr. Petersen, Rospatt, Fortsch, Remele, Petrey, at the oral hearing of Mar. 4, 1898 have handed down the decision:—

With regard to the judgment of the "zehnten Civilsenats des Koniglich Preussischen Kammergerichts," at Berlin of July 3, 1897, the following revision is remanded, the costs of the court of revision are placed upon the revision plaintiff.

"Von Rechts Wegen" (By reason of the law).

STATEMENT OF FACTS.

The firm Glogowski, plaintiffs, are engaged in Berlin in the business of dealing in American typewriters, which they obtain from the firm Wyckoff, Seamans & Benedict at New York. They allege, that these sales are carried on in their own name and for their own account, while the merchant Newald, defendant, claims, that they sell the machines simply as agents of the American firm.

On February 8, 1896, the word "Remington," was entered as a Trade-Mark, in the Imperial Patent Office at Berlin, and on behalf of the predecessors of the plaintiffs, Glogowski and Son; said Trade-Mark is intended for typewriters and their parts, also for typewriter supplies; the line of business in which the mark is to be used, is said to be "The sale of the aforementioned articles." This Trade-Mark has been assigned to the plaintiff firm.

The defendant carries on at Berlin the sale of American typewriters of the firm, Remington-Sholes Typewriter Co. at Chicago. He himself states, that he carries on such sales as the employe of said concern and on its account. The plaintiff, against this, maintains that he carries on an independent business in his own name. The typewriters of said American concern introduced into commerce by the defendant, are marked with the full name of said concern, this firm's name is likewise printed in the advertisements and price lists of the defendant.

The plaintiff believes that the defendant, in carrying on such business, violates their trademark rights and moved for a judgment, as follows:—

a: That the defendant, on pain of fine to be imposed for each case of violation, refrain from placing the word "Remington," either singly or in connection with other words, upon any typewriter, casings or enclosures therefor, and from using such marks in connection with any advertisements, price lists, letters, recommendations, bills and the like.

b: That the defendant remove the mark "Remington" from all typewriters, price lists, letters of recommendation and other printed matter in his possession, or in case such removal cannot be effected in any other way, then destroy all typewriters and articles bearing the aforesaid mark.

The defendant raised the objection to the complaint that he is incompetent to be sued, since he does not sell here in his own name, but as the employe of the Remington-Sholes Typewriter Co.

The defendant further replied that he has a right to use, in connection with typewriters consigned by said concern, the business name containing the word "Remington;" that said word is a proper name, and two bearers of this name, Franklin Remington and Carver Remington are associated with and interested in this firm; that they are descendants of the first manufacturer of typewriters, Samuel Remington; that years ago they had associated themselves with Zalmon Sholes in a concern for the manufacture of typewriters under a business name containing the words Remington and Sholes; that this concern has produced a typewriter wholly different from previous constructions; that, for many years, they have been selling these machines all over the world under said business name, and that its right to place such business name upon its machines has never yet been contested.

The defendant moved to dismiss the complaint; maintained that the plaintiff, under Sec. 9 of the law of May 12, 1894, was not properly entitled to the trademark Remington; and filed a cross-complaint and moved, as follows:—

a) to decree that the trademark Remington, registered for the plaintiff be cancelled.

b) to order the plaintiff to acknowledge that they are not entitled to prohibit the defendant from carrying on the sale of the machines made by the Remington-Sholes Typewriter Co. their casings and enclosures, which are marked with said business name, nor from using said firm name in connection with advertisements or otherwise in the regular course of business.

The "Konigliche Landgericht I," (territorial court) at Berlin, upon Mar. 9, 1897 decided against the defendant in accordance with the complaint, and the cross-complaint was dismissed as unfounded. Upon the appeal of the defendant, the "Konigliche Kammerigericht" (Supreme Court) at Berlin, by the judgment of July 3, 1897, upon which the review is taken, decided that:—

1. the prayer of the plaintiffs was refused.

2. a degree entered against the plaintiffs in accordance with the prayer (*b*) of the cross-complaint; the prayer (*a*) of the cross-complaint was refused; the costs of court were equally divided between the parties, the other costs of the parties were set-off against one another.

In the decision, it is stated, that that prayer of the cross-complaint, which has for its object the cancellation of the trademark registered for the plaintiff, is not well founded, and then continuing:

> "the complaint and the cross-complaint (*b*) are so related, that if the complaint can be sustained, the cross-complaint must be denied and *vice versa.*
>
> "In deciding these matters, we must note that the articles which the defendant sells in this locality, are manufactured by the American concern, Remington-Sholes Typewriter Co. at Chicago. Marked with the name of that concern, they are introduced by the defendant into commerce, and that name may also be found upon the business advertisements of the defendant. The plaintiff believes, that by reason of their trademark rights, they may enjoin the use of that firm name. This position of the plaintiff cannot be regarded as sound, for two reasons.
>
> "First, under Sec's 12 and 20 of the act of May 12, 1894, only such use of a registered trademark can be denied to third persons, as may cause mistakes or confusion about commercial articles; if under the existing facts, such danger is out of the question, there can be no infringement of the trademark. This principle must be particularly adhered

to in the case of a single word used as a trademark. After such a word has been registered, its use in commerce in all cases is not to be condemned, but is only so far improper as it gives rise to the possibility of a mistake or deception. According to this principle, the injunction cannot be granted to the plaintiff in the present case, for their trademark consisting of the single word Remington, can not be confused with the appellation 'Remington-Sholes Typewriter Co.' either by the trade or by the purchasing public, that does not give attention to the particulars of the trademark. This is not an insignificant distinction, one that would have little effect upon the total impression produced by the trade-mark, but a materially different appearance is presented to the eye, barring all danger of mistake.

"In the second place, the defendant to defeat whatever rights the plaintiff may have to an injunction, may properly avail himself of the restriction of Sec. 13 of the act of May 12, 1894.

"The court below refused to permit the defendant, as the general agent of the Remington-Sholes Typewriter Co. at Chicago, to maintain the right to the use of this trade-name. We are unable to sustain the decision. It is immaterial whether the defendant —as he himself alleges—is an employe of said American concern, or—as the plaintiff states—he does business on his own account; in either event, he may use, in Germany, the American trade-name in connection with the goods of the American concern, in which he deals exclusively. In the first place, such trademark protection may be derived from Sec. 23, Subsec. 1, of the act. According to the proclamation of the Chancellor of Sept. 22, 1894 (see Reichsgesetzblatt P. 521) the same protection is granted to German trade-marks in the United States as to American ones; therefore, American concerns, that have not branches here, share, to the full extent, the protection of the law of May 12, 1894. This protection must extend, without discrimination, to all the goods of the American concern offered for sale in Germany, although there is

no branch of said American house here; from this it follows, that American goods which are offered for sale here upon commission or by merchants on their own account, are entitled to the same protection. The protection of the act of May 12, 1894, which is guaranteed by Sec. 23 Subsec. 1, extends likewise to the right mentioned in Sec. 13, to affix the business name and information about the manner and place of production on goods, on their enclosures, and to use the same in the course of business. Accordingly, the defendant, who offers for sale here, the typewriters of the Remington-Sholes Typewriter Co. of Chicago, can not be prohibited from affixing said business name upon the goods of said house nor from using it in the course of business, upon advertisements, etc. It is not open to dispute, that the defendant deals only in typewriters made by said concern, and that he actually obtains his goods from said concern.

"The plaintiffs have tried to establish that the Remington-Sholes Typewriter Co. has unlawfully and surreptitiously appropriated the word Remington. They do not dispute that two descendants of the first typewriter manufacturer Remington, namely, Franklin and Carver Remington, were among the founders of the concern and are still interested in the same, but they claim that both these individuals named, entered into the concern only pro forma, to bestow upon it an apparent right to use their name so well-known in this line of business. However, whatever the plaintiffs have actually shown by way of foundation for their opposition to the use of the name Remington, it can in no way give rise to the conclusion, that in this instance a business name has been surreptitiously appropriated."

From this judgment the plaintiffs have asked for a revision, and move that the same be revoked as far as the appeal of the defendant is concerned, and that the judgment in the first instance be reinstated by rejecting such appeal.

The defendant has moved that the revision be refused.

OPINION.

The revision can have no effect.

The judgment which is attacked gives two substantial reasons for its decision. The first set forth therein, that the danger of a confusion in business of the trademark employed by the defendant is not apparent, when compared with the plaintiff's trademark; the plaintiff is therefore not entitled under Sec's 12 and 20 of the act of May 12, 1894, to enjoin the defendant's use of his trademark.

This reason depends upon a finding of facts which may not be examined in the court of review, and is in itself alone sufficient to support the decision.

In this connection, as a reason for a revision of the judgment, the point is made, that the appellate court only considered, in its decision, the right to use a certain firm name, which right is governed by special principles, while the review itself is only concerned with the protection of trademarks as regulated by the act of May 12, 1894. This presentation is, however, not well founded and is based upon an incorrect understanding of the opinion rendered. In the case at bar, of course, the trademark and the marking of the firm name are in the same category. But the opinion clearly shows, that the trademark as such, and in accordance with the declaration of the act of May 12, 1894, is made the subject-matter of the decision.

After so holding, it is not necessary to consider the second reason given by the appellate court for its decision, not to consider, in this connection the reason given for a revision of the decision.

The burden of the costs of the court of revision is

placed upon the review-plaintiff in accordance with Sec. 98 of the Civil Code.

(Signed) DR. BINGER, WIELANDT, DR. PETERSEN, ROSPATT, FORTSCH, REMELE, PETRY.

Rendered at the public session of the "zweiten Civil-senats des Reighsgerichts," (Supreme Court) upon Mar. 4, 1898.

Signed, SCHRADER,
Clerk of the Court.

Promulgated at Berlin, October 2, 1899.
(L. S.) Subscribed
Clerk of the Court of the
"Landgerichts I, 4. Kammer fur Handelssachen."

BE IT KNOWN, that I certify to the literal agreement of the foregoing copy with the promulgation of the "Koniglichen Landgerichts I," Berlin of October 2, 1899.

BERLIN, Oct. 6, 1899,
(L. S.) RUDOLF MEISSNER,
Notary Public.

CONSULATE-GENERAL OF THE UNITED STATES OF AMERICA, CITY OF BERLIN, KINGDOM OF PRUSSIA, GERMAN EMPIRE. } ss.

I, Frank H. Mason, Consul-General of the United States of America at Berlin, Germany, do certify that Rudolph Meissner whose signature is subscribed to the foregoing instrument, was, at the time of subscribing the same, Notary Public of the Royal Prussian Court of Justice at Berlin, Empire of Germany, duly commissioned and by law authorized to execute such acts, and that his signature and seal of office affixed thereto are genuine, and as such are entitled to full faith and credit.

WITNESS my signature and seal of office, at Berlin, this 3rd day of January in the year 1901.

FRANK H. MASON,
(L. S.) U. S. Consul-General.